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

Proceeding	92077459
Party	Plaintiff Phoenix Intangibles Holding Company
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Date	09/09/2021
Attachments	Phoenix response to motion to open time and suspend.pdf(21068 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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PHOENIX INTANGIBLES HOLDING COMPANY	:	
	:	
Petitioner,	:	
	:	Cancellation No.: 92077459
v.	:	Registration Nos.: 5040314, 5040321
	:	
VIRK BROTHERS, LLC	:	
	:	
	:	
Respondent.	:	

PETITIONER’S RESPONSE TO RESPONDENT’S MOTION TO REOPEN TIME AND MOTION TO SUSPEND FOR CIVIL ACTION

Petitioner, Phoenix Intangibles Holding Company (“Phoenix” or “Petitioner”) consents to Respondent Virk Brothers, LLC’s (“Respondent”) Motion to Reopen Time to file the Answer in this proceeding.

Phoenix opposes Respondent’s Motion to Suspend for Civil Action on the grounds set forth below.

I. STATEMENT OF ISSUE

The issue before the Board is whether or not the above-captioned cancellation proceeding (the “Cancellation”) should be suspending pending the outcome of civil action No. 1:21-cv-00263-HAB-SLC currently pending in the United States District Court, Northern District of Indiana, Fort Wayne Division (the “Civil Action”). See attachment to Respondent’s Motion to Suspend, 5 TTABVUE 6-66.

II. ARGUMENT

The Board has the discretion to determine whether a TTAB proceeding should be stayed pending final determination of a civil action in which the parties are engaged and that may have bearing on the Board case. 37 C.F.R. § 2.117; TBMP § 510.02(a). The Board will review the pleadings in the civil case in order to determine whether the final determination of the civil action may have a bearing on the case before the Board. TBMP § 510.02(a).

Respondent respectfully requests that the Board deny Respondent's Motion to Suspend and allow the Cancellation to progress simultaneously with the Civil Action. A stay of this Cancellation would delay resolution of the issue of the continued registrability of the marks that are the subject of the Cancellation and prejudice Phoenix. The Cancellation and the Civil Action are separate proceedings to decide separate rights. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1305-06, 113 USPQ2d 2045 (2015). In this instance, the Cancellation involves the question of the registrability of Respondent's trademarks, while the Civil Action involves questions of infringement, common law use, including actual use in the marketplace, and liability for damages, and involves additional parties (Giant Eagle, Inc. as Plaintiff and Charanjit Singh as Defendant in the Civil Action). See 5 TTABVUE 6. Accordingly, the actions may occur simultaneously addressing the distinct rights.

Should the Board reach its decision prior to the court in the Civil Action, the Board's decision may be binding on the court; should the court reach its decision prior to the Board the court's decision may be binding on the Board. *B&B Hardware*, 135 S. Ct. at 1306. Even if the proceedings are occurring simultaneously but separately, there is the possibility that the proceedings will not continue longer than necessary if the elements of issue preclusion are met

and there is preclusive effect. Therefore, there is no loss of judicial economy in allowing both proceedings to proceed simultaneously.

III. CONCLUSION

For the reasons set forth above, Phoenix respectfully requests that Respondent's Motion to Suspend for Civil Action be denied.

Respectfully submitted,

Dated: September 9, 2021

By: s/David V. Radack/
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ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioner's Response to Respondent's Motion to Reopen Time and Motion to Suspend for Civil Action has been served via electronic mail on the date set forth below to Respondent as follows:

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Dated: September 9, 2021

s /Jenna P. Torres/
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