

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 7, 2021

Cancellation No. 92072655

Playlearn USA, Inc.

v.

Viahart, LLC

Wendy Boldt Cohen, Interlocutory Attorney:

Petitioner filed a motion to resume proceeding noting that the civil action filed in the United States District Court for the Eastern District of Texas which occasioned the prior suspension of these proceedings was dismissed. *See* 12 TTABVUE. The Board granted Petitioner's motion to resume as conceded. *See* 13 TTABVUE. This case now comes before the Board on Respondent's motion to suspend for civil action filed in the United States District Court for the Southern District of New York. *See* 14 TTABVUE. The motion is contested by Petitioner.¹

Civil Action

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

¹ As of the date of this order, the time to file a reply brief has not expired. Notwithstanding, the filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989). The Board, in its discretion, will decide this motion on its merits.

Petitioner's change of correspondence is noted. *See* 15 TTABVUE.

Board case. *See* Trademark Rule 2.117(a); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983); TBMP § 510.02(a) (2020).

Respondent seeks suspension of this proceeding pending final disposition of a civil action filed in the United States District Court for the Southern District of New York, Civil Action No. 20-cv-9943, styled *Viahart, LLC v. Playlearn USA, Inc. et al* ("Civil Action"). Upon review of the parties' submissions, the Board notes that the Civil Action involves the same parties as in this Board proceeding; and includes allegations of and seeks relief related to trademark infringement, unfair competition and dilution of the BRAIN FLAKES mark. 14 TTABVUE 17-21.

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 See Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 395 (Fed. Cir. 1983); *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1253-54 (TTAB 2011); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); *Professional Economics Inc. v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979). Contrary to Petitioner's assertion that Respondent has foreclosed its ability to seek suspension for the Civil Action because Respondent did not respond to Petitioner's prior motion to resume, *whenever* it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action that may have a bearing on the Board case, in the Board's discretion, proceedings may be suspended until final determination of the civil action. *See* 16 TTABVUE 3; Trademark Rule 2.117(a);

General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1936-37 (TTAB 1992). The Civil Action may involve matters outside Board jurisdiction and may consider broader issues beyond the right to registration and, therefore, the Board finds that judicial economy is served by suspension. *See, e.g., B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015); *Goya Foods Inc. v. Tropicana Prod. Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988).

In view thereof, the motion to suspend proceedings is **granted**. Trademark Rule 2.117(a). This proceeding is **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 as well as an explanation of any relief sought.² 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.

² 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).

Other Pending Motions

In view of the suspension for Civil Action, to the extent there are any other pending motions at the time of this suspension, those motions are denied without prejudice.

After final disposition of the Civil Action or upon resumption of this proceeding, if a party believes its motion denied by this order was not resolved or made moot, the party may renew the motion by written request to the Board, citing the motion's title, date of filing, and docket entry in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the Board accepts any renewed motion, it may reset briefing, as necessary.