

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: March 16, 2010

Cancellation No. 92051017

Forethought Financial
Services, Inc.

v.

Enigma Marketing & Travel
Solutions, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on respondent's motion to suspend proceedings pending the disposition of a civil action between the parties, filed July 29, 2009. The motion is contested.

The Board regrets the delay in addressing this matter, and considers all matters, including the deadline to file an answer, to have been suspended with the filing of this motion. The Board sua sponte initiated a phone conference on March 16, 2009. The participants were Louis Perry, attorney for opposer, David Klinestiver, attorney for applicant, and Elizabeth Dunn, attorney for the Board.

As background the Board notes that the petition to cancel brings claims of likelihood of confusion between petitioner's mark FORETHOUGHT, the subject of four pleaded registrations for underwriting insurance, banking, and business and financial services, and respondent's mark EXCLUSIVELY FORE THOUGHT for services coordinating travel arrangements for individuals and groups, fraud, lack of bona fide intent to use, non-use, and lack of ownership. In lieu of an answer, respondent filed the instant motion to suspend proceedings.¹

In support of its motion respondent submits the pleadings in *Enigma Marketing & Travel Solutions, Inc. v.*

¹ The need to schedule a discovery conference and to exchange initial disclosures is contingent upon the filing of an answer. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42245 (Aug. 1, 2007) ("Because disclosure is tied to claims and defenses, in general, a defendant's default or the filing of various pleading motions under Federal Rule 12 will effectively stay the parties' obligations to conference and, subsequently, make initial disclosures. An answer must be filed and issues related to the pleadings resolved before the parties can know the extent of claims and defenses and, therefore, be able to discuss the extent of their initial disclosure obligations, plans for discovery, and the possibility of settlement.").

No consideration will be given to petitioner's initial disclosures filed October 5, 2009. "Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period." Trademark Rule 2.120(j)(8).

Forethought Financial Services, Inc. (Cause No. 1:09-CV-0473-DFH-JMS), now pending in the United States District Court for the Southern District of Indiana, Indianapolis Division. In that action the district court will decide, among other issues, whether petitioner's use infringes respondent's registered mark and if respondent's registration should be cancelled. Respondent notes that petitioner filed its counterclaim in the district court action on the same day - May 22, 2009 - that it filed the instant petition to cancel.

In opposition to suspension petitioner contends that the issues between the parties are more appropriate to resolution by the Board and that, to that end, petitioner has sought a stay of the district court action pending the resolution of this cancellation proceeding. Petitioner also contends that the parties could employ ACR (accelerated case resolution) procedures to expedite a decision in this proceeding, which would reduce the number of issues to be decided by the district court.

On December 21, 2009, the district court issued an order denying petitioner's motion to stay the civil action pending disposition of this cancellation proceeding. The district court noted that the Board's order in this proceeding would leave several issues unresolved, including the remedies of injunction and damages.

As noted, one of the issues before the district court is cancellation of the registration which is the subject of this proceeding. There would be unnecessary duplication of resources in trying the same issue in two fora. Moreover, the district court's decision will be binding upon the Board. Accordingly, respondent's motion to suspend is granted, and proceedings herein are suspended pending the district court's resolution of the civil action between the parties.

Within twenty days after the final determination of the civil action, respondent should notify the Board so that this case may be called up for appropriate action.

During the suspension period the Board should be notified of any address changes for the parties or their attorneys.
