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

Proceeding	92058018
Party	Plaintiff Health & Sun Research, Inc. d/b/a Kava Kava Intl.
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Submission	Opposition/Response to Motion
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Date	12/09/2013
Attachments	HSR Response in Opposition to Motion to Suspend for Civil Action 12_9_13 (2).PDF(13297 bytes)

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

Health & Sun Research, Inc. d/b/a)	
Kava Kava Intl.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92058018
)	Registration No. 4,805,143
Australian Gold, LLC)	
)	
Registrant.)	

RESPONSE IN OPPOSITION TO MOTION TO SUSPEND FOR CIVIL ACTION

Petitioner, Health & Sun Research, Inc. d/b/a Kava Kava Intl. (“Health & Sun”) hereby files its Response in Opposition to Registrant’s, Australian Gold, LLC (“Australian Gold”), Motion to Suspend the present Cancellation Proceeding and states as follows:

On October 11, 2012, Health & Sun filed a Complaint against Australian Gold in the Middle District of Florida Tampa Division, Case No. 8:12-cv-02319 (the “Civil Action”). The Civil Action involves, *inter alia*, Australian Gold’s violations of Health & Sun’s common law trademark rights in the PURPLE RAIN mark. The Complaint in the Civil Action does not seek cancellation of the PURPLE REIGN mark. However, through the discovery process in the Civil Action, it was revealed that Australian Gold owns U.S. Trademark Reg. No. 4,085,143 for the trademark PURPLE REIGN. Health & Sun contends there is a likelihood of confusion between the respective marks and products.

As a threshold matter, 37 C.F.R. §2.117 is permissive and provides the Board may, *but is not required to*, suspend a proceeding until termination of a civil case where the civil case may have a bearing on the current proceeding. In this instance, the ongoing Civil Action does not require suspension of the current cancellation proceeding. Indeed, even though the current

cancellation proceeding and the Civil Action may have common issues of fact, the remedies in each proceeding are different, as cancellation of the PURPLE REIGN mark is not at issue in the Civil Action. Thus, to the extent Health & Sun is successful on its claims in the Civil Action, it would still be required to litigate the cancellation proceedings in order to achieve cancellation of the PURPLE REIGN mark.¹ Likewise, if the cancellation proceedings were to be suspended, Health & Sun would be deprived of the opportunity to achieve a complete remedy. Therefore, continuation of the cancellation proceedings simultaneously with the Civil Action does not result in any duplication of efforts.

Accordingly, Health & Sun requests the Australian Gold's Motion to Suspend be denied in its entirety.

Respectfully submitted,

/s/ Eric R. Pellenbarg
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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of Petitioner's Response in Opposition to Motion to Suspend for Civil Action was filed with the TTAB and served on Charles J. Meyer, Esq., counsel for Registrant, via U.S. First Class Mail: Woodard, Emhardt, Moriarty, McNett &

¹ Undersigned counsel indicated Health & Sun would be agreeable to suspension of the current proceeding in exchange for Australian Gold's agreement to cancellation of the PURPLE REIGN mark if Health & Sun were to prevail on its claims in the Civil Action at the upcoming trial. However, Australian Gold did not agree to such an arrangement and, instead, filed the subject Motion to Suspend.

Henry, LLP, Chase Tower, 111 Monument Circle, Suite 3700, Indianapolis, Indiana 46204 and
electronic mail (cjmeyer@uspatent.com) this **9th day of December, 2013**.

/s/ Eric R. Pellenbarg
Eric R. Pellenbarg, Esq.