

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

December 11, 2021

Cancellation No. 92078331

Balls Marketing LLC

v.

FINE Design Group, Inc.

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Respondent's motion (filed November 19, 2021) to suspend for a civil action. Petitioner filed a response to the motion on December 9, 2021. Although the time for filing a reply brief has not yet passed, the Board finds it appropriate to consider the motion at this juncture. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 502.02(b) (2021) and authorities cited therein.

The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of their arguments, except as necessary to explain the Board's order. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Respondent moves to suspend this proceeding pending determination of a civil action filed in the United States District Court for the Northern District of California, *Fine Design Group, Inc. v. Fine The Agency*, 4:20-cv-09459 (the "Civil Action").

Respondent filed a copy of its amended complaint and Petitioner's answer and counterclaims in the Civil Action concurrently with its motion.

Respondent alleges that the Board proceeding should be suspended because the Civil Action involves the same parties and raises the same issues as the Board proceeding. In response, Petitioner argues that the Board should not suspend proceedings, because the cancellation proceeding is more narrow than the Civil Action and the Board has expertise in determining a party's right to maintain a registration.

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* Trademark Rule 2.117(a); TBMP § 510.02(a).

Following a careful review of the record, the Board finds that a decision by the district court in the Civil Action could have a bearing on the issues in this proceeding. Specifically, in the Civil Action, Petitioner has asserted, inter alia, a counterclaim of bad faith enforcement alleging that Respondent's involved mark is primarily merely a surname. 4 TTABVUE 46. Petitioner has also alleged that Respondent's mark is primarily merely a surname in the cancellation proceeding. Thus, the Civil Action involves the same parties, the same marks, and similar claims. Additionally, because the Civil Action involves broader claims not at issue in the cancellation proceeding, suspending the Board proceeding pending disposition of the Civil Action would serve the interests of efficiency and judicial economy.

The Board also notes that, to the extent that a civil action in a federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board. *See Wella Corp. v. Cal. Concept. Corp.*, 194 USPQ 419, 423 (CCPA 1977); *Midland Cooperatives, Inc. v. Midland Int'l Corp.*, 164 USPQ 579, 583 (CCPA 1970). Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b).

In view of the foregoing, Respondent's motion to suspend proceedings is **granted** and this proceeding is **suspended** pending final disposition of the Civil Action, including all appeals or remands.¹

Within **twenty 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 that issued in the Civil Action.

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.

¹ 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).