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

Proceeding no.	92079816
Party	Defendant Light Street Capital Management, LLC
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Date	07/12/2023
Attachments	Reply in Support of Motion to Suspend Proceeding.pdf(512143 bytes)

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

In the Matter of **LIGHT STREET** Reg. No. 5,212,320

Light Street Ventures LLC, Light Street Capital)	
Management LLC, and Light Street)	
Investments LLC,)	
)	
Petitioners,)	
)	
)	Cancellation No. 92,079,816
)	
v.)	
)	
Light Street Capital Management, LLC)	
)	
Respondent.)	
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**REPLY IN SUPPORT OF MOTION TO SUSPEND PROCEEDING
PENDING OUTCOME OF CIVIL ACTION**

Respondent Light Street Capital Management, LLC did not file the civil action as a type of tactical gamesmanship or forum shopping. Rather, Respondent filed the civil action because the Trademark Trial and Appeal Board (the “Board”) does not have jurisdiction to resolve Respondent’s trademark infringement claims, nor the authority to issue the remedies Respondent seeks in the civil action. Respondent filed its civil action as soon as it became apparent that the parties would not be able to resolve the dispute amicably and before it even filed its answer in this TTAB proceeding. The Board routinely grants motions to suspend under similar circumstances. Here too, the Board should grant Respondent’s Motion to Suspend the Proceeding Pending the Outcome of the Civil Action.

I. Respondent Did Not File the Civil Action as a Type of Gamesmanship or Forum Shopping.

Shortly after Petitioners filed their Petition for Cancellation in this proceeding, Respondent filed a brief motion to dismiss based on a single procedural argument in an effort to quickly resolve the proceeding. On October 25, 2022, the TTAB issued a short decision denying Respondent's motion to dismiss on the ground that Petitioners technically had met the pleading standard.

Shortly after the Board issued its decision on the motion to dismiss, Petitioners, not Respondent, initiated settlement discussions. Respondent participated in these settlement discussions in good faith. Petitioners made their first settlement offer on December 16, 2022. Respondent made a counteroffer on January 6, 2023. The parties had a call to discuss settlement on January 18, 2023 and opposing counsel agreed to send a revised offer based on Petitioners' anticipated rebranding costs. Petitioners did not send their anticipated rebranding costs and revised settlement demand until March 17, 2023. Counsel for both parties had another call to discuss settlement on March 27, 2023. Shortly thereafter, on April 10, 2023, Petitioners requested a 90-day suspension of the TTAB proceeding, to which Respondent consented. All suspensions of this proceeding, including this 90-day suspension, were consented motions.

This proceeding remains suspended until July 23, 2023, which is Respondent's deadline to answer the Petition for Cancellation. Discovery in this proceeding has not yet opened.

As soon as Respondent realized the settlement negotiations were no longer fruitful and the parties were unlikely to resolve the dispute, Respondent filed a civil action in the Northern District of Illinois alleging trademark infringement, unfair competition, and deceptive trade practices in violation of federal and Illinois state law. In its complaint filed in federal court,

Respondent seeks a permanent injunction enjoining Petitioners from using the LIGHT STREET mark or any mark that is similar thereto, along with an award of damages and Petitioners' profits.

II. The Board Routinely Suspends Proceedings Under Similar Circumstances.

“It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case.” *Ara Ohanian v. Tekno Products, Inc.*, Opposition No. 91237581, 2019 WL 367659, at *1 (TTAB, Jan. 25, 2019) [non-precedential] (citing Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) and *New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011)) (attached hereto as Exhibit A).

The Board has suspended its proceedings pending the outcome of a civil action under circumstances similar to those present in this case. For example, in *Solid 21 Inc. v. Corey J. England*, the Board suspended an opposition where the applicant had yet to file its answer, and instead filed a motion to dismiss. Opposition No. 91162389, 2005 WL 376725 (TTAB, Feb. 10, 2005) [non-precedential] (attached hereto as Exhibit B). Because the briefing on the motion to dismiss involved matters outside the opposition pleading, the Board treated it as a motion for summary judgment. *Id.*, at *1. The Board did not grant summary judgment, but noted there was a civil trademark infringement action between the same parties that involved issues of “ownership and priority of use of the mark at issue [in the opposition proceeding].” *Id.*, at *2. The Board held “the civil action [would], at the very least, have a bearing on the issues before the Board in [the] opposition,” and thus, suspended the opposition proceeding pending the outcome of the civil action. *Id.*

Similarly here, the civil action in the Northern District of Illinois involves issues of priority of use of the LIGHT STREET mark, along with allegations of trademark infringement, unfair competition and deceptive trade practices, all of which would have a bearing on the issues

before the Board in this proceeding. As demonstrated in *Solid 21*, the fact that Respondent filed a short motion to dismiss early in this proceeding does not create an unusual circumstance.

Nor does the fact that this proceeding has been pending for a year create an unusual circumstance. To start, this proceeding has been suspended a majority of the year that it has been pending for good faith settlement negotiations. Second, the Board has suspended its proceedings pending the outcome of a civil action that was filed much more than a year after the initial Board proceeding was filed. *See, i.e., Arcadia Grp. Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d 1134 (T.T.A.B. 2011) (suspending TTAB proceeding pending a civil action, despite the fact that the parties had been litigating before the Board for several years before the civil action was filed). Here too, the Board should follow its standard policy and suspend this proceeding pending the outcome of the civil action filed in the Northern District of Illinois.

III. Petitioners' Citations to Cases Refusing to Suspend a TTAB Proceeding Pending the Outcome of a Civil Action Are Inapposite.

Petitioners cite to two TTAB decisions where the Board refused to suspend a TTAB proceeding pending the outcome of a civil action. In both instances, the TTAB proceeding at issue had already reached the trial period and discovery had closed, unlike here where discovery has yet to even start.

In *Jodi Kristopher Inc. v. Int'l Seaway Trading Corp.*, the petitioner waited to file a civil action until the TTAB proceeding had reached the trial period. 91 U.S.P.Q.2d 1957 (T.T.A.B. 2009). The petitioner “failed to take testimony or submit evidence during its original or second testimony period” in the TTAB proceeding. *Id.* Instead, on the last day of the petitioner’s second 30-day testimony period, the petitioner filed a civil action. *Id.* The Board concluded that the filing of the “civil action (on identical claims) on the last day of petitioner's testimony period was

solely for purposes of delay and not for advancing resolution of its claims.” *Id.* Thus, the Board refused to suspend the TTAB proceeding pending the outcome of the civil action. *Id.*

Similarly, in *Jymax, Inc. v. ESR Performance Corp.*, the Board found “unusual circumstances [were] present” because the parties’ trial periods had closed before the civil action was filed. Cancellation No. 9206387, 2018 WL 1010721 (TTAB, Feb. 15, 2018) [non-precedential] (attached hereto as Exhibit C). The Board held that the filing of the civil action at the “final stage” of the TTAB proceeding “suggest[ed] an attempt to forestall a final outcome in this proceeding.” *Id.* Thus, the Board refused to suspend the TTAB proceeding pending the outcome of the late-filed civil action. *Id.*

Both *Jodi Kristopher* or *Jymax* presented unusual circumstances, and thus, were outliers to the standard procedure of the Board suspending its proceedings pending the outcome of a civil action. The circumstances of this case are not similar to those in *Jodi Kristopher* or *Jymax*. This TTAB proceeding is nowhere near its final stage. Rather, Respondent has yet to file an answer and discovery has not opened. Moreover, there is a reasonable explanation as to why Respondent waited to file its complaint in federal court. The parties have been engaged in settlement negotiations over the past several months. This does not indicate gamesmanship by Respondent, but rather the opposite. Respondent attempted to resolve this dispute amicably before escalating it. Only after determining an amicable resolution was unlikely did Respondent file its civil action. Furthermore, Respondent filed its civil action months before its next deadline (the July 23rd deadline to answer), unlike the petitioner in *Jodi Kristopher*, which waited until the last day of its second testimony period to file its civil action in an obvious attempt to delay.

Petitioners also cite to two federal cases where a motion to stay a civil action was granted pending the outcome of a TTAB proceeding. Again, in both instances, discovery in the TTAB proceeding was nearly closed, unlike here.

In *Tigercat Int'l, Inc. v. Caterpillar Inc.*, the District of Delaware stayed a civil action where the TTAB proceeding had been ongoing for *three years*. No. 16-CV-1047-GMS, 2018 WL 2049816 (D. Del. May 2, 2018). During that time, the parties had engaged in extensive discovery, including taking 22 depositions and producing over 35,000 pages of documents. *Id.* at *1. Tigercat filed the civil action only ten days before the close of discovery in the TTAB proceeding and only two months before the trial date. *Id.* at *5. In other words, by the time Tigercat filed the civil action, the TTAB proceeding was nearly finished. The court criticized Tigercat's decision to wait to file its civil action for such a long period of time "without offering the court any explanation as to why." *Id.* The court granted the motion to stay pending the outcome of the TTAB proceeding, reasoning that "resetting the clock at this stage of the proceedings strikes the court as a monumental waste of time, money, and effort." *Id.*

Similar to the court in *Tigercat*, in *Shaf Int'l, Inc. v. Ultimate Leather Apparel, Inc.*, the District of New Jersey stayed a civil action where discovery in the TTAB proceeding had already closed and the TTAB proceeding was ripe for dispositive motion practice. No. CV 20-2569 (JMV), 2020 WL 7137929 (D.N.J. Dec. 7, 2020). Moreover, in *Shaf*, the same party filed both the TTAB proceeding and the civil action. In granting the motion to stay, the court reasoned that "Shaf litigated the case before the TTAB for nearly a year before commencing this action in the District Court. If it wanted to have its claims decided in the federal court, Shaf could have filed the case here in the first instance." *Id.* at *2. The court further explained that "Defendants should

not have to duplicate their efforts and spend additional resources merely because *Shaf* would now prefer to have its claims heard here.” *Id.* at *3.

Unlike the procedural posture in *Shaf*, the TTAB proceeding here was filed by Petitioners, not Respondent. The fact that Respondent filed a civil action does not indicate that Respondent was forum shopping or was somehow “unsatisfied with its fortunes in this proceeding.” Petitioners’ Brief in Opposition of Respondent’s Motion to Suspend Proceeding Pending Outcome of Civil Action, p. 4. Respondent did not file the civil action as a response to the TTAB’s denial of Respondent’s motion to dismiss on technical grounds. Rather, Respondent filed the civil action because its claims and the remedies it seeks are outside the jurisdiction of the Board. Respondent waited a few months to file its complaint in this civil action in a good faith attempt to resolve this dispute. As soon as it became apparent that the parties were unlikely to reach an agreement, Respondent filed its complaint. Even so, Respondent filed the civil action before filing its answer in the TTAB proceeding, let alone the beginning of discovery, whereas the plaintiff in *Shaf* waited to file its civil action until discovery in the TTAB proceeding was nearly complete.

Both *Tigercat* and *Shaf* are outliers to the standard procedure of courts denying motions to stay pending the outcome of a TTAB proceeding. The facts of this case do not fit within the particular circumstances that were present in *Tigercat* or *Shaf*. Accordingly, the TTAB proceeding, not the civil action, should be suspended. The Board should follow standard procedure and grant Respondent’s motion to suspend the TTAB proceeding pending the outcome of the civil action.

IV. Conclusion

For the reasons outlined above, Respondent respectfully asks the Board to grant its motion to suspend the TTAB proceeding pending the outcome of the civil action.

Dated: July 12, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing REPLY IN SUPPORT OF MOTION TO SUSPEND PROCEEDING PENDING OUTCOME OF CIVIL ACTION was served upon the counsel for Light Street Ventures LLC identified below by email on July 12, 2023:

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EXHIBIT A

2019 WL 367659 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

ARA OHANIAN

v.

TEKNO PRODUCTS, INC.

Opposition No. 91237581

January 25, 2019

***1 M. Catherine Faint, Interlocutory Attorney:**

This case now comes before the Board for the following motions:

- 1) Opposer's motion, filed November 20, 2018, to compel discovery responses;¹
- 2) Applicant's motion, filed January 3, 2019, to suspend for civil action, which motion is contested;
- 3) Opposer's cross-motion, filed January 23, 2019, for discovery sanctions.

The Board exercises its discretion to decide the matter prior to full briefing by the parties.

By its order of December 14, 2018, the Board reviewed the pleadings striking certain claims and defenses, allowed the parties time to amend their pleadings, denied Applicant's motion to compel, and noted that although Opposer's motion to compel was filed while proceedings were suspended, allowed time for briefing on the motion to compel with Applicant's response due January 3, 2019. On January 3, 2019, Applicant filed its motion to suspend for disposition of a civil action between the parties.²

Motion to Suspend

For the sake of efficiency, the Board turns first to Applicant's motion to suspend for civil action. The motion seeks to suspend this proceeding pending final determination of Civil Action No. 2:19-cv-91 filed in the United States District Court for the District of New Jersey, styled as *Tekno Prods., Inc. v. Glove Trends, et al.* Applicant included the complaint with its motion, and a review of the pleading shows that it involves the same parties and includes a claim for trademark infringement regarding the parties' marks at issue in this Board proceeding. Opposer argues that Applicant's motion to suspend should be denied as filed during the pendency of the motion to compel, and in the interest of judicial efficiency.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. See [Trademark Rule 2.117\(a\)](#), 37 C.F.R. § 2.117(a). See also *New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have bearing on issues before Board). Any Court findings regarding the ownership of the marks would have a bearing on this Board proceeding involving the same marks. As the District Court proceeding involves the same parties and the same marks, the motion to suspend for civil action is **granted** as well taken.

Motion to Compel/Motion for Sanctions

Opposer argues that because Applicant filed its motion to suspend for civil action without responding to the discovery motion, the Board should treat the motion to compel as conceded. Opposer then proceeds to move immediately for discovery sanctions.

*2 As the motion to suspend for civil action was filed promptly and within the time for response set by the Board, the Board declines to treat the motion as conceded. The Board has found that the civil action may have a bearing on these Board proceedings.

Accordingly, Opposer's motion to compel is **denied without prejudice**. If Opposer believes its motion to compel was not resolved or made moot as a result of the final determination by the District Court, Opposer may renew the motion by citing its title, date of filing, and docket entry in the Board's electronic proceeding file. Any motion **renewed must be accompanied by a signed statement** that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

While the Board has broad authority to impose sanctions when necessary, the Board will not normally impose discovery sanctions unless a party fails to comply with an order of the Board relating to discovery, or a party fails to make initial or expert disclosures or fails to respond to discovery requests, and the non-responding party informs the party seeking discovery that no response will be made thereto. *See Trademark Rule 2.120(g)(1) and (2)*.

In this case the motion for discovery sanctions is premature and **will not be given further consideration** because an order compelling discovery was not previously issued as Rule 2.120(g)(1) requires.

Proceedings are Suspended

Accordingly, proceedings are **suspended** pending final disposition of the civil action.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.³ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

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. Upon resumption, if appropriate, the Board may consolidate related Board cases.

Footnotes

- 1 Opposer's notice, filed January 23, 2019, of appearance for an associate attorney is noted.
- 2 On January 2, 2019, Opposer filed a "notice of pending civil action" regarding a pending civil action between the parties filed in the Northern District of Georgia. Opposer reports the case was terminated January 10, 2019.²⁴ TTABVue 5.
- 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).

2019 WL 367659 (Trademark Tr. & App. Bd.)

EXHIBIT B

2005 WL 376725 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

SOLID 21 INCORPORATED

v.

