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

Proceeding	91227176
Party	Defendant Weber Luke Alliance
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Studio IC Inc., Opposer, v. Weber Luke Alliance LLC, Applicant.	APPLICANT’S MOTION TO SUSPEND OPPOSITION PROCEEDING PENDING OUTCOME OF PENDING CIVIL ACTION IN FEDERAL DISTRICT COURT Opposition No.: 91227176 Serial. No.: 86686620 Mark: ROLLERBALL International Class: 016 Filed : July 8, 2015
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MOTION TO SUSPEND

Applicant, Weber Luke Alliance, LLC (“Applicant”), by and through its counsel, submits this motion pursuant to Trademark Rule 2.117(a) and TBMP section 510.02(a) and asks the Board to suspend this proceeding pending the outcome of a trademark infringement action that Applicant has filed against Studio IC Inc. (“Opposer”) in the United States District Court for the District of Utah, Central Division.

The present opposition proceeding is but one aspect of an ongoing and much broader dispute between Opposer and Applicant regarding the “ROLLERBALL” trademark. The present proceeding simply addresses Applicant’s ability to register the trademark “ROLLERBALL.”

On May 10, 2016, Applicant here filed an action for trademark infringement, unfair competition and declaratory relief, among other causes of action, against Opposer in the United States District Court for Utah (the “District Court Action”). A true and correct copy of Applicant’s complaint and related pleadings in the District Court Action are submitted herewith

as Exhibit A. As discussed below, Applicant’s complaint in the District Court Action asserts claims that raise the same issues as the present proceeding, specifically the Fifth Cause of Action requests the District Court to rule on this present opposition. Moreover, as the Board is aware, the decision on such issues in the District Court Action will be binding in – indeed likely dispositive of – the present proceeding. Accordingly, Applicant respectfully submits that this proceeding should be suspended pursuant to Trademark Rule 2.117(a) and TBMP section 510.02(a) pending the outcome of the District Court Action.

Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), and TBMP section 510.02(a) both provide 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 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 explained in TBMP section 510.02(a): 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 is not binding upon the court.

The situation addressed in Trademark Rule 2.117(a) and TBMP section 510.02(a) is the exact situation presented here. Applicant’s complaint in the District Court Action also will provide the Board with a detailed discussion of the conduct and issues addressed by the District Court Action. Where, as here, the parties to an opposition proceeding also are involved in a district court action involving the same mark or the opposed application, the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a

bearing on the Board's decision in the opposition proceeding. [New Orleans Saints LLC and NFL Properties LLC v. Who Dat?, Inc., 99 USPQ2d 1550 (TTAB 2011).] This is so because a decision by the district court may be binding on the Board whereas a determination by the Board as to an applicant's right to obtain a registration would not be binding or have any res judicata or collateral estoppel effect in the district court action. [Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971).] It is critical to understand and remember that the 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 Saints LLC and NFL Properties LLC v. Who Dat?, Inc., 99 USPQ2d 1550 (TTAB 2011).] Consequently, as explained by Professor McCarthy, "[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues." [6 McCarthy on Trademarks and Unfair Competition, § 32:47 (4th Ed. 2011).]

Applicant respectfully submits that suspension of the present opposition proceeding pending completion of the District Court Action is warranted and appropriate under Trademark Rule 2.117(a) and TBMP section 510.02(a). Simply put, there cannot be any dispute that the issues described above, which are the issues in this proceeding, also are raised and will be decided in the District Court Action. There likewise cannot be any dispute that the determination of such issues in the District Court Action will be binding and have collateral estoppel and res judicata effect in this proceeding. Accordingly, in accordance with the authorities cited above, this proceeding should be suspended pending the outcome of the District Court Action.

Date: May 11, 2016

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