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

Proceeding no.	91281704
Party	Plaintiff Viahart LLC
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Submission	Motion to Suspend for Civil Action
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Date	12/06/2022
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Application Nos. 97024919 & 97025034

For the marks: CREATIVE FLAKES and CREATIVE KIDS FLAKES

Published: September 20, 2022

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VIAHART LLC	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition Number: 91281704
	:	
CREATIVE KIDS ONLINE LLC	:	
	:	
Applicant.	:	
-----X	:	

MOTION TO SUSPEND PROCEEDING PURSUANT TO 37 C.F.R. § 2.117

Opposer Viahart LLC (“Viahart”), moves to suspend this proceeding pursuant to 37 C.F.R. § 2.117(a) pending the determination of *Viahart, LLC v. Creative Kids Online, LLC*, No. 1:20-CV-09943-GHW (S.D.N.Y.)—a federal lawsuit pending in the Southern District of New York. As discussed below, the ultimate decision in the pending lawsuit is likely to have a bearing on the outcome of this proceeding, and suspension is therefore warranted at this stage.

STATEMENT OF FACTS

A. General Background

Viahart designs, manufactures, and sells BRAIN FLAKES—a line of toys that are sold under the Viahart line. Viahart has used the BRAIN FLAKES mark in United States commerce as early as February 16, 2014, in connection with educational children’s toys consisting of high quality, manipulative interconnecting disc construction toys. On September 27, 2016, Viahart was granted registration for the BRAIN FLAKES word mark under U.S. Registration No. 5,049,910 (the “Registered Mark”) in International Class 28 for “Children's educational toys for developing fine motor skills and engineering skills; Construction toys; Stacking toys; Toy building blocks; Toy building blocks capable of interconnection; Toy construction sets.” 1 TTABVUE, Ex. 1.

Beginning around 2017, Applicant Creative Kids Online, LLC (“Applicant”) began using the name “Brian Flakes” on the packaging of its products consisting of interlocking plastic disc sets. Applicant referred to its products in marketing materials as “Creative Kids Brain Flakes” or Creative Kids Flakes”—while still using Viahart’s Registered Mark and the image of a brain with the image of a disc on product packaging. 1 TTABVUE, Ex. 4. In 2018, Viahart sent notice to Applicant about its infringement of the Registered Mark. Despite this, Applicant did not cease said use, and instead continued selling its products.

On September 13, 2021, Applicant filed U.S. Trademark Application Nos. 97024919 and 97025034 for the CREATIVE FLAKES and CREATIVE KIDS

FLAKES marks (“Applicant’s Marks”) based on an intent to use said marks in commerce under 15 U.S.C. § 1051(b). Each application for Applicant’s Marks covers “Children's educational toys for developing counting skills; Children's educational toys for developing fine motor skills; Construction toys; Stacking toys; Toy construction blocks” in International Class 28. 1 TTABVUE, Ex. 3.

B. Federal Court Action

On November 25, 2020, Viahart brought suit against Applicant in the Southern District of New York—alleging, among other things, Trademark Infringement and Counterfeiting under 15 U.S.C. §1114, Unfair Competition under 15 U.S.C. §1125(a), Common Law Unfair Competition, and Common Law Trademark Infringement. *Viahart, LLC v. Creative Kids Online, LLC*, No. 1:20-CV-09943-GHW (S.D.N.Y.). Central to said lawsuit is Viahart’s claim that Applicant’s use of CREATIVE FLAKES and CREATIVE KIDS FLAKES in connection with children’s interlocking plastic disc sets is likely to cause consumer confusion with Viahart’s Registered Mark.

ARGUMENT

A motion to suspend is governed by 37 CFR § 2.117(a) which provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action . . . may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action A civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought.

37 CFR § 2.117(a); *see also* TBMP § 510.02(a) (“Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court”). In the absence of unusual circumstances, the “Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” TBMP § 510.02(a) There is no requirement the determination will likely be dispositive of the Board proceeding but only that it may have a bearing on the proceeding. *See Id.* (citing, in part, *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011)).

The final determination in the federal infringement lawsuit before the Southern District of New York is likely to have a bearing on the issues before the Board, as said lawsuit concerns the same facts, parties, and legal question as to whether Applicant’s use of CREATIVE FLAKES and CREATIVE KIDS FLAKES causes a likelihood of confusion with Viahart’s Registered Mark. Said lawsuit is still pending before the Southern District of New York, has not been terminated as of the date of this filing, and focuses on the same likelihood of confusion issue central to this opposition proceeding. The Southern District of New York’s determination of this question of law is therefore highly likely to have a bearing on the outcome of this proceeding.

CONCLUSION

Because the legal question as to whether Applicant’s use of CREATIVE FLAKES and CREATIVE KIDS FLAKES causes a likelihood of confusion with

Viahart's Registered Mark is a central issue currently pending before the Southern District of New York, the determination of said issue is highly likely to have a bearing on this proceeding. Viahart therefore respectfully submits that this proceeding should be suspended pursuant to 37 C.F.R. § 2.117(a).

Dated: December 6, 2022

Respectfully submitted,

CREEDON PLLC

By: /s/ Charles A. Wallace

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ATTORNEYS FOR OPPOSER
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CERTIFICATE OF SERVICE

I certify that a true and complete copy of the foregoing document was served on Creative Kids Online, LLC by forwarding said copy on December 6, 2022, via email to Andrew D. Bochner at andrew@bochnerip.com and at uspto@bochnerip.com.

By: /s/ Charles A. Wallace
Charles A. Wallace