

UNITED STATES PATENT AND TRADEMARK OFFICE
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KGC

October 3, 2023

Opposition No. 91285094

Juda Ohana

v.

EXP Corp.

By the Trademark Trial and Appeal Board:

This proceeding is before the Board for consideration of Applicant's motion to dismiss, pursuant to Fed. R. Civ. P. 12(b)(6), the notice of opposition filed in lieu of an answer thereto (7 TTABVUE),¹ and Opposer's motion to suspend this proceeding pending disposition of a civil action in the U.S. District Court for the Eastern District of New York: *EXP Corp USA v. Juda Ohana*, Civil Action No. 1:23-cv-05480 (10 TTABVUE). The motion to suspend is fully briefed.²

¹ In this order, citations to the record in this proceeding are to TTABVUE, the Board's online docketing system. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); see also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 106.03 (2023). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. The Board expects the parties to use this method of citing to the record throughout this proceeding.

² The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion. The Board does not recount the facts or arguments here, except as necessary to explain the Board's order. See *Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Preliminary Matter

Opposer's brief in response to the motion to dismiss was due by August 9, 2023. *See* Trademark Rule 2.127(a). Inasmuch as Opposer failed to file such a submission, the Board could treat the motion as conceded.³ *See id.* Notwithstanding, during this time, Opposer filed its motion to suspend.

Pursuant to Trademark Rule 2.117(b), “[w]henver there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.” “The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.” TBMP § 510.02(a). “However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.” *Id.*

In view thereof, and inasmuch, as will be discussed, suspension of this opposition pending final determination of the civil action is warranted, the Board exercises its discretion and considers the motion to suspend without deciding the motion to dismiss, which is **deferred**. In the event this opposition resumes, the motion to

³ “However, the Board, in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits.” TBMP § 502.04 and authority cited therein.

dismiss may be decided at that time. However, if the civil action is finally determined to be dispositive of this opposition, then the motion to dismiss may be moot.⁴

Notwithstanding, the parties are reminded that it is incumbent that they timely respond to motions, otherwise the Board is within its authority to grant such motions as conceded. *See* Trademark Rule 2.127(a).

II. Motion to Suspend

A. Standard

Trademark Rule 2.117(a) provides, in relevant part, that “[w]henver 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.” Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of another proceeding may have a bearing on the issues before the Board. *See New Orleans La. Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (“Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.”). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the Board’s discretion. TBMP § 510.02(a). A civil action may involve other matters outside the Board’s jurisdiction and may consider broader

⁴ For this reason, the Board finds that the motion to suspend is germane to the motion to dismiss. *See* 9 TTABVUE 1.

issues beyond the right to registration,⁵ and, therefore, judicial economy is usually served by suspension. *See Goya Foods, Inc. v. Tropicana Prods., Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the USPTO).

B. Analysis

The Board has reviewed the civil action complaint, which was submitted with the motion to suspend. 10 TTABVUE 4-22. Opposer in this opposition is the defendant in the civil action, and Applicant in this opposition appears to be the plaintiff in the civil action.⁶ In addition, in the civil action, Applicant/plaintiff pleads ownership of the mark BROOKLYN LAB for coffee, which is at issue in this opposition. *Id.* at 5, ¶ 3. The civil action complaint also contains allegations pertaining to this opposition, including Opposer/defendant's pleaded application and common-law rights. *E.g., id.* at 9-10, ¶¶ 35, 41. Further, in the civil action, Applicant/plaintiff alleges a likelihood of confusion (*id.* at 12, ¶ 55) and seeks a declaratory judgment that "there was no fraud in [its] application with the USPTO for the registration of the 'Brooklyn Lab' mark" (*id.* at 20, ¶ 120), which are claims at issue in this opposition (1 TTABVUE 5-

⁵ The parties are reminded that the Board's jurisdiction is restricted to determining the right to register; it may not determine infringement or unfair competition claims, such as those that are the subject of the civil action. *See* TBMP § 102.01 and authority cited therein.

⁶ Applicant is identified as EXP Corp. whereas the plaintiff is identified in the caption of the civil action as Exp Corp USA, which the plaintiff shortens in the body of the complaint to "EXP Corp." Further, there is no indication in the parties' submissions that these entities are different.

6, ¶¶ 12, 15). Applicant/plaintiff also requests in the civil action “[p]reliminary and permanent injunctive relief enjoining [Opposer/]Defendant and its agents, attorneys, employees, and all others in active concern or participation with them from: ... using the ‘Brooklyn Lab’ mark unless expressly and specifically authorized by Plaintiffs.” 10 TTABVUE 20, ¶ 1.

In view thereof, the Board finds that any decision that is issued in the civil action may bear on this opposition, in particular, the claims of likelihood of confusion and fraud as well as Opposer’s entitlement to a statutory cause of action.

C. Decision

Accordingly, and given the Board’s policy to suspend proceedings if the final determination of another proceeding may have a bearing on the issues before it, Opposer’s motion to suspend this proceeding pending disposition of the civil action is **granted**, and the Board, in its discretion, **suspends** this opposition pending final determination 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.⁷ Such notification to the Board should include a copy of any final order or final judgment that issued in the civil action. A certified copy is not necessary; a clear and legible photocopy will suffice. TBMP § 106.03.

⁷ 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. *See* TBMP § 510.02(b).

During the suspension period, the parties must notify the Board of any address or email address changes for the parties. 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.