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

Proceeding	92072655
Party	Defendant Viahart, LLC
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Date	01/06/2021
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

PLAYLEARN USA, INC.,

Petitioner,

v.

VIAHART, LLC,

Registrant.

Proceeding No. 92072655

Mark: BRAIN FLAKES

Serial No. 87021780

Registration No. 5049910

**REPLY TO PETITIONER’S OPPOSITION TO MOTION TO SUSPEND PROCEEDING
PENDING OUTCOME OF CIVIL ACTION AND REQUEST TO TOLL DEADLINES**

Registrant Viahart, LLC (“Registrant”) hereby files this its Reply to Petitioner’s Opposition to Motion to Suspend Proceeding Pending Outcome of Civil Action (“Motion to Suspend”) (filed on January 4, 2021) and Request to Toll Deadlines pursuant to TBMP §§ 502.2(b) and 502.4.

History of the Motion to Suspend Proceeding

On November 18, 2019, Registrant, by and through its undersigned counsel, originally moved to suspend this proceeding pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a). On November 21, 2019, Petitioner Playlearn USA, Inc. (“Petitioner”) filed its original Opposition to the original Motion to Suspend Proceeding Pending Outcome of Civil Action making many of the same or substantially similar arguments as Petitioner made in its Response to Registrant’s currently pending Motion to Suspend.

Current Motion to Suspend Proceeding

Petitioner argues that (1) Registrant “conceded” to resuming the proceeding; and (2) the Motion to Suspend “improperly relies on a Second Civil Action [] refiled after dismissal simply

for the purpose of staying this proceeding.” However, Registrant did not intentionally concede, because Petitioner filed a Motion to Resume proceedings without first obtaining the required final judgment pursuant to TBMP § 510.02(b) and Registrant believed the Board would issue an Order to Show Cause before Registrant would be required to respond; and (2) there is no credible evidence that Registrant refiled its lawsuit simply to continue to suspend these proceedings. Registrant filed its original lawsuit on September 6, 2019 and Petitioner filed its original Petition to Cancel Registration approximately *one and ½ months later* on October 28, 2019. The fact that Registrant filed its lawsuit before Petitioner filed its Petition to Cancel is evidence that Registrant did not file the original lawsuit or the refiled lawsuit simply to avoid having the Board address this matter. Accordingly, there is no improper purpose in Registrant’s filing the pending Motion to Suspend, as Registrant had a basis for filing the original Texas lawsuit and continues to have that same basis for refiled its lawsuit in New York after the Court dismissed it without prejudice.

While, Registrant understands that Replies may be disfavored by the Board as being an attempt to get the last word, this Reply is not for that purpose but is to avoid having issues with the current Answer deadline tomorrow, January 7, 2021, issues raised by Petitioner in its Response and to respectfully request that the Board toll the deadlines set by the Board for this case, until such time as the Proceeding resumes.

Registrant’s Motion is Timely

Petitioner argues that Registrant’s Motion is untimely. However, this Motion to Suspend is timely, as Petitioner explained its understanding of the Rules regarding responding to the Motion to Resume in its Motion to Suspend; and the current Motion to Suspend is separate and independent of the Motion to Resume. Further, since this Motion to Suspend was filed on the

same day the Board ordered the matter to resume and prior to the date that the Answer is due, January 7, 2021, it is timely and is not prejudicial. Further, there are no limits on the number of Motions to Suspend that can be filed. Specifically, a Motion to Suspend may be filed anytime there is a civil action that may have a bearing on the Board case. “Whenever it comes to the attention of the Board that a party or parties to a case before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.” TBMP § 510.02(a), ¶ 1. Therefore, Petitioner’s Motion to Suspend is timely and should be granted for the reasons outlined in the Motion to Suspend and for the reasons outlined in this Reply.

