

ESTTA Tracking number: **ESTTA617445**

Filing date: **07/24/2014**

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

Proceeding	91216892
Party	Plaintiff IVFMD P.A.
Correspondence Address	ERIN B ROTH FULBRIGHT & JAWORSKI LLP 2200 ROSS AVENUE, SUITE 2800 DALLAS, TX 75201-2784 UNITED STATES chris.andersen@nortonrosefulbright.com, doipdocket@nortonrosefulbright.com
Submission	Reply in Support of Motion
Filer's Name	Chris Andersen
Filer's e-mail	chris.andersen@nortonrosefulbright.com, doipdocket@nortonrosefulbright.com
Signature	/chris andersen/
Date	07/24/2014
Attachments	91216892 Reply to Applicants Response.pdf(1143269 bytes )

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

In the matter of Application Serial No.: 85/981,000  
For the mark: IVFMD  
Filed: April 2, 2013  
Published in the Official Gazette on June, 17, 2014

IVFMD P.C.,

Opposer,

v.

IVFMD-Florida, Inc.,

Applicant.

Opposition No. 91216892

**REPLY TO APPLICANT'S RESPONSE IN  
OPPOSITION OF MOTION TO SUSPEND**

**Summary of Background**

Suspension of this Opposition is appropriate because the parties' civil case and this Opposition involve the same issues of descriptiveness and control/ownership of the mark at issue: the abbreviation "IVFMD" (the "IVFMD Abbreviation"). Applicant-Plaintiff's response to Opposer-Defendant's Motion to Suspend (the "Response") sets forth irrelevant arguments and misstatements of fact, and cannot change the fact that the identity of issues warrants suspension.

Applicant-Plaintiff's complaint in the Civil Action Case number 3:13-cv-03527-N ("Civil Action") alleges that it owns the descriptive IVFMD Abbreviation, and that the abbreviation has acquired secondary meaning in connection with its medical services. Pl.'s First Am. Compl. ¶¶ 8, 15. A copy of Plaintiff's First Amended Complaint is attached as Exhibit A. Based on Opposer-Defendant's use of the abbreviation, Applicant-Plaintiff asserts claims for trademark infringement and false designation under the Lanham Act, among other claims. *Id.* ¶ 3.

Opposer-Defendant moved for summary judgment on the grounds that the IVFMD abbreviation is highly descriptive of Applicant-Plaintiff's services and has not acquired

secondary meaning. The brief in support of the motion for summary judgment is attached as Exhibit B. In its response to Defendant's motion in the Civil Action, attached as Exhibit C, Applicant-Plaintiff denies that IVFMD is descriptive and lacks secondary meaning, and repeatedly cites to the USPTO's treatment of its IVFMD applications, including the application at issue here, in support of its arguments. *See, e.g.*, Pl.'s Resp. Opp. Def.'s Mot. Summ. J. at 3, 5-6, 11, 17, 26. Therefore, the same arguments and issues are involved in the Civil Case and this Opposition, and resolution of these issues in the Civil Case will impact this Opposition. *See* Notice of Opp. ¶ 9. Accordingly, Opposer-Defendant's Motion to Suspend due to Civil Proceedings should be granted.

### **Argument**

According to 37 C.F.R. § 2.117(a):

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 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 evident from the pleadings in the Civil Action and this Opposition, both proceedings involve the same issues. Accordingly, a decision by the federal district court on these issues will impact the Board's decision, and suspension is warranted. *Other Tel. Co. v. Ct. Nat'l Tel. Co.*, 181 U.S.P.Q. 125 (T.T.A.B. 1974) (motion to suspend granted in opposition proceeding because final determination of same issues in civil suit affects resolution of Board proceedings), *pet. denied*, 181 U.S.P.Q. 779 (Comm'r 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (T.T.A.B. 1971) (motion to suspend granted in cancellation proceeding because a decision on the same issue by the district court would be binding upon the Board).

In the Civil Action, Applicant-Plaintiff alleges that Opposer-Defendant is infringing Applicant-Plaintiff's rights to the IVFMD Abbreviation under the Lanham Act. Opposer-Defendant has moved for summary judgment on the grounds that the IVFMD abbreviation is highly descriptive of Applicant-Plaintiff's services and lacks secondary meaning. As grounds for the Opposition, Opposer-Defendant alleges that IVFMD is so highly descriptive of Applicant-Plaintiff's services that IVFMD cannot be appropriated as a trademark. Thus, the issues of descriptiveness, secondary meaning, and rights/ownership of the mark are the same in the Civil Action and in this Opposition. A determination of these issues in the Civil Action not only should have a bearing on this Opposition, but in fact will be binding upon the Board and affect the outcome of this Opposition.

Applicant-Plaintiff has acknowledged the inter-relatedness of these proceedings by relying heavily on the proceedings in its response to Defendant's motion in the Civil Action. *See, e.g.*, Pl.'s Resp. Opp. Def.'s Mot. Summ. J. at 3, 5–6, 11, 17, 26. Yet Applicant-Plaintiff now takes the opposite position before this Board in hopes of winning its Opposition to the Motion to Suspend.

In its Response, Applicant-Plaintiff asserts only meritless arguments against suspension. First, it argues that Opposer-Defendant's Motion to Suspend improperly attempts to shift the burden to Applicant-Plaintiff. But this argument concerns the substance of the Opposition and the burden of proof applicable therein, and is irrelevant to the determination of whether the Civil Action will *have a bearing on* the Opposition. Second, the Applicant-Plaintiff's claims that the Civil Action will not resolve the same issues that will be decided in the Opposition. This argument is based on an incorrect statement of the analysis for suspension, and, as set forth above, is also factually incorrect.

Lastly, while Applicant-Plaintiff alludes to a hypothetical “loss of evidence” should the Opposition be suspended, because the Civil Case and the Opposition are so inter-related, such evidence would be properly preserved for use in the Civil Case. Applicant-Plaintiff faces no such harm if the Opposition is suspended. Therefore, in accordance with 37 C.F.R. § 2.117, suspension of this Opposition is appropriate until the Civil Action is resolved.

### **Conclusion**

The Civil Action and the Opposition involve the same issues of descriptiveness, secondary meaning, and Applicant-Plaintiff’s alleged trademark rights to the IVFMD Abbreviation. Because the outcome of the Civil Action will have a bearing on this Opposition, suspension is the appropriate course of action pending disposition of the Civil Action.

For the foregoing reasons, Applicant respectfully requests that this Opposition be suspended until final determination of the Civil Action.

Date: 07/29/2014

Respectfully submitted,



---

Erin Roth  
FULBRIGHT & JAWORSKI LLP  
2200 Ross Avenue; Suite 2800  
Dallas, Texas 75201  
Telephone: (214) 855-8000  
Facsimile: (214) 855-8200

Attorney for Opposer  
*IVFMD P.A.*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.