

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

August 15, 2022

Opposition No. 91266633

Align Technologies Corp.

v.

Atlassian, Inc. and Atlassian Pty. Ltd.

Andrew P. Baxley, Interlocutory Attorney:

On August 12, 2022, Opposer filed a motion to suspend the above-captioned proceeding under Trademark Rule 2.117(a) pending final determination of a civil action styled *Align Technologies Corp. v. Atlassian US, Inc.*, Case No. 1:22-cv-00824, that is pending in the United States District Court for the Western District of Texas. Bearing in mind that a motion to suspend under Rule 2.117(a) is based almost entirely on a review of the pleadings at issue, the Board, in its discretion, elects to decide the motion now. *See* TBMP § 510.01 (2022) (the Board has inherent authority to control the scheduling of cases on its docket).

Under Trademark Rule 2.117(a), whenever the Board is made aware that a party or parties to a pending Board proceeding 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 final determination of the civil action or other Board proceeding. The civil action need not be dispositive of the Board proceeding to warrant

suspension; “it need only have a bearing on the issues before the Board.” *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. *See* TBMP § 510.02(a).

After reviewing the pleadings at issue, the Board finds that suspension of the above-captioned proceeding is warranted. In the notice of opposition herein, 1 TTABVUE, Opposer opposes registration of Applicant’s mark JIRA ALIGN for goods and services in International Classes 9 and 42¹ on the ground of likelihood of confusion with its previously used tradename and mark ALIGN for “computer software for project management, task, goal and issue tracking, communication and collaboration.” 1 TTABVUE 9-10. Applicant, in its answer, 4 TTABVUE, Applicant denies the salient allegations of the notice of opposition and asserts affirmative defenses. In the complaint in the civil action, Opposer seeks to enjoin permanently Applicant’s use of the involved mark, 30 TTABVUE 17-20, and asks the court to refuse registration of the involved mark. 30 TTABVUE 20-21. To begin with, a permanent injunction against Applicant’s use of the involved mark would preclude

¹ Application Serial No. 79273525, filed June 19, 2019, under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a).

Applicant from registering that mark. *See DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1950 (TTAB 2008). Moreover, the district court's determinations regarding the registrability of the involved mark may have a bearing upon Opposer's claim herein. Based on the foregoing, the Board finds that the civil action may have a bearing upon this proceeding, and the motion to suspend under Rule 2.117(a) is granted.

Opposer's motion to suspend is granted, and the above-captioned proceeding is suspended pending final determination of the aforementioned civil action between the parties.² The Board will make annual inquiry as to the status of the civil action. Within twenty days of such final determination, Applicant shall notify the Board in writing and include a copy of all relevant final decisions in that notification. While this case is suspended, the parties must keep their correspondence addresses current.

² A proceeding is 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. *See* TBMP § 510.02(b).