Registrant’s Motion is Not an Attempt to Game the System and Avoid Having the Board Consider the Relevant Issues

Petitioner again argues that Registrant had some nefarious intent by filing its Motion to Suspend Proceeding; however, this is par for the course when a lawsuit is pending before a District Court. Petitioner alleged in its original response to Registrant’s original Motion to Suspend on November 18, 2019 that Registrant was somehow gaming the system as well, but of course, as is the case with the current Motion to Suspend, Registrant was not “gaming the system.” Ultimately, to the extent that it is relevant at this point, if anything is questionable, it is not Registrant’s Motion to Suspend, but it is Petitioner’s attempt to resume this proceeding when there was no *final adjudication* of the lawsuit, as is required under TBMP § 510.02(b).

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been ***finally determined***, the interested party should promptly notify the Board in writing of the disposition of the other proceeding, and request that further appropriate action be taken in the Board proceeding. Usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding. [Note 1.] A copy of the decision in the other proceeding should accompany the

notification. The Board will then *issue a show cause order* as to why judgment on the identified issues should not be entered in favor of the moving party. Absent any such notification as to the final determination of the civil action, cases which have been suspended pending civil action will usually remain in a suspended status for one year before the Board will issue an order requiring the parties to provide the status of the civil action.

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*.

TBMP § 510.02(b).

Finally, Petitioner attempts to argue the merits of the trademark lawsuit against Petitioner in its current Response. Registrant filed its lawsuit that includes trademark claims in good faith and will proceed with the Court in determining the outcome of the lawsuit, rather than argue its case here. Further, Petitioner did not deny that it will assert the defense or counterclaim that Petitioner's mark is generic when it is time for Petitioner to file its Answer in the Civil Action. Thus, the Board should suspend these proceeding, because the parties "are involved in a civil action which may have a bearing on the Board case." TBMP § 510.02(a), ¶ 1.

REQUEST TO TOLL DEADLINES

Due to the pending litigation in Court, the pending Motion to Suspend Proceedings related to the pending Petition to Cancel, continuing with the Board's currently set deadlines in this proceeding would cause duplication of efforts, unnecessarily burden Registrant and increase costs of defending the Petition to Cancel. Accordingly, pursuant to TBMP § 502.04, Registrant respectfully requests that the Board toll the deadlines set for this proceeding, until such time as the proceeding resumes. This request is not made for dilatory purposes but so that justice may be served and reduce unnecessary burden and cost.

Current Deadlines

Trials and Appeals. *See* Trademark Rule 2.114(b)(1).

Time to Answer 1/7/2021

Deadline for Discovery Conference 2/6/2021

Discovery Opens 2/6/2021

Initial Disclosures Due 3/8/2021

Expert Disclosures Due 7/6/2021

Discovery Closes 8/5/2021

Plaintiff's Pretrial Disclosures Due 9/19/2021

Plaintiff's 30-day Trial Period Ends 11/3/2021

Defendant's Pretrial Disclosures Due 11/18/2021

Defendant's 30-day Trial Period Ends 1/2/2022

Plaintiff's Rebuttal Disclosures Due 1/17/2022

Plaintiff's 15-day Rebuttal Period Ends 2/16/2022

Plaintiff's Opening Brief Due 4/17/2022

Defendant's Brief Due 5/17/2022

Plaintiff's Reply Brief Due 6/1/2022

Request for Oral Hearing (optional) Due 6/11/2022

WHEREFORE, Registrant again respectfully requests that the Board suspend this proceeding pending determination of the pending Civil Action; and respectfully requests that the Board Toll the Deadlines in this proceeding, including the deadline to file its Answer on January 7, 2021.

January 6, 2021

Respectfully submitted,

/s/ Wendy B. Mills_____

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CERTIFICATE OF SERVICE

The undersigned counsel for Registrant hereby certifies that a true and correct copy of the foregoing document was served on Petitioner via email on January 6, 2021.

/s/ Wendy B. Mills_____

Wendy B. Mills