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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(36145 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)

Registration No. 4844308. The Complaint also asserts causes of action for false designation of origin, cybersquatting, and state law claims under Delaware state law.

37 C.F.R. § 2.117 provides that: “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 or the other Board proceeding.”

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);

The present Opposition should be stayed, because, *inter alia*, the Complaint raises issues that are central to the pending Opposition. 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 example, the Complaint bears directly on the issue of registrability of Applicant's POYNT mark, because a central element in the Complaint is whether there is likelihood of confusion between Applicant's POYNT mark, and Opposer's registered trademarks. That issue is common to the present Opposition, insofar as if Opposer prevails on the likelihood of confusion, Applicant's POYNT mark is not entitled to registration.

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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