UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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November 1, 2023

Opposition No. 91274066

Nairobi 1932, Inc.

v.

Radian Group Inc.

Cheryl Butler, Senior Level Attorney, Trademark Trial and Appeal Board:

Now before the Board is Opposer's August 21, 2023 (22 TTABVUE) motion to suspend this proceeding pending a civil action. The motion is denied.

BACKGROUND

Radian Group Inc. ("Applicant") seeks registration on the Principal Register of the marks TITLEGENIUS,[1] in standard characters, and the mark 

[2], both for the services listed below:

> Educational services provided through a website, namely, providing online articles and other written information, namely, online fact sheets, and non-downloadable webinars and informational videos, all

[1] Serial No. 90530815, filed February 16, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's bona fide intent to use the mark in commerce.

[2] Serial No. 90530819, filed February 16, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's bona fide intent to use the mark in commerce.
The mark consists of the word "titlegenius" shown in lowercase letters. To the left of the word "titlegenius" is a drawing of a partial house outline with two curved lines making up the remainder of the house drawing.

> in the field of title insurance and fees for title insurance, in International Class 41, and
>
> Software as a service services featuring software which provides a communications portal that allows consumers, real estate agents, lenders and brokers to obtain title rate quotes, order title insurance, obtain closing and settlement services for purchase and refinance transactions, upload documents and make payments, in International Class 42

Nairobi 1932, Inc. ("Opposer") filed a Notice of Opposition against the registration of Applicant's marks alleging likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). 1 TTABVUE. In the Opposition, Opposer claimed ownership of its application for the mark TITLEGENIUS, in standard characters, for the services listed below:

> (Based on Use in Commerce) Educational services provided through a website, namely, providing classes, seminars, programs, and non-downloadable webinars regarding title insurance and fees for title insurance, in International Class 41, and
>
> (Based on Intent to Use) Non-downloadable software as a service which provides a communications portal that allows consumers, real estate agents, lenders and brokers to obtain title rate quotes, order title insurance, obtain closing and settlement services for purchase and refinance transactions, upload documents and make payments, in International Class 42.[3]

[3] Serial No. 90847812 filed July 26, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use and date of first use in commerce of February 13, 2020 in International Class 41, and under Trademark Act Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's bona fide intent to use the mark in commerce in International Class 42.

On June 14, 2023, the Trademark Trial and Appeal Board (Board) entered judgment against Opposer and dismissed the instant opposition with prejudice under 37 C.F.R. § 2.132(a)in light of its failure to prosecute its case. 19 TTABVUE.

On August 4, 2023, Opposer sought an extension of time until October 6, 2023, "to file a de novo civil action in the Middle District of Florida." 21 TTABVUE 2. The motion was granted. 21 TTABVUE.

CIVIL ACTION COMMENCED

On August 3, 2023, Opposer initiated a civil action in the United States District Court Middle District of Florida, Case No. 6:23-cv-01490-ACC-RMN, styled *Nairbi 1932, Inc. v. Radian Group, Inc.* Nairobi 1932, Inc., alleging counts of trademark infringement, unfair competition and false advertising, seeks as relief: 1) a permanent injunction barring Radian Group, Inc. from improperly using, or registering, the mark TITLEGENIUS for use in commerce in the United States; 2) monetary damages; and 3) attorney's fees.[4] 22 TTABVUE.

Opposer described the prior litigation before the Board but does not seek review of the Board's final decision. *Id.* at 4-5. Opposer notes for the court that an unsuccessful proceeding in the Board does not preclude a party from bringing related claims, such as a trademark infringement action, in federal courts, or seeking relief that is not available in a Board proceeding. *Id.* at 5. Opposer notes that the Board has limited jurisdiction only to determine the right to register a trademark and

[4] The Board construes the complaint filed in the district court as a complaint filed under the statutory provision of Trademark Act Section 37, 15 U.S.C. 1119 as opposed to Trademark Act Section 21, 15 U.S.C. 1071, which relates to a complaint filed for review of a final decision of the TTAB.

cannot determine whether a party has a right to use the mark or provide any remedy beyond cancellation of a registration. *Id.*

AVENUES OF APPEAL OF A TTAB DECISION

A party to a Board proceeding who is dissatisfied with the final decision of the Board is provided, under the Trademark Act, with two possible (mutually exclusive) remedies:

> (1) Appeal to the United States Court of Appeals for the Federal Circuit ("Federal Circuit"), which will review the decision from which the appeal is taken on the record before the USPTO, 15 U.S.C. § 1071(a), or
>
> (2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear," 15 U.S.C. § 1071(b).

See also TBMP § 901.

Notably, Opposer does not seek review of the Board's final decision. There are no provisions otherwise to support suspension of the Board's case, in which a final decision issued, where the civil action commenced is not for review of the Board's decision.

Accordingly, this opposition proceeding will be terminated in due course and Radian Group, Inc.'s use-based applications, Serial Nos. 90530819 and 90530815, will be forwarded to issuance of a registration. Opposer's remedy lies in successfully litigating its case before the district court and requesting relief to include cancellation of any such registrations. *See* 15 U.S.C. § 1119, which provides as follows:

> In any action involving a registered mark the court may determine the right to registration, ***order the cancellation of registrations***, in whole or in part,

> restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

(Emphasis added.)