

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

WF

September 20, 2021

Cancellation No. 92077294

Kirk Junge

v.

Todd Graves Golf School LLC

Winston Folmar, Interlocutory Attorney:

This case now comes up for consideration of Todd Graves Golf School LLC's ("Respondent") motion, filed June 7, 2021, to suspend proceedings pending disposition of a civil action involving the identical parties as the present proceeding, namely, Case No. 9:21-cv-80793-AMC in the United States District Court for the Southern District of Florida (the "Federal Case").¹ The motion is fully briefed.²

Additionally, the Board acknowledges receipt of the exhibits from June 29, 2021,³ i.e., the pleadings from the Federal Case in response to the Board's order of June 28, 2021, namely, Respondent's complaint and Respondent's answer to Kirk Junge's ("Petitioner") counterclaims and, in its discretion, elects to review the exhibits.⁴

¹ 4 TTABVUE.

² 5-6 TTABVUE.

³ 8 TTABVUE.

⁴ The consideration of reply briefs on motions is discretionary on the part of the Board. *See* Trademark Rule 2.127(a). *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000) (Trademark Rule 2.127 "vests the Board with discretion to consider a reply brief").

However, the Board will not consider the surreply brief, filed July 13, 2021.⁵ See Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 502.02(b) (June 2021).

I. BACKGROUND

By way of background, in the Federal Case, Respondent is the plaintiff and Petitioner is the defendant.⁶ Respondent complains of cyberpiracy in violation of the Anticybersquatting Consumer Protection Act under 15 U.S.C. § 1125(d) based on allegations that Petitioner is using the confusingly similar domain names to those Respondent’s SINGLE PLANE registrations without Respondent’s authorization and with bad faith intent to mislead and deceive the public.⁷ Additionally, Petitioner seeks a declaratory judgment via his counterclaim in the Federal Case that Petitioner’s use of the term “single plane” does not infringe Respondent’s trademark rights on account that the term is generic in connection with the sport of golf and golf instruction services.⁸ Moreover, Petitioner included in his counterclaim a request to cancel Respondent’s registrations⁹ and seeks a finding that “single plane” should be

⁵ 9 TTABVUE.

⁶ 8 TTABVUE 2-8.

⁷ *Id.* at 6, ¶¶25-30.

⁸ 4 TTABVUE 12-20, ¶¶2 and 8-41.

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MARK	REG. NO.	REG. DATE	GOODS/SERVICES & (CLASS)
SINGLE PLANE	4683879	2/10/2015	Prerecorded digital video discs featuring sports instruction (Intl. Cl. 9)
SINGLE PLANE	5040967	9/13/2016	Golf clubs (Intl. Cl. 28)
SINGLE PLANE EXPERIENCE	5041110	9/13/2016	Golf instruction; instruction in the nature of golf clinics (Intl. Cl. 41)
SINGLE PLANE 3D Supplemental Register	5771794	6/4/2019	Coaching and instruction services in the field of biomechanics of golf; golf instruction (Intl. Cl. 41)

considered generic and thus does not infringe Respondent’s claimed trademark rights.

The Board has considered the parties’ arguments and presumes the parties’ familiarity with the factual basis for Respondent’s motion, and does not recount all the facts or arguments here, except as necessary to explain the decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

II. RESPONDENT’S MOTION TO SUSPEND FOR THE FEDERAL CASE

Respondent contends that a suspension for the Federal Case is warranted because the Federal Case involves the identical parties and the issues overlap.¹⁰ Conversely,

MARK	REG. NO.	REG. DATE	GOODS/SERVICES & (CLASS)
<p>SINGLE PLANE GOLFER</p> <p>Disclaimer:“GOLFER”</p>	5268985	8/22/2017	<p>Electronic publications, namely, a magazine featuring golf recorded on computer media; downloadable electronic publications in the nature of magazines in the field of golf; etc. (Intl. Cl. 9)</p> <p>-----</p> <p>Magazines in the field of gold (Intl. Cl. 16)</p> <p>-----</p> <p>Providing on-line magazines in the field of golf (Intl. Cl. 41)</p>
<p>SINGLE PLANE </p> <p>Disclaimer:“GOLFER”</p>	5268986	8/22/2017	<p>Electronic publications, namely, a magazine featuring golf recorded on computer media; downloadable electronic publications in the nature of magazines in the field of golf; etc. (Intl. Cl. 9)</p> <p>-----</p> <p>Magazines in the field of gold (Intl. Cl. 16)</p> <p>-----</p> <p>Providing on-line magazines in the field of golf (Intl. Cl. 41)</p>

¹⁰ 4 TTABVUE 2.

Petitioner argues that: (i) Respondent has not made a sufficient showing that requisite elements for a suspension of the Federal Case have been met;¹¹ (ii) a suspension will unfairly prejudice Petitioner but “will not manifest any hardship to [Respondent] if the motion for suspension is denied;”¹² (iii) the claims of the Federal Case and present cancellation proceeding are not identical, as the present proceeding includes a claim of abandonment;¹³ (iv) a suspension will manifest a clear tactical advantage for Respondent because Respondent would continue to enjoy the presumptions that go along with owning live federal registrations;¹⁴ and (v) “[t]he Board is in the best position to evaluate whether a mark that is the subject of a registration is generic or descriptive absent secondary meaning.”¹⁵

The Board finds from a review of the complaint and counterclaims that the Federal Case may have a bearing on the present proceeding. *See* Trademark Rule 2.117(a). *See also New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). The Board’s well-settled policy is to suspend proceedings when one or both parties are involved in a civil action that **may** be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). Suspension is not absolute; it is within the Board’s discretion. Trademark Rule 2.117(a). The Federal Case involves the same parties, marks, issues, and, at least in part, the same

¹¹ 5 TTABVUE 2.

¹² *Id.*

¹³ *Id.* at 3.

¹⁴ *Id.* at 4.

¹⁵ *Id.* at 3-4.

request for relief as in the Board proceeding. For these reasons, the Federal Case “may have a bearing” on this proceeding.

Additionally, the Board is unpersuaded by Petitioner’s arguments because:

- (i) it is well-settled that so long as the civil action may have a bearing on the Board proceeding, suspension is available and no additional elements are required;
- (ii) prejudice must be more than the mere inconvenience and delay and more than a loss of any possible tactical advantage that Petitioner may enjoy as a result of proceedings not being suspended. Rather, prejudice contemplates an adverse impact on an adversary’s ability to litigate the case or a change in a party’s economic position during the delay. *See A. C. Aukerman Co.*, 22 USPQ2d at 1328-29; *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997); *see also* TBMP § 509.01(b);
- (iii) the claims of the Federal Case need not be identical in order to potentially have a bearing on the present cancellation;
- (iv) the Board is unaware of any tactical advantage the continued existence of the registrations offer to Respondent in the litigation of the Federal Case or the present proceedings; and
- (v) the Court’s findings in the Federal Case will be binding on the Board, thus, the outcome of the Federal Case will clearly have a bearing on the present cancellation.

For all of these reasons, Respondent's motion to suspend this proceeding pending final determination of the Federal Case is **GRANTED**. Accordingly, the proceedings are suspended pending final disposition of the civil action, including all appeals or remands of the Federal Case. Within **TWENTY (20) DAYS** after the final determination of the Federal Case, 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 that issued in the Federal Case.

During the suspension period, the parties must notify the Board of any address or email 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.