

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JK/RG

March 19, 2021

Opposition No. 91266494

Jemie B.V.

v.

Growcentia, Inc.

J. Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Applicant's January 21, 2021 motion to suspend proceedings pending the final disposition of a civil action. The motion is fully briefed.

Amended Notice of Opposition

Initially addressing Opposer's amended notice of opposition, in Board proceedings, a plaintiff may amend its complaint once as a matter of course, beyond the initial 21 days from serving it, until the defendant files either an answer or a Rule 12(b), (e) or (f) motion. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 507.02 (2020).

On January 21, 2021, Opposer filed an amended notice of opposition. 4 TTABVUE. The amended notice of opposition was filed before Applicant filed an answer or otherwise responded to the original notice of opposition. Therefore, the amended

notice of opposition was filed as a matter of course and is deemed the operative pleading. Fed. R. Civ. P. 15(a)(1).¹

Analysis—Motion to Suspend

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 proceeding. The statutory authority, Trademark Rule 2.117(a), 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.

TBMP § 510.02(a). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. *Id.* A civil action may involve matters outside Board jurisdiction and may consider broader issues beyond right to registration; therefore, judicial economy is usually served by suspension. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (decision by district court may be binding on the Board).

Here, Applicant requests suspension of this opposition pending the final disposition of *Growcentia, Inc. v. Jemie B.V.*, Case No. 1:20-cv-02619 which it filed

¹ Opposer did not submit a red-lined copy showing the proposed changes in its amended notice of opposition, as recommended by the Board in all motions to amend pleadings. TBMP § 507.01. In the event that either party files any further amended pleading, it must include a red-lined copy as well as a clean copy.

The Board notes Applicant's answer to the amended notice of opposition, filed on February 3, 2021. 10 TTABVUE. Inasmuch as the Board did not previously acknowledge the amended notice of opposition as operative and set a deadline for Applicant to file its answer thereto, but said deadline would have been after February 3, 2021, Applicant's answer is deemed timely. Trademark Rules 2.105(a) and 2.106(b)(2).

against Opposer on August 28, 2020, in the United States District Court for the District of Colorado (“civil action”). 5 TTABVUE 6.

Contesting the motion to suspend, Opposer argues, inter alia, that some issues in the civil action have no bearing on this opposition proceeding or are different from the issues herein, and that it filed a motion to dismiss in the civil action under which that action “could be dismissed at any time.” 6 TTABVUE 2-4.

Applicant submitted with its motion a copy of the complaint for declaratory judgment filed in the civil action. 5 TTABVUE 6. Upon thorough review, the civil action involves the marks that are pleaded and are at issue in the likelihood of confusion claim in this opposition. 5 TTABVUE 11. Furthermore, in the civil action, Applicant asserts that the mark CANNCONTROL for the International Class 5 goods in its involved application is not likely to be confused with Opposer’s trademarks - including the pleaded registrations. 5 TTABVUE 17. Moreover, Applicant requests the relief of a declaratory judgment ruling that, in effect, its applied-for mark CANNCONTROL will not violate any of Opposer’s trademark rights. 5 TTABVUE 18.

Addressing Opposer’s argument that “should the motion to dismiss be denied, then a suspension would be more appropriate for the Board to consider,” (6 TTABVUE 3), the Board finds it more appropriate, in the service of judicial economy, to suspend while the motion to dismiss is pending in the civil action, then resume proceedings in the event that the motion to dismiss is granted and results in a final determination of the civil action.

Based on this record, the disposition of the civil action may have a bearing on the issues in this opposition, and therefore suspension is appropriate. In view of these findings, Applicant's motion is **granted**. Proceedings herein are **suspended** pending final disposition of the civil action.

Within twenty (20) 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. 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).

Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.²

During the period of suspension pending disposition of the civil action, and at any time thereafter, 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.

² A certified copy is not necessary; a clear and legible photocopy will suffice. TBMP § 106.03.