

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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September 29, 2023

Cancellation No. 92079816

Light Street Ventures LLC

v.

Light Street Capital Management, LLC

Jill M. McCormack, Interlocutory Attorney:

This case comes before the Board for consideration of Respondent's motion to suspend this proceeding pending the outcome of a civil action between the parties.

The motion is fully-briefed.

I. The Board Proceeding

Respondent owns a registration for the standard-character mark LIGHT STREET for "financial services, namely, hedge fund investment services, investment advisory services, investment management services, financial asset management services, private equity investment services, investment consultation, and investment of funds for others," in International Class 36.¹ On May 27, 2022, Petitioner² filed a petition for cancellation on the ground of likelihood of confusion under Section 2(d) of the

¹ Registration No. 5212320 was issued on May 30, 2017.

² Because Petitioner did not advise the Board that it seeks to add any additional party plaintiffs in response to the Board's October 25, 2022 order, nor pay the required fee, Light Street Ventures LLC remains the only Petitioner in this proceeding. 7 TTABVUE 4–6.

Trademark Act, 15 U.S.C. § 1052(d). Petitioner has alleged, inter alia, common law rights in the mark LIGHT STREET “since at least December 6, 2015 in connection with the offering, marketing, advertising, and promotion of its investment and financial products and services.”³

On June 2, 2023, Respondent filed a motion to suspend this proceeding pending the outcome of the below-discussed civil action.

II. The Civil Action

Respondent seeks suspension of this proceeding pending the outcome of a civil action between the parties, namely, *Light Street Capital Management, LLC v. Light Street Capital Management LLC, et al.*, Case No. 1:23-cv-2616, pending in the United States District Court for the Northern District of Illinois. Respondent filed the civil action on April 26, 2023, and alleges, inter alia, trademark infringement in connection with the involved registration in the Board proceeding. Respondent seeks, inter alia, a permanent injunction preventing Petitioner from using the mark LIGHT STREET on or in connection with the offering, promotion, marketing or sale of financial services.⁴

III. Applicable Legal Principles

Trademark Rule 2.117(a), provides that:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding, or an expungement or reexamination proceeding may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action, the other Board proceeding, or the expungement or

³ 1 TTABVUE 4, ¶ 3.

⁴ 16 TTABVUE 14–15.

reexamination proceeding. A civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought.

37 C.F.R. § 2.117(a). It is the policy of the Board, absent unusual circumstances, to suspend proceedings when a party or parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See, e.g., Monster Energy Co. v. Martin*, 125 USPQ2d 1774, 1778 (TTAB 2018); *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 a bearing on issues before the Board); *WhopperBurger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806–07 (TTAB 1971). The Board typically will review the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board proceeding. *See New Orleans La. Saints LLC*, 99 USPQ2d at 1552.

IV. Analysis and Decision

As noted above, in the civil action, Respondent seeks, inter alia, an order that Petitioner may not use the mark LIGHT STREET on or in connection with the offering, promotion, marketing or sale of financial services. As a result, the civil action raises issues of fact and law that may have a bearing on this proceeding, and judicial economy will be served by suspension. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.01 (2023). If, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board may go forward with its proceeding. TBMP § 510.02(a). Here, however, although Petitioner

contends that it has sought a stay of the civil action from the District Court, Petitioner does not argue that such a stay has been granted.⁵

In view of the foregoing, Respondent's motion to suspend this proceeding pending the disposition of the civil action between the parties is **granted**.

V. Proceeding Suspended

Proceedings are suspended pending final disposition of the civil action.⁶ Within **TWENTY (20) DAYS** after the final determination of each civil action, the parties shall so notify the Board, in writing, so that these proceedings may be called up for appropriate action. 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 (i) any address or email address changes for the parties or their attorneys, and (ii) any other related cases, even if they become aware of such cases during the suspension period.

⁵ To the extent that such a stay of the civil action is granted by the District Court in the future, Petitioner may request resumption of this proceeding.

⁶ A civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought. Trademark Rule 2.117(a).