

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

December 31, 2018

Cancellation No. 92069730

New Image Global, Inc.

v.

Blunt Wrap U.S.A., Inc.

**Katie W. McKnight,
Interlocutory Attorney:**

On November 12, 2018, Respondent filed a contested motion to suspend this proceeding pending final determination of a civil action between the parties in the United States District Court for the Central District of California (the “Federal Case”).¹ Respondent maintains that the Federal Case may have a bearing on this one, inasmuch as the Federal Case involves the same marks, parties, and claim of likelihood of confusion.²

In response, Petitioner argues that the Federal Case is not dispositive of this proceeding, inasmuch as Petitioner’s fraud claim is not at issue in the Federal Case.³

¹ *New Image Global, Inc. v. Blunt Wrap USA Inc.*, Case No. 2:18-cv-08940, filed on or about October 16, 2018. Respondent included a copy of the complaint in the Federal Case with its motion.

² 4 TTABVUE 5.

³ 5 TTABVUE 6.

Petitioner further argues that suspension is unwarranted where a motion to dismiss or transfer the Federal Case is currently pending before the District Court.⁴ In reply, Respondent argues that the Federal Case need not be dispositive of this proceeding, and determination of the likelihood of confusion issue in the Federal Case may have a bearing on this proceeding.⁵ Respondent further contends that while the outcome of the motion to dismiss the Federal Case might warrant resumption of these proceedings, the fact that a motion to dismiss is pending in the Federal Case is not material to determination of the instant motion to suspend in this proceeding.⁶

Board proceedings are typically suspended when a party is involved in a civil action which may have a bearing on the Board case. *See* Trademark Rule 2.117(a); *see also New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (“the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board”). Here, Petitioner alleges (1) that Respondent’s DOUBLEXL mark is confusingly similar to Petitioner’s XXL and XXL 2 marks; and (2) fraudulent procurement of Respondent’s subject registration. In the Federal Case, Petitioner alleges, *inter alia*, infringement of Petitioner’s XXL and XXL 2 marks.⁷ The Federal Case may have a bearing on this proceeding, for example, if the District Court grants Petitioner’s prayer for relief requesting, *inter alia*, that Respondent be enjoined from “the

⁴ 5 TTABVUE 9.

⁵ 6 TTABVUE 3.

⁶ 6 TTABVUE 4.

⁷ Civil complaint, ¶¶12, 24, 34-44.

unauthorized use of any mark, copyright or other intellectual property right of Plaintiff.”⁸ See *Other Telephone Co. v. Conn. Nat’l Telephone Co., Inc.*, 181 USPQ 125, 126-27 (TTAB 1974); *New Orleans Louisiana Saints LLC*, 99 USPQ2d at 1552.

Petitioner’s argument that Respondent’s motion should be denied because it has filed a motion to dismiss in the Federal Case is not persuasive. Rule 3 of the Federal Rules of Civil Procedure provides that a civil action is commenced by filing a complaint with the court. Once a complaint is filed, “the civil suit is pending and will be considered until the Board is informed that it has either been dismissed or been finally ruled upon.” *Other Telephone Co.*, 181 USPQ at 126. Petitioner has not indicated that the motion to dismiss has been granted and the District Court has rendered a final determination. *Tokaido v. Honda Assoc. Inc.*, 179 USPQ 861, 862 (TTAB 1973).

Since proceeding here would risk inconsistent judgments, judicial economy would in fact be best served by suspension of this proceeding. Accordingly, Respondent’s motion is **granted**. Proceedings are **suspended** pending final disposition of the Federal Case. Within **thirty days** after the final determination of the Federal Case,⁹ the parties shall so notify the Board in writing, including a copy of the District Court’s final order, so that this proceeding may be called up for appropriate action (including, if appropriate, resetting the time for Respondent to file its answer to Petitioner’s

⁸ Civil complaint, Prayer for Relief at ¶D.

⁹ “A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired.” See TBMP § 510.02(b) (2018).

petition to cancel).¹⁰ During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys. *See* Trademark Rule 2.18(b)(1).

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

¹⁰ The Board does not usually require that an issue be joined in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. TBMP § 510.01(a).