

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Baxley

Mailed: February 6, 2018

Cancellation No. 92067621

*Family Express Corporation*

*v.*

*Richard A Comer, Jr.*

**Andrew P. Baxley, Interlocutory Attorney:**

Pursuant to the Board's January 30, 2018 order, Respondent, on January 31, 2018, filed copies of pleadings in a civil action styled *Family Express Corp. v. Square Donuts, Inc.*, Case No. 2:16-cv-103, filed in the United States District Court for the Northern District of Indiana ("the civil action"), upon which his motion (filed January 30, 2018) to suspend the above-captioned proceeding is based.<sup>1</sup> Petitioner filed a brief in opposition to the motion to suspend. Although Respondent's time to file a reply

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<sup>1</sup> Petitioner's genericness claim in the above-captioned proceeding is based on an assertion that the mark SQUARE DONUTS is "the generic name for any square-shaped donut." 1 TTABVUE 9. The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. See *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986). Thus, a proper genericness inquiry is based on the recited services in the registration at issue, in this case "café services." See Trademark Act Section 14(3), 15 U.S.C. § 1064(3); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991). However, a term can be generic for a genus of services if the relevant public understands the term to refer to a key aspect of that genus, e.g., a key good that characterizes a particular genus of cafe services. See *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016). If appropriate, Petitioner may be allowed to replead the genericness claim herein if this proceeding goes forward.

brief has not lapsed, the Board, in its discretion, elects to decide the motion to suspend now. *See* Trademark Rule 2.127(a); TBMP § 510.02(a) (June 2017).

“Whenever it shall come to the attention of the ... 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 or the other Board proceeding.” Trademark Rule 2.117(a). *See* TBMP § 510.02(a). The civil action need not be dispositive of the Board proceeding to warrant suspension; “it need only have a bearing on the issues before the Board.” *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). To 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 binding upon the Board.<sup>2</sup> *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

Petitioner’s assertion that suspension is inappropriate because Respondent is not a party to the civil action is incorrect. Suspension may be appropriate where *a party* to a pending Board proceeding is involved in a civil action that may have a bearing upon the Board proceeding. *See* Trademark Rule 2.117(a). Even if Respondent has not yet been joined as a party defendant in the civil action, the civil action may have a bearing upon Petitioner’s claims herein inasmuch as Petitioner seeks cancellation of Respondent’s involved registration therein. 9 TTABVUE 12. Moreover, to prevail

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<sup>2</sup> Likewise, a Board decision, in certain circumstances, may provide a basis for application of issue preclusion. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 113 USPQ2d 2045 (2015).

on the counterclaim in the civil action for infringement, Square Donuts, Inc., through its owner Respondent, may be required to establish their trademark rights in the mark SQUARE DONUTS. The district court's determination as to whether such rights exist may have a bearing upon this proceeding.

Accordingly, in the interests of judicial economy and of avoiding possibly inconsistent results, the Board finds that suspension of the above-captioned proceeding pending final determination of the civil action is warranted. Respondent's motion to suspend is therefore granted. Proceedings herein are suspended pending final determination, including any appeals or remands, of the civil action.

The Board will make annual inquiry as to the status of the civil action. Within twenty days of the final determination of the civil action, Respondent shall notify the Board in writing,<sup>3</sup> so that the Board can take appropriate action. While this proceeding is suspended, the parties shall keep their correspondence addresses current.

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<sup>3</sup> Such notification should include copies of relevant decisions from the civil action.