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

Proceeding	91232366
Party	Defendant Menudo International, LLC
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Submission	Motion to Suspend for Civil Action
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Signature	/Ralph H. Cathcart/
Date	05/01/2017
Attachments	Consented Motion to Suspend for Civil Action - Opposition IMP Holdings.pdf(1067543 bytes) Declaration of Ralph H. Cathcart - Opposition IMP Holdings.pdf(4233133 bytes)

denying the salient allegations in Opposer's Notice of Opposition and asserting several affirmative defenses. The parties have yet to take any discovery.

Opposer has also recently filed a Cancellation Action No. 92/065,725, seeking to cancel Menudo's subsisting MENUDO Registration No. 4,558,767, seemingly alleging abandonment and fraud in the prosecution. Menudo has yet to file its Answer and the parties have engaged in no discovery.

On April 26, 2017, Applicant filed the District Court Action alleging prior and exclusive ownership rights to MENUDO and trademark infringement by Opposer of Applicant's MENUDO trademarks, including MENUDO Registration No. 4,558,767 and unfair competition and related state claims.

ARGUMENT

It is well established that when a pending civil action between the Parties to a proceeding before the Board may be dispositive of the Board proceeding, the Board may suspend those proceedings until final disposition of the civil action. *See, i.e.,* 37 C.F.R. § 2.117(a); TBMP § 510.02(a). *See also, General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2D 1933, 1936 (TTAB 1992); *The Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 U.S.P.Q. 125, 127 (TTAB 1974); *Tokaido v. Honda Associates, