

ESTTA Tracking number: **ESTTA745129**

Filing date: **05/09/2016**

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

Proceeding	91225175
Party	Defendant Thomas Ice
Correspondence Address	WOODROW H POLLACK GRAYROBINSON PA SUITE 2700, 401 E JACKSON STREET TAMPA, FL 33602 UNITED STATES woodrow.pollack@gray-robinson.com, whpPTODocket@gray-robinson.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Woodrow H. Pollack
Filer's e-mail	woodrow.pollack@gray-robinson.com
Signature	/Woodrow H. Pollack/
Date	05/09/2016
Attachments	Terry v Ice Legal - Motion to Suspend.pdf(19878 bytes) Exhibit A.pdf(521714 bytes) Exhibit B.pdf(570329 bytes) Exhibit C.pdf(4585469 bytes)

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

BRENNA TERRY,)	Opposition No.: 91225175
)	
Opposer,)	Application No.: 86/635,477
)	
v.)	Mark: LAWTENDER
)	
THOMAS ICE,)	Published in the Official Gazette:
)	August 4, 2105
Applicant.)	

MOTION TO SUSPEND PROCEEDING

Pursuant to the Trademark Trial and Appeal Board Manual of Procedure § 510 and 37 C.F.R. § 2.117, Applicant, Thomas Ice and Ice Legal P.A.¹. (“Applicant”), files this Motion to Suspend Proceeding in view of a pending civil action.

BACKGROUND

On December 11, 2015, Ice Legal, P.A. (“Ice Legal”) recorded its ownership of the LAWTENDER mark, U.S. Application No. 86/635,477. (*See* Exhibit A). On December 17, 2015, the United States Patent and Trademark Office entered a Notice of Recordation of Assignment Document. (*See* Exhibit B).

On April 28, 2016, Ice Legal filed a complaint in the United States District Court for the Southern District of Florida against Opposer, Brenna Terry (“Terry”) for trademark infringement, false designation, and unfair competition. In support of this Motion, Applicant submits a copy of the Complaint attached hereto as Exhibit C. Ice Legal is serving a copy of the complaint on Terry. Upon receipt of the Executed Return of Summons from the process server,

¹ Ice Legal, P.A. recorded its ownership of the trademark application at issue on December 11, 2015. Thomas Ice and Ice Legal, P.A. will be filing a separate motion to substitute Ice Legal P.A. as the applicant in this matter pursuant to TBMP § 512.01.

Ice Legal will promptly file it with the District Court.

LEGAL ARGUMENT

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 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.”). “A decision by the district court may be binding on the Board whereas a determination by the Board as to a defendant's right to obtain or retain a registration would not be binding or res judicata in respect to the proceeding pending before the court.” *New Orleans Louisiana Saints LLC & NFL Properties LLC*, 99 U.S.P.Q.2d 1550 (P.T.O. July 22, 2011). Therefore, if the civil litigation could have any bearing on the opposition, regardless of whether or not it would be conclusively determinative, suspension of the opposition proceeding is appropriate. *J & G Grant v. Brassat*, 91204048, 2013 WL 11247282, at *3 (T.T.A.B. Oct. 11, 2013); *see also Sturgis Motorcycle Rally, Inc. v. Farrokhi*, 91202020, 2013 WL 11247190, at *6 (T.T.A.B. Aug. 12, 2013)(“The Board's well-settled policy is to suspend proceedings when the parties are involved in a civil action or another Board proceeding which may be dispositive of or have a bearing on the Board case.”).

The pending civil action involves issues which are involved in this proceeding, namely whether Ice Legal has been harmed by Terry’s use of the LAWENDER mark. The civil action will also necessarily consider the ownership and priority of the LAWENDER mark. The determination of these issues by the District Court will likely be dispositive of and will certainly

have a bearing on the issues involved in this proceeding. *See Cmty. Trust Bancorp, Inc. v. Cmty. Trust Bank*, 91194948, 2012 WL 12517285, at *3 (T.T.A.B. Feb. 7, 2012). This proceeding is at its earliest stages. Only limited written discovery has been exchanged. No depositions have been noticed or taken, and no dispositive motions have been filed. To avoid duplication of effort and possible inconsistency of rulings, suspension of this proceeding is appropriate pending the outcome of the civil litigation. *Arcadia Grp. Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d 1134 (P.T.O. Jan. 6, 2011).

On May 4, 2016, Applicant conferred with counsel for Terry regarding the relief sought herein. Terry objected to a suspension of this opposition proceeding.

WHEREFORE, Applicant respectfully requests that the Trademark Trial and Appeal Board suspend this proceeding pending the determination of the civil action.

May 9, 2016

Respectfully submitted,

/s/ Woodrow H. Pollack
Woodrow H. Pollack
GRAYROBINSON, PA
Suite 2700
401 E. Jackson Street
Tampa, Florida 33602
(813) 273-5000
(813) 273-5145 facsimile
woodrow.pollack@gray-robinson.com
whpPTODocket@gray-robinson.com
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on May 9, 2016 a true and correct copy of the foregoing was filed electronically via Electronic System for Trademark Trials and Appeals and served by U.S. mail on Brenna Terry, 25 W. 132nd Street, #11B, New York, NY 10037.

/s/ Woodrow H. Pollack
Woodrow H. Pollack

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.