

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EJW

December 28, 2021

Cancellation No. 92077459

Phoenix Intangibles Holding Company

v.

Virk Brothers, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of Respondent's fully briefed combined motion (filed August 13, 2021) to reopen its time to file an answer and to suspend this proceeding pending a civil action between the parties. 5 TTABVUE.¹ Petitioner consents² to the motion to reopen Respondent's time to answer, 7 TTABVUE 2, but opposes the motion to suspend for civil action. *Id.*

¹ Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer. Parties should use the same method to refer to the record in their submissions to the Board.

² In view thereof, Respondent's technical default is discharged; and the answer due date will be reset. *See* Fed. R. Civ. P. 55(c); Trademark Rules 2.116(a) and 2.127(a), 37 C.F.R. §§ 2.116(a) and 2.127(a).

The Board has considered the parties' briefs and materials submitted therewith, but addresses the record only to the extent necessary to support the Board's analysis and findings, and does not repeat or address all of the parties' arguments or materials. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the petition to cancel and the arguments and materials submitted in connection with the subject motion.

Motion to Suspend for Civil Action

A. Parties' Arguments

Respondent seeks to suspend this proceeding pending the final resolution of civil action No. 1:21-cv-00263-HAB-SLC, currently pending between the parties (and others) in the United States District Court, Northern District of Indiana, Fort Wayne Division (the "Civil Action"). In support thereof, Respondent states that Petitioner "filed a civil action regarding the trademark registrations at issue" and that "Form AO 120, Report on the Filing or Determination of an Action Regarding a Patent or Trademark, was not filed at this time." 5 TTABVUE 2. Respondent also suggests that this proceeding should be suspended "in the interest of efficiency." *Id.* In support of its motion, Respondent attached a copy of the complaint filed in the Civil Action. *Id.* at 4-14.

Petitioner argues that this proceeding should proceed simultaneously with the Civil Action because the latter involves several other parties and issues, including infringement, common law use, and liability for damages. Petitioner also contends

that if the elements of issue preclusion are met, and there is preclusive effect, there will be no loss of judicial economy. In reply, Respondent argues the Civil Action has a direct bearing on this cancellation proceeding and, in contrast to Petitioner, asserts that judicial economy would be served if this proceeding were suspended.

B. Legal Standard; Board's Analysis and Order

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board's decision in the opposition); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); Trademark Rules 2.127(a) and 2.117(a), 37 C.F.R. §§ 2.127(a) and 2.117(a); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.02 (2021). Additionally, the Board will suspend or maintain the suspension of a proceeding until the civil action at issue is considered to have been finally determined, that is, when a decision on the merits of the case has been rendered, and no appeal has been filed in regard thereto, or all appeals filed have been decided. *See* TBMP § 510.02(b).

Petitioner seeks cancellation of Respondent's registrations on the ground of likelihood of confusion. 1 TTABVUE 1, 10-11. Similarly, the Civil Action concerns Petitioner's claims (as one of the plaintiffs therein) that Respondent (as one of the defendants in the Civil Action) is infringing on Petitioner's prior rights accrued at common law and trademark registrations. *See* 5 TTABVUE 6-8. Petitioner also seeks

injunctive relief in view of its claims and allegations. *See* 5 TTABVUE 11. In view of the foregoing, the Civil Action clearly has a bearing on this proceeding, specifically, the Board's determination as to which party has priority and whether there is a likelihood of confusion. Accordingly, Respondent's motion to suspend for civil action is **GRANTED**, and this proceeding is **SUSPENDED** pending final disposition of the Civil Action.³

Within twenty days after the final determination of the Civil Action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

Should this proceeding be resumed, Respondent's due date for filing an answer in this proceeding shall be reset.

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³ A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).