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

Proceeding	91223944
Party	Plaintiff VeriFone, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	02/28/2016
Attachments	Motion to SUSPEND - VERIFONE - POYNT - February 28, 2016.pdf(37487 bytes) Verifone v. Poynt - Complaint.pdf(91810 bytes) Verifone v Poynt - Exhibits A - G.pdf(4874576 bytes) Verifone v Poynt - Coversheet.pdf(71724 bytes) Verifone v Poynt - Report to PTO.pdf(17493 bytes)

Opposer, Verifone, Inc. filed the Complaint against Applicant, Poynt Co., alleging that Applicant's POYNT mark, the subject of U.S. Application Serial No. 86424322, for "computer hardware; computer software to allow users to accept financial payments through multiple means," in International Class 09 infringes Opposer's U.S. trademark registrations for the marks VERIFONE POINT, U.S. Registration No. 4844307 and POINT., U.S. Registration No. 4844308 under Section 32 of the Lanham Act, 15 U.S.C. § 1114 and creates a false designation of origin under 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Opposer further alleges against Applicant claims for cybersquatting under Section 43(d), 15 U.S.C § 1125(d) and state claims under Delaware state law, including, Trademark Dilution Under the Delaware Trademark Act, 6 Del. C. §3301 et seq., Unfair Competition under Del. Deceptive Trade Practices Act, 6 Del. C. § 2531 et seq., Delaware Common Law Trademark Infringement And Unfair Competition and Delaware Common Law Unjust Enrichment.

Opposer's Complaint for trademark infringement of Opposer's VERIFONE POINT and POINT marks by Applicant's POYNT mark raises issues that have a direct bearing on Opposition No. 91223944.

37 C.F.R. § 2.117 provides that:

(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.

Opposer's Complaint bears directly on the issue of registrability of Applicant's POYNT mark. TMEP Section 510.02(a) states that "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 may not be binding upon the court." *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the USPTO).

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board. *See Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990) (district court has no control over Board docket and no power to stay Board proceedings), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

Further, 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. *See, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need

not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board);

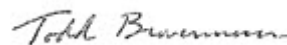
In this instance, the trademark infringement issues before the U.S. District Court, District of Delaware are equivalent and overlap the issues before the TTAB, namely, that Applicant's use and registration of the POYNT mark, U.S. Application Serial No. 86/424,322, creates a likelihood of confusion and infringes Opposer's prior U.S. registrations for VERIFONE POINT and POINT., U.S. Registration Nos. 4844307 and 4844308.

For the above reasons, Opposer respectfully submits that the TTAB suspend Opposition No. 91223944 pending the disposition of Civil Action No. Civil Action No. 1:16-cv-00105-UNA. Moreover, Opposer is filing this motion in good faith and submits that it did not delay unduly in filing this Motion to Suspend.

Accordingly, based on the above, Opposer requests that its Motion to Suspend be GRANTED.

Respectfully submitted,

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