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

Proceeding	92077459
Party	Defendant Virk Brothers, LLC
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Submission	Reply in Support of Motion
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Date	09/29/2021
Attachments	Respondents Reply to Petitioners Response to Respondents Motion to Re open Time and Motion to Suspend for Civil Action.pdf(251357 bytes)

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

PHOENIX INTANGIBLES HOLDING
COMPANY

Petitioner,

v.

VIRK BROTHERS, LLC,

Respondent.

Cancellation No. 92077459

Registration Nos. 5040314 and 5040321

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

Virk Brothers, LLC (“Virk Brothers”), by and through its attorneys, Carson LLP, submits this Reply in support of its Motion to Suspend for Civil Action.

INTRODUCTION

The above-captioned cancellation proceeding (the “Cancellation”) should be stayed pending final determination 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”) because the Civil Action has a direct bearing on the issues of the Cancellation and judicial economy would be served by suspension until final determination of the Civil Action.

ARGUMENT

Whenever it comes to the attention of the Trademark Trial and Appeal Board (the “Board”) that the parties to proceedings pending before it are also involved in a civil action that may have a bearing on the proceedings, the Board may suspend the proceedings until final determination of the civil action. TBMP § 510.02(a). Absent unusual circumstances, the Board

will suspend proceedings before it if the final determination of the civil action may have a bearing on the issues before the Board. *Id.* The Civil Action does not need to be dispositive of the Cancellation, but only needs to have a bearing on the issues before the Board. *Id.* The Board has previously held that a civil action for infringement and unfair competition would have a bearing on the outcome of a Trademark Act §2(d) claim before the Board. *See, e.g., Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974).

Moreover, “[a]lthough the Supreme Court held that issue preclusion can be based on a decision by the Board in a case in which the ordinary elements of issue preclusion are met, the Board’s policy to suspend in favor of a civil action has not changed. A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration, and, therefore, judicial economy is usually served by suspension.” *Id.*

Similar to *Other Telephone Co.*, the Civil Action does have a bearing on the issue before the Board in the Cancellation proceeding because the final determination of the Civil Action will directly affect the resolution of the Trademark Act § 2(d) likelihood of confusion issue, which will ultimately be an issue in the Cancellation proceeding. Further, regardless of whether the Civil Action involves other matters outside the Board’s jurisdiction, judicial economy would be served by suspension of the Cancellation pending final determination in the Civil Action.

CONCLUSION

For the reasons set forth above, Respondent respectfully requests that the Board suspend the Cancellation pending final determination of the Civil Action.

Dated: September 29, 2021

Respectfully submitted,

s/Amanda K. Landis/

Amanda K. Landis

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ATTORNEY FOR RESPONDENT

CERTIFICATE OF SERVICE

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

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Date: September 29, 2021

s/Amanda K. Landis/

Amanda K. Landis