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

Proceeding	91204328
Party	Plaintiff Right Connection, Inc.
Correspondence Address	DONALD HUGHES LIFESTYLES TOURS AND TRAVEL 2375 EAST TROPICANA AVE #172 LAS VEGAS, NV 89119 UNITED STATES don@rightconnect.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Gregory P. Goonan
Filer's e-mail	ggoonan@affinity-law.com
Signature	/gregory p. goonan/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Right Connection, Inc.

Opposer,

v.

DPP Enterprises, Inc.,

Applicant.

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And Related Counterclaim

**Opposition No. 91/204328**

Application Serial No. 85/367057

**OPPOSER’S MOTION TO SUSPEND  
OPPOSITION PROCEEDING PENDING  
OUTCOME OF PENDING CIVIL ACTION  
IN FEDERAL DISTRICT COURT**

**[TRADEMARK RULE 2.117(a)/TBMP  
510.02(a)]**

**[ELECTRONICALLY FILED]**

PRELIMINARY STATEMENT

Opposer and counterclaim defendant Right Connection, Inc. (“Opposer”) submits this motion pursuant to Trademark Rule 2.117(a) and TBMP section 510.02(a) and asks the Board to suspend this proceeding pending the outcome of a trademark infringement action that Opposer has filed against Applicant in the United States District Court for the Southern District of California.

The present opposition proceeding is but one aspect of an ongoing and much broader dispute between Opposer and Applicant regarding certain trademarks owned by Opposer that feature the word “Lifestyles” for alternate adult travel services. The present proceeding simply addresses Applicant’s ability to register the trademark “Dream Pleasure Tours Lifestyle Specialists.” The broader and more significant dispute is whether Applicant can use formulations of the word “Lifestyles” to market and sell its adult travel services given that Opposer owns registered trademarks (one of which is incontestable) for the terms “Lifestyles Tours and Travel,” “Lifestyles Resorts,” and “Lifestyles Cruise.” These three referenced marks are sometimes referred to herein as the “Lifestyles Trademarks.”

On October 18, 2012, Opposer here filed an action for trademark infringement, unfair competition and declaratory relief against Applicant and its principal in the United States District Court for the Southern District of California (the “District Court Action”). A true and correct copy of Opposer’s complaint and related pleadings in the District Court Action are submitted herewith as Exhibit A.

As discussed below, Opposer’s complaint in the District Court Action asserts claims that raise the same issues as the present proceeding (for example, whether Opposer owns protectable trademark rights, whether there is a likelihood of confusion, whether the assignment addressed by Applicant’s counterclaim is valid, etc.). Moreover, as the Board is aware, the decision on such issues in the District Court Action will be binding in – indeed likely dispositive of – the present proceeding.

Accordingly, Opposer respectfully submits that this proceeding should be suspended pursuant to Trademark Rule 2.117(a) and TBMP section 510.02(a) pending the outcome of the District Court Action.

#### DISCUSSION

Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), and TBMP section 510.02(a) both provide that “[w]hensoever 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 or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.” As explained in TBMP section 510.02(a):

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court. To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.

The situation addressed in Trademark Rule 2.117(a) and TBMP section 510.02(a) is the exact situation presented here. Here, Opposer was forced to file the present opposition proceeding to prevent Applicant from obtaining a registration for the purported trademark “Dream Pleasure Tours Lifestyle Specialists” because such purported trademark is confusingly similar to the Lifestyles Trademarks. However, Applicant’s attempt to register the subject mark is but one aspect of its broader infringement of the Lifestyles Trademarks.

When settlement discussions between Opposer and Applicant were not successful, Opposer here was forced to file the District Court Action to address and remedy Applicant’s infringement of Opposer’s Lifestyles Trademarks. As the Board will see when it reviews Exhibit A, the District Court Action is a civil action between Opposer and Applicant (as well as Applicant’s principal) and involves the exact same trademarks as this proceeding, so it falls squarely within the suspension procedure of Trademark Rule 2.117(a) and TBMP section 510.02(a). Opposer’s complaint in the District Court Action also will provide the Board with a detailed discussion of the conduct and issues addressed by the District Court Action.

Where, as here, the parties to an opposition proceeding also are involved in a district court action involving the same mark or the opposed application, the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board’s decision in the opposition proceeding. [*New Orleans Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011).] This is so because a decision by the district court may be binding on the Board whereas a determination by the Board as to an applicant’s right to obtain a registration would not be binding or have any res judicata or collateral estoppel effect in the district court action. [*Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).]

It is critical to understand and remember that 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. [*New Orleans Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011).] Consequently, as explained by Professor McCarthy, “[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.” [6 *McCarthy on Trademarks and Unfair Competition*, § 32:47 (4<sup>th</sup> Ed. 2011).]

Opposer respectfully submits that suspension of the present opposition proceeding pending completion of the District Court Action is warranted and appropriate under Trademark Rule 2.117(a) and TBMP section 510.02(a). The pleadings in this proceeding are Opposer’s opposition petition and Applicant’s amended answer and counterclaim.

As the Board will recognize when it reviews such pleadings, the primary issues in this matter are (i) whether Opposer has valid and protectable trademark rights in the Lifestyles Trademarks (which are the trademarks on which the opposition is based); (ii) whether the assignment by which Opposer acquired certain rights in and to the “Lifestyles Tours and Travel” and “Lifestyles Resorts” trademarks transferred the goodwill in such marks to Opposer; (iii) whether the “Lifestyles Tours and Travel” trademark is incontestable with respect to Opposer; and (iv) whether there is a likelihood of confusion between the Lifestyles Trademarks and the mark that is the subject of this proceeding such that registration of the subject mark cannot be permitted.

As noted, the complaint in the District Court Action is submitted herewith as Exhibit A. As the Board will see when it reviews Exhibit A, Opposer has asserted claims in the District Court Action for trademark infringement, unfair competition and declaratory relief. As is true here, Opposer’s claims in the District Court Action are based on its Lifestyles Trademarks and also address Applicant’s attempt to register the purported trademark that is the subject of this proceeding. Moreover, Opposer’s claim for declaratory relief addresses the exact same assignment

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