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

Proceeding	91196055
Party	Plaintiff BBY Solutions, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	08/19/2011
Attachments	Motion to Suspend.pdf (32 pages)(1099554 bytes)

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

In the matter of Application Serial No.: 77/841,065
by Elephant Group, Inc. for the Mark: **SUPPORTSQUAD**
Filed: October 5, 2009

Published in the Official Gazette
on April 20, 2010

BBY SOLUTIONS, INC.
Opposer,

v.

ELEPHANT GROUP, INC.,
Applicant.

Opposition No. 91196055

MOTION TO SUSPEND PROCEEDINGS DUE TO PENDING CIVIL ACTION

Pursuant to Trademark Rule 2.117(a), BBY Solutions, Inc. (“BBY Solutions”) hereby moves to suspend these proceedings due to the filing of a trademark infringement and unfair competition lawsuit on August 2, 2011 by BBY Solutions against Applicant Elephant Group, Inc. (“Elephant Group”) in the District Court for Minnesota, and in support thereof would show as follows:

1. On August 12, 2010 the above Opposition was commenced. Since that time the parties have conducted limited discovery, namely the exchange of documents and responding to Interrogatories as well as serving one third party subpoena.

2. On August 2, 2011, BBY Solutions, along with two other related entities, filed suit against Elephant Group and several other related entities, as well as the principal owner of these entities, in federal district court in Minnesota, entitled *BBY Solutions, Inc., et al v. Elephant Group, Inc., et al*, Case 0:11-cv-02195-DSD-JJK, in the United States District Court, District of Minnesota (the “Minnesota Infringement Action”). The Complaint that was filed in that action, a true and correct copy of which is attached hereto as Exhibit A, alleges a number of claims, including trademark infringement, dilution and unfair competition. *See* Complaint, pp.1-14. The Complaint also seeks, among other remedies, an injunction prohibiting the defendants, including Elephant Group, from (1) using the mark SUPPORTSQUAD anywhere in the United States; and (2) registering the mark SUPPORTSQUAD, as well as an order certified to the USPTO, directing that the current Application be refused with prejudice. *See*, Complaint at pp. 14-16.

3. Under Trademark Rule 2.117(a), whenever the Board becomes aware that the parties in an opposition have become parties to a civil action that may be dispositive of the issues pending before the Board, the Board may suspend the opposition pending resolution of the civil action if the issues before the court have any bearing on the Board’s decision in the opposition due to the fact that a federal court’s decision is binding on the Board whereas the Board’s decision is not binding on the court. *Forest Laboratories Inc. v. G. D. Searle & Co.*, 52 U.S.P.Q.2d 1058, 1061 T.T.A.B. 1999). Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board. Trademark Rule 2.117(a); *accord*, 6 McCarthy on Trademarks and Unfair Competition _32:47 (4th Edition updated May, 2011) (“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”)

4. In the present case, the Board should suspend these proceedings pending resolution of the Minnesota Infringement Action because a decision by the Minnesota district court could have bearing on the exact issues in this proceeding. For example, if BBY Solutions is successful in its case, it could obtain an injunction prohibiting any use of the mark SUPPORTSQUAD, which is the mark at issue in this proceeding. Moreover, BBY Solutions has also sought to enjoin any attempts to register the SUPPORTSQUAD mark, and has also asked for the issuance of an order directed to the USPTO to refuse registration of this mark. Therefore, because such relief if granted would not allow Elephant Group to proceed with unrestricted registration, and because Elephant Group's entitlement to such registration is the issue before this Board, the district court's decision clearly has a bearing on the issues before the Board and thus the Board should suspend these proceedings until resolution of the Minnesota Infringement Action.

5. Finally, if this proceeding is suspended no prejudice will occur to Elephant Group. As noted previously, little discovery was been conducted to date and in fact that parties have not taken one deposition to date. This is not the case where these proceedings are so far along that it would be unfair and prejudicial to suspend the matter. *See, Boyds Collection Ltd. V. Herrington & Company*, 65 U.P.S.Q. 2d 2017, 2003 WL 152427 (T.T.A.B. 2003) (where the parties engage in discovery, take testimony, offer evidence and file briefs, it would be unfair and prejudicial to suspend the opposition).

6. BBY requested Elephant Group to consent to this Motion but as of the filing of this Motion, Elephant Group has not granted its consent.

For all of the forgoing reasons, BBY Solutions, Inc. prays that the Board suspend these proceedings until resolution of the Minnesota Infringement Action.

Date: August 19, 2011

Respectfully submitted,

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permission*

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