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

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|------------------------|---|
| Proceeding | 92065591 |
| Party | Plaintiff Monster Energy Company |
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| Submission | Motion to Suspend for Civil Action |
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| Signature | /Julianna M. Simon/ |
| Date | 05/03/2017 |
| Attachments | 2017-05-03 PETITIONER_S MOTION TO SUSPEND FOR CIVIL ACTION- HANBEV.5881N.pdf(135490 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MONSTER ENERGY COMPANY,

Petitioner,

v.

INTEGRATED SUPPLY NETWORK, LLC,

Respondent.

)
) Cancellation No.: 92065591
)
) Registration No.: 4,951,671
)
) Mark:
)
)
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**PETITIONER MONSTER ENERGY COMPANY’S MOTION TO SUSPEND
FOR CIVIL ACTION**

Pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02, Petitioner Monster Energy Company (“Petitioner”) hereby requests that the Trademark Trial and Appeal Board (the “Board”) suspend the above-captioned Cancellation pending the determination of a pending federal lawsuit between Petitioner and Respondent claiming trademark infringement, trade dress infringement, false designation of origin, and unfair competition (“the Lawsuit”). On May 2, 2017, the Board granted Petitioner’s motion to suspend a related Opposition, Opposition No. 91222672, pending the outcome of the Lawsuit. On May 2, Petitioner’s counsel requested that Respondent’s counsel stipulate to this Motion to Suspend Cancellation No. 92065591 in view of the Board’s suspension of the related Opposition No. 91222672. As of the filing of this motion, Respondent’s counsel has not responded to that request. Petitioner respectfully requests that the Board grant this Motion to Suspend this Cancellation action.

I. FACTUAL BACKGROUND

On July 1, 2015, Petitioner filed Opposition No. 91222672 (the “Opposition”). Petitioner’s Notice of Opposition alleges, among other things, that Petitioner will be damaged by



registration of Respondent’s mark in that the mark so resembles Petitioner’s trade dress (the “MONSTER Trade Dress”) and MONSTER-inclusive trademarks registered and applied for in the United States Patent and Trademark Office, and in which Petitioner owns common law trademark rights (“MONSTERTM Marks”), as to be likely, when used on or in connection with Respondent’s goods, to cause confusion, to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act.

Petitioner filed this Cancellation on March 6, 2017. Petitioner’s Notice of Cancellation alleges, among other things, that Petitioner has been and will continue to be damaged by the continued registration of the mark shown in U.S. Trademark Registration No. 4,951,671 for the



mark (the “Subject Registration”) in that the mark so resembles Petitioner’s MONSTERTM Marks as to be likely, when used on or in connection with Respondent’s services, to cause confusion, to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act.

On March 22, 2017, Petitioner filed a lawsuit against Respondent in the U.S. District Court for the Central District of California – *Monster Energy Company v. Integrated Supply Network, LLC*, Civil Action No. 5:17-CV-00548-CBM-RAO (“the Lawsuit”). Attached hereto as Exhibit A is a true and correct copy of the Complaint filed by Petitioner. The Lawsuit alleges



that Respondent's use of Respondent's mark, which is the subject of the Subject Registration, infringes most of the MONSTERTM Marks identified in Petitioner's Petition for Cancellation. Further, the allegedly infringing goods identified in the Lawsuit are highly related to the services that are the subject of the Subject Registration.

On May 2, 2017, the Board granted Petitioner's motion to suspend the Opposition pending the determination of the Lawsuit. The Board ruled that the Lawsuit could have a bearing on the issues in the Opposition because the Lawsuit involves many of the same marks at issue in the Opposition and the decision in the Lawsuit would be binding on the Board to the extent the Lawsuit involves issues in common with the Opposition. On May 2, 2017, Petitioner's counsel requested Respondent's counsel to stipulate to the suspension of this Cancellation in view of the Board's order. As of the filing of this motion, Petitioner has not received a response.


**II. THIS CANCELLATION SHOULD BE SUSPENDED PENDING A FINAL DECISION
IN THE LAWSUIT WHICH INVOLVES THE SAME PARTIES AND SIMILAR ISSUES
OF FACT AND LAW**

It is proper for the Board to suspend a cancellation proceeding where, as here, there is a co-pending civil action involving the same parties that may have a bearing on an issue in the Cancellation proceeding. *See* 37 C.F.R. § 2.117(a) ("Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action."). "The only question for determination [by the Board], therefore, is whether the outcome of the civil action will have a bearing on the issues

involved in the [Board] proceeding.” *The Other Tel. Co. v. Conn. Nat’l Tel. Co.*, 181 U.S.P.Q. 125, 127 (T.T.A.B. 1974). A copy of the complaint from the civil action is usually sufficient for the Board to make that determination. *Id.* (Based on the allegations in the complaint, “[i]t is clear . . . that the final determination of the civil suit will directly affect the resolution of the issue of likelihood of confusion which is involved in the proceeding before the Trademark Trial and Appeal Board.”).

Petitioner respectfully asserts that the Board should suspend the Cancellation proceeding until the Lawsuit is resolved because the Lawsuit not only has a bearing on, but should resolve, the legal and factual issues in this Cancellation proceeding. Petitioner alleges in the Lawsuit,



among other things, that Respondent’s use of the  mark in connection with Respondent’s goods, which are highly related to the services that are the subject of the Subject Registration, infringes many of Petitioner’s MONSTERTM Marks. Accordingly, the Lawsuit will require a determination of the same issues bearing on the likelihood of confusion claim at issue in this Cancellation proceeding.

In view of the related nature of the legal and factual issues present in the Lawsuit and this proceeding, resolution of the Lawsuit will have a bearing on and may dispose of the issues in this proceeding. *See generally* T.B.M.P. § 510.02(a) (“[T]o the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is typically binding upon the Board. . .”); *see also Daimler Chrysler Corp. v. Maydak*, 86 U.S.P.Q.2d 1945, 1950 (T.T.A.B. 2008). Where this is the case, “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.” T.B.M.P. § 510.02(a); *see also*

Gen. Motors Corp. v. Cadillac Club Fashions Inc., 22 U.S.P.Q.2d 1933, 1936-37 (T.T.A.B. 1992).

Accordingly, in the interests of avoiding the burden associated with maintaining two parallel proceedings involving issues that have a bearing on one another, Petitioner respectfully requests suspension of the Cancellation until resolution of the Lawsuit. Proceeding with this Cancellation during the pendency of the Lawsuit will waste the resources of the parties and the Board. Therefore, it is in the best interest of the parties and the Board to suspend this Cancellation pending the outcome of the Lawsuit.

III. CONCLUSION

For the reasons set forth above, Petitioner respectfully requests that the Board suspend this proceeding pending the outcome of the Lawsuit.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 3, 2017

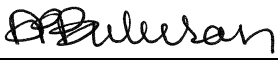
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITIONER MONSTER ENERGY COMPANY'S MOTION TO SUSPEND FOR CIVIL ACTION** has been served on Applicant's counsel on May 3, 2017 via electronic mail to:

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Date: May 3, 2017

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