

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

wbc

Mailed: January 29, 2020

Cancellation No. 92072655

*Playlearn USA, Inc.*

*v.*

*Viahart, LLC*

**Wendy Boldt Cohen, Interlocutory Attorney:**

Now before the Board is Respondent's motion to suspend proceedings pending disposition of a civil action filed in the United States District Court for the Eastern District of Texas, styled *Viahart, LLC v. Arkview, LLC d/b/a Moo Toys and d/b/a Lexivon, et al.*,<sup>1</sup> case no. 6:19-cv-00406 (the "Civil Action"). 4 TTABVUE. The motion is fully briefed.<sup>2</sup>

The Board may suspend a proceeding before it whenever it becomes aware that a party to that proceeding is involved in a civil action which may have a bearing on the Board case. *See* Trademark Rule 2.117(a); *see also* *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983); *Goya Foods Inc. v.*

---

<sup>1</sup> Petitioner, Playlearn USA, Inc., is listed as one of the defendants. *See* 7 TTABVUE 142.

<sup>2</sup> Respondent's reply brief seeks to suspend or toll current deadlines. *See* 10 TTABVUE 304. As noted in the Board's order suspending this proceeding pending disposition of the motion to suspend for civil action, deadlines are suspended. *See* 9 TTABVUE. In view thereof, the motion to suspend upcoming deadlines is moot.

The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount them here except as necessary to explain the Board's order.

*Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208, 1211 (D. Minn. 1986); TBMP § 510.02(a) (2019). It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). “A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration and, therefore, judicial economy is usually served by suspension.” TBMP § 510.02(a); *see, e.g., B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015). The Board does not usually require that an issue be joined (i.e., that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974). Further, “[w]hen a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB’s analysis, the TTAB gives preclusive effect to the court’s judgment.” *B&B Hardware, Inc.*, 113 USPQ2d at 2053.

Upon review of the pleadings from the Civil Action, the Board determines that the outcome of the Civil Action may have a bearing on this proceeding. One of the issues in the Civil Action is trademark infringement involving the marks pleaded in this proceeding and Respondent seeks injunctive relief regarding purported trademark infringement of the mark BRAIN FLAKES. 7 TTABVUE 35-37. Because the issues

involved in the Board action as well as the Civil Action involve the same parties and the same or similar issues, the Civil Action decision may have bearing on this proceeding. Additionally, the Civil Action involves claims broader than the right to register – an adjudication of the parties’ rights to use the mark BRAIN FLAKES and a declaration of infringement, amongst other things. *See* 7 TTABVUE 35-38.

Although Petitioner notes that it has filed a motion to dismiss the Civil Action, as also noted by Petitioner, the motion has not yet been decided by the court. *See* 8 TTABVUE 8. Accordingly, based on the record before the Board, the claims in the Civil Action are current and still involve Petitioner. The motion to dismiss is a matter for the court to resolve.

Additionally, Petitioner argues that if the Board proceeding is suspended pending final disposition of the Civil Action, the Board proceeding should only be suspended so long as the claims against Petitioner remain. *See* 8 TTABVUE 4. If there is a final disposition of all the claims against Petitioner in the Civil Action and assuming this Board proceeding remains suspended and has not been otherwise finally decided, either party may file a motion at that time, as appropriate, addressing whether further suspension of this Board proceeding is warranted.

**Order**

Respondent’s motion to suspend is **granted**. Trademark Rule 2.117(a). Proceedings herein are suspended pending final disposition, including any appeals or remands, of the Civil Action.

Within **thirty days** after the final determination of the Civil Action, the parties must so notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment which issued in the Civil Action.<sup>3</sup> 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.

---

<sup>3</sup> A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered and no appeal has been filed therefrom or all appeals filed have been decided. *See* TBMP § 510.02(b).