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

Proceeding	91218369
Party	Plaintiff Voke Tab, Inc.
Correspondence Address	VIJAY K TOKE COBALT LLP 918 PARKER STREET BUILDING A21 BERKELEY, CA 94710 UNITED STATES trademarks@cobaltlaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Gregory Soltys
Filer's e-mail	trademarks@cobaltlaw.com
Signature	/Gregory Soltys/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VOKE TAB, INC.,

Opposer,

v.

NICOVENTURES LIMITED,

Applicant.

Opposition No. 91218369

Serial No. 79/138873

Trademark: VOKE (stylized)

**OPPOSER VOKE TAB, INC.'S MOTION TO SUSPEND PROCEEDINGS IN VIEW OF
PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE §2.117(a)**

Opposer Voke Tab, Inc. ("Voke Tab") hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a).

PROCEDURAL BACKGROUND

On August 27, 2015, Voke Tab served on Applicant Nicoventures Limited ("Nicoventures") a Notice of 30(b)(6) Deposition (the "Notice") stating that Voke Tab would take the deposition of Nicoventures on September 22, 2015. On September 14, Voke Tab served a First Amended Notice of Deposition (the "First Amended Notice"), continuing the date of the deposition to October 23, 2015.

On September 14, Nicoventures filed in this proceeding a Motion to Quash both the Deposition Notice and the First Amended Notice.

On September 16, Voke Tab initiated a miscellaneous action for the issuance of a deposition subpoena in the United States District Court for the Eastern District of Virginia against Nicoventures based on this proceeding (Case No. 1:15-mc-00027-CMH-TCB). Voke

Tab filed with the court a Motion for the Issuance of a Subpoena to Testify at Deposition, requesting that the clerk of the court issue a subpoena (the "Subpoena") to Nicoventures pursuant to Fed. R. Civ. P. 30(b)(6) and 35 U.S.C.A. § 24. The Subpoena would command Nicoventures to appear pursuant to the First Amended Notice. Voke Tab expects that the court will issue the subpoena within a matter of days.

In support of this Motion to Suspend, Voke Tab submits as **Exhibit 1** the following documents that it filed with the District Court: (1) cover letter; (2) filing fee; (3) Civil Cover Sheet; (4) Motion for Issuance of a Subpoena; (5) Memorandum in Support of the Motion with exhibits.

ARGUMENT

Trademark Rule 2.117(a) provides that "[w]henver 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 or the other Board proceeding." 37 C.F.R. § 2.117(a); *see also* TBMP § 510.02(a) n.1-7; *Whopper-Burger Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (suspending proceeding in light of pending federal litigation where "the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein....") "[T]he 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 Louisiana Saints LLC & NFL Properties LLC*, 99 U.S.P.Q.2d 1550 (P.T.O. July 22, 2011) (citing *6 McCarthy on Trademarks and Unfair Competition* §32:47 (4th ed.) ("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."); *see also* TBMP § 510.02(a) n.7.

(“Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.”)

As the Board lacks the authority to compel witnesses through the subpoena power to appear for testimony in *inter partes* proceedings, district courts have subpoena authority under 35 U.S.C.A. § 24 to command the appearance of witnesses in administrative proceedings before the PTO. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 443-44 (4th Cir. 2007) (citing *Frilette v. Kimberlin*, 508 F.2d 205, 207 (3d Cir. 1975) (en banc); *Vogel v. Jones*, 443 F.2d 257, 259 (3d Cir. 1971)). “Thus, § 24 assigns a supportive role to the district courts to ensure the smooth functioning of the procedures adopted by the PTO.” *Id.* (citing *Frilette v. Kimberlin*, 508 F.2d at 210 (describing the function of the district court as “co-operatively complementing” the PTO.))

The Court of Appeals for the Fourth Circuit has held that a foreign corporation shall obey a subpoena issued by the District Court for the Eastern District of Virginia, pursuant to a Rule 30(b)(6) notice in a TTAB proceeding, and must appear in Virginia to give trial testimony. *Rosenruist-Gestao*, 511 F.3d at 448-49.

Here, in its Motion for Issuance of a Subpoena, Voke Tab has asked that the District Court issue the Subpoena commanding Nicoventures, a foreign corporation, to appear in Virginia for deposition pursuant to the *Rosenruist-Gestao* rule. The Subpoena would command Nicoventures to appear pursuant to the First Amended Notice, the same Notice that Nicoventures has asked the Board to quash in this proceeding. The pending civil action accordingly involves issues that are involved in this proceeding, namely whether Nicoventures may be compelled to appear in Virginia to give trial testimony. The District Court’s determination of this issue will

have a direct bearing on the questions that Nicoventures has raised in its Motion to Quash. *See* 37 C.F.R. § 2.117(a). Because the Board customarily defers to determination by the District Court's on legal issues having a direct bearing on Board proceedings, it is appropriate for the Board to suspend of this proceeding pending the issuance of a subpoena by the District Court for the Eastern District of Virginia.

Voke Tab therefore respectfully requests that the Board follow its customary practice of deferring to determinations by the federal district courts (*see* TBMP § 510.02(a) n.7) and suspend this proceeding pending the District Court's issuance of the Subpoena, and Nicoventures' compliance therewith, pursuant to Trademark Rule 2.117(a).

Dated this 22nd day of September, 2015

Respectfully submitted,

VOKE TAB, INC.

By Counsel:



Vijay K. Toke
Cobalt LLP
918 Parker Street
Bldg. A21
Berkeley, CA 94710
T 510.841.9800
F 510.925.2401
vijay@cobaltlaw.com

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