UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm/WF

May 1, 2019

Opposition No. 91243698

Frungy Games, Inc.

v.

Stardock Systems, Inc.

Mary Beth Myles, Interlocutory Attorney:

This case now comes up for consideration of Frungy Games, Inc.'s ("Opposer") motion (filed October 10, 2018) to suspend this proceeding pending final determination of Civil Action No. 4:17-cv-07025-SBA filed in the U.S. District Court for the Northern District of California, an action between the parties Stardock Systems, Inc. ("Applicant") versus Paul Reiche III and Robert Frederick Ford (the "Civil Action"). Opposer filed a copy of the second amended complaint in the Civil Action, as well as the answer and amended counterclaims filed in the Civil Action, concurrently with its motion to suspend. On October 29, 2018, Applicant filed a combined response to Opposer's motion to suspend for civil action and a motion to dismiss the notice of opposition for failure to state a claim upon which relief can be granted. On November 20, 2018, Opposer filed an untimely response to Applicant's

motion to dismiss. Accordingly, on December 10, 2018, Applicant filed a motion to strike Opposer's untimely response. The motion to strike is fully briefed.

As an initial matter, each of Opposer's filings indicates proof of service via First Class Mail. Trademark Rule 2.119(b) states that every submission filed in an inter partes proceeding must be served upon the other party or parties by **email**, unless otherwise stipulated. Inasmuch as Applicant had actual notice of Opposer's motion to suspend for civil action and filed a timely response thereto, the Board exercises its discretion to consider the filing. Opposer is warned, however, that the Board may decline to read or consider any future submission filed by Opposer that does not include the proper proof of service.

By way of background, in the Civil Action, the Applicant is the plaintiff and Reiche and Ford are the only named defendants. Opposer alleges that Frungy Games, Inc. was founded and incorporated by the defendants to the Civil Action and that Opposer seeks to join Frungy Games, Inc. as a party to the Civil Action. 4 TTABVUE 2. In the Civil Action, Applicant has alleged, inter alia, trademark infringement of the STAR CONTROL mark. Applicant also contends to own all rights and title to the involved mark in this proceeding.

Conversely, Reiche and Ford have filed counterclaims in the Civil Action against Applicant seeking, inter alia, declaratory judgment regarding the parties' respective claims to ownership of the involved mark in this proceeding.

The Board's policy is 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.

Trademark Rule 2.117(a); *General Motors Corp. v. Cadillac Fashions Inc.,* 22 USPQ2d 1933, 1937 (TTAB 1992).

Following a careful review of the pleadings in the Civil Action, the Board finds that a decision by the district court could have a bearing on the issues in this proceeding. In the present case, it remains unclear whether Opposer has or will join as a party to the Civil Action; however, the Board is persuaded that the underlying Civil Action may have a bearing on the present proceedings. Specifically, the individuals Reiche and Ford, owners of Opposer, have asserted counterclaims against Applicant that seek to determine Applicant's ownership of its involved mark. Opposer has also asserted a claim that Applicant is not the rightful owner of the mark in this proceeding. It is important to note that the explicit standard of Trademark Rule 2.117(a) is whether the proceeding **may** have a bearing, not that it must or definitely will, rather there only needs to exist a plausible situation whereby the proceeding could affect the determination of the matter before the Board. Trademark Rule 2.117(a). The Board finds that the determination(s) that result from the Civil Action, regardless of whether Opposer is ultimately added as a party to the action, may have a bearing on this proceeding.

The Board further notes that, to the extent that a civil action in a federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board. *See Wella Corp. v. Cal. Concept. Corp.*, 194 USPQ 419, 423 (CCPA 1977); *Midland Cooperatives, Inc. v. Midland Int'l Corp.*, 164 USPQ 579, 583 (CCPA 1970).

Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Finally, suspending this matter pending the final determination of the Civil Action will serve the interests of judicial economy.

For all of these reasons, Opposer's motion to suspend this proceeding pending final determination of the Civil Action is **GRANTED**. Accordingly, the proceedings are suspended pending final disposition of the Civil Action, including all appeals or remands of the Civil Action. Within **twenty days** after the final determination of the Civil Action, the parties must so notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment that issued in the Civil Action.

In view of the suspension, Applicant's motion to dismiss and motion to strike are each denied without prejudice. Upon resumption, if Applicant believes its motions pending at the time of the suspension and denied by this order were not resolved or made moot by the Civil Action, Applicant may renew the motion(s).

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.