

ESTTA Tracking number: **ESTTA401184**

Filing date: **04/01/2011**

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

Proceeding	91199060
Party	Defendant Pure Entertainment, LLC
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Submission	Motion to Suspend for Civil Action
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Date	04/01/2011
Attachments	Applicant's Motion to Suspend Opposition Proceeding.pdf (29 pages)(1775800 bytes)

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8 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
9 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
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11 BUTTER LICENSING, LLC,
12 Opposer,
13 v.
14 PURE ENTERTAINMENT, LLC,
15 Applicant.
16

Opposition No. 91199060
Mark: BUTTER LICENSING, LLC
Serial No. 77/361106
Filed: December 28, 2007
Published for Opposition: November 16, 2010

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18 **APPLICANT'S MOTION TO SUSPEND OPPOSITION**
19 **PROCEEDING**

20 Pursuant to 37 C.F.R. §2.117(a), Applicant, Pure Entertainment, LLC ("**Pure**"), requests that
21 the Trademark Trial and Appeal Board (the "**Board**") suspend the above-captioned Opposition
22 proceeding pending the resolution of the federal civil action, *Butter Licensing, LLC vs. Pure*
23 *Entertainment, LLC*, 10-CV-01711-JL (the "**Federal Action**"). A copy of the complaint from the
24 Federal Action is attached hereto as Exhibit A.

25 On April 21, 2010, Butter Licensing, LLC ("**Licensing**") filed the Federal Action in the
26 United States District Court for the Northern District of California - San Francisco Division.
27 Licensing's complaint in the Federal Action states an appeal from a final decision of the Board
28 sustaining Pure's opposition to Licensing's application for registration of the trademark BUTTER

1 LOUNGE and Pure's petition to cancel Licensing's trademark registration for BUTTER
2 RESTAURANT on the grounds of Priority of Use, Likelihood of Confusion and Fraud (although the
3 Board did not find it necessary to reach the fraud allegations in granting Pure's motion for summary
4 judgment). The matter on appeal to the District Court in the Federal Action and the Opposition
5 involve common issues of fact and law such that the resolution of the Federal Action will likely be
6 binding upon the Board in deciding the instant Opposition.

7 Pursuant to 37 C.F.R. §2.117(a), the Board will suspend an inter-partes proceeding when it
8 comes to the Board's attention that the parties to the proceeding are involved in a civil action that
9 may have a bearing on the inter-partes proceeding. See *Anheuser-Busch, Inc. v. The Florists*
10 *Association Of Greater Cleveland, Inc.*, 29 U.S.P.Q.2d 1146 (1993); *Other Telephone Co. v.*
11 *Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974); *Tokaido v. Honda Associates*
12 *Inc.*, 179 USPQ 861, passim (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ
13 805, 807 (TTAB 1971). In this instance, both the Federal Action and the Opposition proceedings
14 involve the same parties, the same trademarks and will address the same legal issues, namely, the
15 priority of use of the relevant trademarks, the likelihood of confusion with Pure's BUTTER mark
16 caused by Licensing's use of a confusingly similar BUTTER mark, and fraud on the Trademark
17 Office. In fact, many of the issues raised in the Opposition may be barred by the doctrine of *res*
18 *judicata* upon a favorable outcome for Pure in the Federal Action.

19 The Opposition proceeding was filed on March 16, 2011, and the time for Pure to answer or
20 otherwise respond to the Opposition has not yet expired (Pure's response is currently due on or
21 before April 27, 2011, according to the Board's web site). Pure notes that, as of the date of this
22 Motion, effective service has not been made on Pure or its attorney of record in this proceeding. No
23 dispositive motions are pending such that the suspension of the Opposition proceeding will prolong
24 the resolution of this matter.

25 For these reasons, Pure respectfully requests that the Board suspend the above-captioned
26 Opposition proceeding including the time to answer and all other dates currently listed in the
27 schedules of dates set by the Board. Pure hereby reserves any and all objections and defenses Pure
28 may have to the Opposition and makes an appearance in this Opposition solely for purposes of

1 requesting this suspension.

2 DATED: April 1, 2011.

Respectfully,

PHELPS DUNBAR LLP

By:  _____

ANNE L. TURNER

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