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

Proceeding	91266494
Party	Plaintiff Jemie B.V.
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Attachments	Opposition to Mot to Suspend.pdf(22960 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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JEMIE B.V.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91266494
)	
GROWCENTIA, INC.,)	
)	
Applicant.)	
)	

OPPOSITION TO MOTION TO SUSPEND

Growcentia, Inc. ("Growcentia") requests suspension of this opposition proceeding based on a declaratory judgment action that Growcentia filed against Jemie B.V. ("Jemie") in the U.S. District Court of the District of Colorado (the "Civil Action"). Jemie moved to dismiss the Civil Action on November 5th, 2020, and its motion is fully briefed and pending. In addition, the issues in the opposition proceeding and civil action do not squarely overlap, and some issues have no bearing on this proceeding. Thus, suspension of this proceeding is unnecessary and inappropriate.

ARGUMENT

I. The Board Should Not Suspend This Proceeding Because the Civil Action Is Likely To Be Dismissed.

Where the parties to an opposition proceeding are engaged in a civil action, "proceedings before the Board *may* be suspended until termination of the civil action." 37 C.F.R. § 2.117 (emphasis added). Such suspension is not required. "Suspension of a proceeding pending a civil action is a discretionary determination." *Abercrombie & Fitch Trading Co. v. Skull Shaver LLC*, 2020 WL 553712 (T.T.A.B. 2020)(non-precedential). In this case, the Board should not suspend

the opposition proceeding because the Civil Action could be dismissed at any time. In particular, Jemie has moved to dismiss the Civil Action both for lack of personal jurisdiction under Fed. R. Civ. P. 12(b)(2) and for insufficient service of process under Fed. R. Civ. P. 12(b)(5). The motion to dismiss, response and reply briefs are attached as Exhibit A for the Board's reference.¹ The merits of Jemie's position indicate that dismissal is likely and suspension is premature.

The mere filing of a civil action involving a mark that is subject to a proceeding before the Board should not be enough to suspend the proceeding where the viability of the civil action is subject to doubt, such as here where there is a fully-briefed motion to dismiss.

The decision cited by Growcentia, *Arcadia Grp. Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d 1134 (T.T.A.B. 2011), did not involve a pending motion to dismiss the civil action in question. Should the motion to dismiss be denied, then a suspension would be more appropriate for the Board to consider.

II. The Board Should Not Suspend This Proceeding Because the Civil Action Involves Issues in Dispute That Are Different And Narrower

The potential suspension should not turn simply on Growcentia's invocation of the CannControl mark. Growcentia's claims in the Civil Action rely on allegations concerning the role of its MAMMOTH mark, among other market conditions such as the labeling of the product, that have no bearing on the issues in this or any opposition proceeding. (Compl., ¶¶ 16, 33, 37 and 38). They simply do not relate to questions of registrability.

In addition, Growcentia has raised allegations concerning use of CannControl for a single, specific product. (Compl., ¶¶ 16, 33). Growcentia has applied for more goods than just that one in class 5. Growcentia acknowledges this difference in the complaint in which it lists out all the goods covered by the application, (Compl., ¶ 32), and yet focuses on the use of

¹ Supporting declarations and exhibits are not included due to the size.

CannControl with just the one product. (Compl., ¶ 33). Although Growcentia's complaint mentions the pending application and seeks relief concerning registrability, the core focus of the complaint is about likelihood of confusion over the use of CannControl in connection with a single product. The Board proceeding, by contrast, focuses on the intent-to-use CannControl for *all* the products of the application at issue in class 5.

CONCLUSION

Jemie respectfully submits that Growcentia has not established good cause to support a suspension. Merely filing a civil action relating to a mark should not create the basis for a suspension in all circumstances. Apart from the pending motion to dismiss, the Civil Action raises issues that have no bearing on the registrability of CannControl. For the reasons discussed above, the Board should deny Growcentia's motion and permit this opposition proceeding to continue.

Dated: January 24, 2021

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing **OPPOSITION TO MOTION TO SUSPEND** was served via email to Applicant's counsel of record as set forth below this 24th day of January, 2021.

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