COREY J. ENGLAND

Opposition No. 91162389

February 10, 2005

*1 Before Hanak, [Hohein](#) and Chapman
Administrative Trademark Judges

By the Board:

Corey J. England (“applicant”) seeks to register the mark ICEMAN for “jewelry, jeweled watches, precious gemstones, semi-precious gemstones, diamonds, costume jewelry and crystal jewelry” in International Class 14.¹

Registration has been opposed by Solid 21 Incorporated (“opposer”). As grounds for opposition, opposer alleges that it is the owner of an application for the mark ICEMAN for “jewelry items made of precious metal, namely, watches, necklaces, bracelets, rings, anklets, cufflinks, hairpins, belt buckles, tie clips and pegs, and earrings” in International Class 14 and “advertising and promoting the sale of jewelry through the distribution of printed materials, retail outlets, radio, television and the Internet” in International Class 35.² Opposer further asserts that it has made use of the mark ICEMAN in connection with jewelry items, as well as advertisement and promotion thereof, prior to either the filing date of applicant's involved application or any dates of first use alleged by applicant therein. Opposer asserts in addition that as a result of its extensive sales, advertising and promotion of its goods and services under its ICEMAN mark, the mark has become well known by the general public; that as a result of the similarities between the parties' marks and related nature of their goods and services, confusion is likely among consumers as to the source of those goods and services; that, moreover, applicant is not the owner of the ICEMAN mark; and that, as a result of the foregoing, use and registration of the ICEMAN mark by applicant will result in damage to opposer.

In lieu of an answer, applicant filed a motion to dismiss the opposition under [Fed. R. Civ. P. 12\(b\)\(6\)](#) for failure to state a claim upon which relief can be granted.³ Opposer filed a brief in response, and submitted as an exhibit a portion of the deposition of applicant, taken in a civil action between the parties. In addition, opposer submitted the declaration of its attorney in support thereof.⁴ In addition, applicant submitted a reply brief which the Board has considered.⁵ Applicant submitted as an exhibit with its reply brief a copy of a receipt for the sale of an item of jewelry. Inasmuch as we have considered matters outside of the opposition pleading in this decision, we shall treat applicant's motion to dismiss as one for summary judgment under [Fed. R. Civ. P. 56](#).⁶ See, for example, [Fed. R. Civ. P. 12\(b\)](#); and *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993).

Motion for Summary Judgment

*2 It has often been stated that summary judgment is an appropriate method of disposing of cases in which there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See [Fed. R. Civ. P. 56 \(c\)](#). The party

moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

In this case, after reviewing the arguments and evidence submitted by the parties, we conclude that there are genuine issues of material fact which preclude disposition of this matter by summary judgment. There exist, at a minimum, genuine issues of material fact with regard to priority, as well as whether applicant has made use of its mark analogous to trademark use. *See, for example, T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996).

In view thereof, applicant's motion for summary judgment is **denied**.⁷

Proceedings Suspended

We note that the parties are currently involved in a trademark infringement action involving the mark at issue in this opposition proceeding.⁸ It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See Trademark Rule 2.117(a)*. In this case, the parties to the civil action include the parties herein and the issues include ownership and priority of use of the mark at issue herein. As such, the civil action will, at the very least, have a bearing on the issues before the Board in this opposition.

Accordingly, proceedings are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

Amendment of Use Dates

*3 Finally, we note that applicant indicates it made use of its mark earlier than the date alleged in its application, and that it is amending its application to an earlier date of first use and date of first use in commerce. In that regard, the parties are reminded that an applicant seeking to prove a date of use earlier than the date alleged in its application must do so by clear and convincing evidence. *See Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 1 USPQ2d 1772 (Fed. Cir. 1987). Thus, in the event that the civil action between the parties is not dispositive of this proceeding, the burden will rest on any party seeking to prove such an earlier date of use by the stricter standard of clear and convincing evidence, in accordance with the above authority.

Footnotes

- 1 Application Serial No. 78175570 was filed on October 17, 2002, asserting August 1, 1995 as the date of first use of the mark anywhere and in commerce in connection with the recited goods.
- 2 Application Serial No. 76465856 was filed on November 11, 2002, based upon opposer's assertion of its bona fide intent to use the mark in commerce.
- 3 Applicant's revocation and appointment of attorney, filed therewith, has been made of record.

