

ESTTA Tracking number: **ESTTA939987**

Filing date: **12/07/2018**

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

Proceeding	92069730
Party	Defendant Blunt Wrap U.S.A., Inc.
Correspondence Address	RBENNETT FORD JR ROY KIESEL FORD DOODY & THURMON APLC P O BOX 15928, 9100 BLUEBONNET CENTER BLVD STE 100 BATON ROUGE, LA 70895-5928 UNITED STATES BAN@RoyKiesel.com, rbf@roykiesel.com, blp@roykiesel.com, ask@roykiesel.com 225-927-9908
Submission	Reply in Support of Motion
Filer's Name	R. Bennett Ford
Filer's email	rbf@roykiesel.com, blp@roykiesel.com, info@roykiesel.com
Signature	/R. Bennett Ford/
Date	12/07/2018
Attachments	Reply Memo.pdf(176966 bytes)

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

New Image Global, Inc	§	Registration No. 5,530,554
	§	
Petitioner	§	
	§	
v.	§	Cancellation No. 92/069,730
	§	
Blunt Wrap U.S.A., Inc.	§	
	§	
Registrant	§	Mark: DOUBLEXL

**Reply Memorandum in Support of Registrant’s Motion to Suspend
Proceedings and Other Deadlines**

NOW COMES Registrant, Blunt Wrap U.S.A., Inc., in Reply to Petitioner’s Opposition to Registrant’s Motion to Suspend the current proceedings pending the outcome of related litigation between the parties in federal district court in California.

I. All of the Issues Need Not Overlap for Suspension to Be Appropriate

Petitioner contends that it has raised fraud on the Trademark Office in the present cancellation action, but that it did not raise fraud on the Trademark Office in the Civil Action. This is true. However, it does not change the fact that Petitioner also alleged in the Civil Action that confusion is likely to arise from Petitioner’s use of the mark in registration no. 4,057,940 and Registrant’s use of its DOUBLEXL mark. Nor does it change the fact that in these proceedings, Petitioner is seeking to cancel Registrant’s trademark registration no. 5,530,554 for the DOUBLEXL mark based on an alleged likelihood of confusion with the mark in Petitioner’s ‘940 Registration.. In both the Civil Action and the present proceedings, Petitioner alleges a likelihood of confusion conflict between the marks in Petitioner’s ‘940 Registration and Registrant’s ‘554 Registration. The

likelihood of confusion issues raised in the Civil Action have a bearing on the present proceedings, regardless of what other issues might not overlap between the Civil Action and these proceedings.

The Civil Action does not have to be dispositive of the Board proceedings. They only need to have a bearing on them. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). The likelihood of confusion issues raised in the Civil Action undeniably have a bearing on the present action. Accordingly, the Board should suspend this action pending the resolution of the Civil Action.

II. Registrant's Motion to Dismiss or Transfer in the Civil Action Does Not Effect this Motion to Suspend

Petitioner contends these proceedings should not be suspended because Registrant has filed a motion to dismiss the Civil Action. Registrant first observes that it did not file a motion to dismiss; Registrant filed a motion to dismiss or transfer.

Registrant and Petitioner are parties to a license agreement. That Agreement is referenced in Registrant's Memorandum in Support of its Motion to Dismiss or Transfer, filed in the Civil Action. *See*, Exhibit A to Petitioner's November 26, 2018 Memorandum, at p. 25. The Agreement includes a forum selection clause, which provides "all disputes under this Agreement will be resolved by the United States District Court for the Eastern [District of Louisiana] Court, and the parties all consent to the jurisdiction of such court . . . and hereby waive any jurisdictional and/or venue defenses otherwise available to [them]." *Id.*

Petitioner did not file the Civil Action in the Eastern District of Louisiana. The Civil Action was filed in federal court in Los Angeles. Thus, one possible outcome of Registrant's motion in the

Civil Action is that the action is transferred to the Eastern District of Louisiana.¹ That outcome would leave all of the issues to be litigated, albeit in a different court. However, the Civil Action would continue, only the forum would change. *Norwood v. Kirkpatrick*, 349 U.S. 29, 31, 75 S. Ct. 544, 546, 99 L. Ed. 789 (1955). Thus, a transfer would have no bearing on a suspension of these proceedings.

A dismissal would be another matter. A dismissal would terminate the Civil Action. *Norwood*, 75 S.Ct. at 546. Should the Civil Action be dismissed, the Parties would advise the Board, and these proceedings could be resumed, per TBMP § 510.02(b), like any other matter that is suspended pending the outcome of a civil action once the civil action is resolved.

Another potential outcome is that Registrant's motion in the Civil Action could be denied in its entirety. Registrant does not expect that to happen, but it could. If so, this matter should remain suspended while the Civil Action is litigated to completion in California.

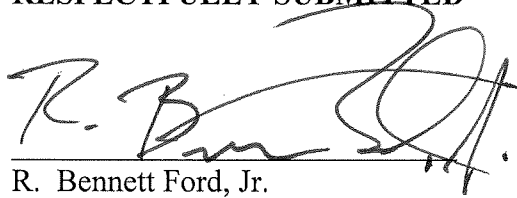
In sum, Registrant's motion to dismiss or transfer does not effect whether the Board should suspend this action. The outcome of that motion *might* warrant resumption of these proceedings, but there is no reason not to suspend simply because there is a motion pending in the Civil Action. A civil action without motions pending is a rare thing. The fact that there is one here is immaterial to the present motion to suspend. A ruling on that motion would be another matter, but this action should be suspended until a ruling is issued *terminating* the Civil Action.

¹*Atl. Marine Const. Co. v. U.S. Dist. Court for W. Dist. of Texas*, 571 U.S. 49, 63, 134 S. Ct. 568, 581, 187 L. Ed. 2d 487 (2013) (“a valid forum-selection clause [should be] given controlling weight in all but the most exceptional case”).

III. Conclusion

Accordingly, the Board is respectfully urged to GRANT Registrant's motion to suspend this cancellation action pending the outcome of the civil litigation. The Board is also urged to suspend any other deadlines in this matter, including the deadline to answer, while this motion is pending.

RESPECTFULLY SUBMITTED



R. Bennett Ford, Jr.

Bar Roll No. 24,093

ROY, KIESEL FORD,

DOODY & THURMON, ap/c

P.O. Box 15928

9100 Bluebonnet Centre Blvd., Suite 100

Baton Rouge, Louisiana 70895-5928

(225) 927-9908

(225) 926-2685 fax

ATTORNEYS FOR BLUNT WRAP U.S.A., Inc.

CERTIFICATE OF SERVICE

I certify that a true copy of this Memorandum and all Exhibits thereto were served on counsel for Petitioner by email (cpham@johnsonpham.com, jvener@johnsonpham.com) and by depositing the same with the U.S. Postal Service in a sealed envelope, First Class postage thereon fully prepaid and addressed to Christopher Q. Pham at JOHNSON & PHAM, LLP; 6355 Topanga Canyon Blvd., Suite 326; Woodland Hills, California 91367 on this 7th day of December, 2018.

By: /R. Bennett Ford, Jr./

R. Bennett Ford, Jr.