

ESTTA Tracking number: **ESTTA412897**

Filing date: **06/06/2011**

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

Proceeding	91199384
Party	Plaintiff Navitar, Inc.
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Date	06/06/2011
Attachments	int2F4.PDF (5 pages)(164543 bytes) int2F5.PDF (14 pages)(561306 bytes) int2F6.PDF (16 pages)(755855 bytes) int2F7.PDF (4 pages)(93851 bytes) int2F8.PDF (6 pages)(200347 bytes)

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

NAVITAR, INC.,

Opposer,

Opposition No. 91199384

v.

eSCHOLAR, LLC,

Applicant.

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO SUSPEND PROCEEDING

Navitar, Inc. ("Navitar") opposes eScholar, LLC's ("Applicant") motion to suspend the subject Opposition on the following grounds:

1. The presently pending litigation between Navitar and Applicant is not, at this time, likely to resolve factual or legal issues that will bear on this Opposition.
2. Applicant's motion to suspend the subject Opposition is premature. Applicant has not yet answered Navitar's Complaint in the action in the U.S. District Court for the Southern District of Florida, Docket No. 1:11-cv-20266-PAS.
3. Instead, Applicant filed a motion to dismiss the Southern District of Florida action. Applicant moved to dismiss asserting improper venue, lack of personal jurisdiction, and failure to state a claim. With regard to the last, at page 8 of its motion to dismiss, Applicant stated to that court that "Navitar categorically fail[ed] to meet the *Twombly* pleading requirements in alleging trademark infringement against eScholar, and thus the Complaint should be dismissed outright." (S.D. Fla., Docket No. 1:11-cv-20266-PAS, Docket Entry 10.) A copy of Applicant's motion to dismiss the Southern District of Florida action is attached as Exhibit A.

4. On May 16, 2011, Navitar moved for discovery regarding jurisdictional issues in the Southern District of Florida action. (S.D. Fla., Docket No. 1:11-cv-20266-PAS, Docket Entry 15.)

5. Navitar has also moved for a preliminary injunction in the Southern District of Florida action. (S.D. Fla., Docket No. 1:11-cv-20266-PAS, Docket Entry 14.) Decision of that motion does not, however, call for the court to determine whether Applicant's use of Navitar's mark causes a likelihood of confusion. Instead, it requires the court to consider, among other things, the likelihood that Navitar will ultimately be able to succeed on the merits — but not a final resolution of whether there is a likelihood of confusion. A copy of Navitar's motion for a preliminary injunction (without exhibits) is attached as Exhibit B.

6. Thus, the issues currently presented in the Southern District of Florida action relate to venue, personal jurisdiction, pleading requirements, and Navitar's likelihood of success on the merits.

7. Applicant's Answer to the Notice of Opposition, on the other hand, defends based on Applicant's position that "There is no overlap between the parties' respective consumers, retailers, channels of trade, nor in their advertising." (Answer ¶ 16.) Applicant, by its Answer, also asserts that "Even if Opposer were to expand into software, it would have no relation whatsoever to Applicant's educational software products." (*Id.* ¶ 17.) A copy of Applicant's Answer to the Notice of Opposition is attached as Exhibit C.

8. As stated in Navitar's Notice of Opposition, however, Navitar has been using the NAVITAR mark in conjunction with goods sold to all levels of educational institutions ranging from K-12 up to research labs at major universities for over 30 years. (Notice of Opposition ¶ 8.) Navitar uses its mark NAVITAR in conjunction with optics products and software products and

is in the process of expanding its software product offerings. (Notice of Opposition ¶ 7; *see also* U.S. Patent No. 7,149,662 (claiming a software system that simplifies optical component selection).) A copy of the Notice of Opposition is attached as Exhibit D.

9. Because Applicant’s application to register the mark MYNAVITAR covers a “computer software application allowing students, educators, administrators and parents to build and create pathways to success for education, personal and career goals” (Notice of Opposition ¶ 5), it is directed to the same markets and for a product of similar nature as Navitar’s products, and the use for which Applicant applied would result in confusion in the marketplace.

10. Determination of the issues presently before the District Court for the Southern District of Florida will not bear on the issues before the Trademark Trial and Appeal Board in this Opposition, namely, whether there is “overlap between the parties’ respective consumers, retailers, channels of trade, nor in their advertising” and whether Navitar’s present and expected software products have any relation to Applicant’s software products. (Answer ¶¶ 16–17.)

11. Because the Southern District of Florida action currently involves different issues than the present Opposition, proceeding with the present Opposition will not result in inconsistent results, duplication of effort, or waste of the parties’ or the Board’s time and resources.

12. Suspending the present Opposition before Applicant has even filed an Answer in the Southern District of Florida action — and before it is known what substantive issues will be contested in the Southern District of Florida action — will unduly delay this Opposition without any benefit of preventing duplication of effort.

13. 37 C.F.R. § 2.117(a) does not mandate suspension of the proceedings before the Trademark Trial and Appeal Board. Instead, it uses permissive language: “Whenever it shall

come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action ... which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action”

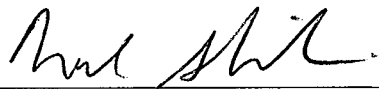
14. Navitar and Applicant sell to the same markets, including to schools and other educational institutions. Navitar’s interest in this proceeding is not to interfere with Applicant’s business but, rather, to prevent confusion as to the source of goods and services and to protect Navitar’s mark.

15. For the above reasons, suspension of the present Opposition is not warranted.

WHEREFORE, Navitar, Inc. respectfully requests that the Board deny Applicant’s Motion to Suspend Proceeding.

Dated: June 1, 2011

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