- 4 Opposer's motion to accept its late-filed response to applicant's motion to dismiss is hereby granted based upon the showing made therein and, moreover, as conceded. *See Trademark Rule 2.127(a)*; and TBMP §509 (2d ed. rev. 2004) and the authorities cited therein.
- 5 Consideration of reply briefs is discretionary on the part of the Board.
- 6 We note nonetheless that in its notice of opposition, opposer has pleaded a claim upon which relief can be granted in that it has sufficiently pleaded its standing as well as priority and likelihood of confusion. *See Fed. R. Civ. P. 8; King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1978).
- 7 The parties are advised that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during their appropriate trial periods. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).
- 8 Case No. 04 CV 02370, styled *Christopher Aire and Solid 21 Incorporated v. Corey England, Midwest Gems, Inc., et. al.*, brought in the United States District Court for the Southern District of New York.

2005 WL 376725 (Trademark Tr. & App. Bd.)

EXHIBIT C

2018 WL 1010721 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

JVMAX, INC.

v.

ESR PERFORMANCE CORP.

Cancellation No. 92063873

February 15, 2018

*1 Christen M. English, Interlocutory Attorney:

This case now comes up on Respondent's motion, filed January 19, 2018, to suspend this proceeding pending disposition of a civil action involving the parties, also filed January 19, 2018: *ESR Performance Corp. v. JVMAX, Inc.*, Case No. 1:18-cv-20247, pending in the United States District Court for the Southern District of Florida (the "Federal Case"). Petitioner opposes the motion.

Petitioner seeks cancellation of Registration No. 4954143 on the ground that the product configuration subject to the involved registration (the "'143 Trademark") lacks inherent distinctiveness and is functional. Petitioner also alleges that the registration for the '143 Trademark was fraudulently obtained.

The Board proceeding is in the final briefing stage. Petitioner filed its main brief on January 20, 2018 - one day after Respondent filed its motion to suspend. Respondent's main brief is due February 18, 2018. 17 TTABVUE.

Respondent argues that suspension is appropriate because the issue in the Federal Case is whether Petitioner is infringing Respondent's rights in the '143 Trademark, and therefore, "the '143 Trademark's validity will be litigated and determined in the district court litigation." 22 TTABVUE 2.

Petitioner argues that "Respondent's Motion is merely an attempt to delay the impending cancellation of [the '143 Trademark]" and that "for purposes of judicial efficiency, economy and fairness, the Board should ... allow the instant proceeding to continue to final decision." 33 TTABVUE 2. In support of this position, Petitioner asserts that "Respondent chose not to conduct discovery in the instant proceeding, failed to produce documents requested by Petitioner related to its claim of acquired distinctiveness, failed to take any testimony depositions, and failed to submit any evidence during its trial period." *Id.*

[Trademark Rule 2.117\(a\)](#) provides that the Board "may" suspend a proceeding pending disposition of a civil action involving one or both parties that "may have a bearing on" the Board proceeding. Generally, the Board will exercise its discretion and suspend unless there are unusual circumstances.

Here, unusual circumstances are present. The parties' trial periods are closed and Petitioner has filed its main brief in the Board proceeding. The timing of the Federal Case, filed in the final stage of the Board proceeding, suggests an attempt to forestall a final outcome in this proceeding. In these circumstances, the Board, in its discretion, declines to suspend proceedings pending disposition of the Federal Case. *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018-19 (TTAB 2003) (explaining that the language of [Trademark Rule 2.117\(a\)](#) is "permissive" and that a party "should not be allowed to delay the outcome of this proceeding when there would be little or nothing to resume upon conclusion of [the Federal Case]."); *Ortho Pharm. Corp. v. Hudson Pharm. Corp.*, 178 USPQ 429 (TTAB 1973) (denying motion to suspend after final briefing as "untimely since orderly procedure requires that opposer is entitled to a decision on the record before [the Board]").

*2 In view of the foregoing, Respondent's motion to suspend is **DENIED**. The deadlines for Respondent's main brief, and Petitioner's reply brief, if filed, are reset as follows:

Defendant's Main Brief Due March 10, 2018

Plaintiff's Reply Brief Due March 25, 2018

Trial briefs shall be submitted in accordance with [Trademark Rules 2.128\(a\) and \(b\)](#). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by [Trademark Rule 2.129\(a\)](#).

2018 WL 1010721 (Trademark Tr. & App. Bd.)

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