

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 13, 2022

Cancellation No. 92076810

YYGM, SA

v.

John Capovani

Wendy Boldt Cohen, Interlocutory Attorney:

This case comes before the Board on Petitioner's motion to suspend for civil action and Respondent's motion for sanctions. 5 TTABVUE; 11 TTABVUE. The motions are fully briefed.¹

Preliminary Matters

Respondent filed a surreply to the motion to suspend for civil action. 9 TTABVUE.

Surreply briefs will be given no consideration by the Board. Trademark Rule 2.127(a). Accordingly, Respondent's surreply brief will be given no consideration.

Respondent asserts that Petitioner did not serve its motion to suspend on Respondent and as such, the motion to suspend be denied. 6 TTABVUE 6.

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motions and does not recount them here except as necessary to explain the Board's decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015) (reconsideration denied because no requirement that Board repeat or address irrelevant arguments when determining a motion).

Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a submission that does not include the required proof of service.

As such, a copy of Petitioner's motion can be found at: <https://ttabvue.uspto.gov/ttabvue/v?pno=92076810&pty=CAN&eno=5>. In view thereof and because Respondent has filed a timely response which contests the motion to suspend, the Board exercises its discretion to consider the motion to suspend on its merits. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003).

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 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) (2021).

Petitioner seeks suspension of this proceeding pending final disposition of a civil action filed in the United States District Court, Eastern District of New York, case no. 1:21-cv-04902-ENV-SJB, styled *Y.Y.G.M., SA v. Henry Ishay d/b/a X-TREME*

VIBE, INC. and John Capovani d/b/a/ Ratbastard Supply Co. (the “Civil Action”).
5 TTABVUE 5-16.

The Civil Action involves the same parties as in this Board proceeding; includes allegations that are related to the pleaded marks; and involves claims regarding likelihood of confusion and abandonment whereas the Board proceeding involves allegations regarding fraud. The Civil Action further includes seeking relief in the form of enjoining and restraining Respondent from directly or indirectly infringing Petitioner’s rights in its marks; an order that Petitioner is “entitled to registration of [its] Marks with the USPTO”; and requiring Respondent obtain a license from Petitioner. 5 TTABVUE 5-16.

In view thereof, the decision in the Civil Action may have a bearing on this proceeding. As noted, 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* Trademark Rule 2.117(a); *Mother’s Restaurant Inc*, 221 USPQ 394; *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). In view of this policy, 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.

Motion for Sanctions and 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, including the motion for sanctions. *See* 11 TTABUVE.

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 appropriate.

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).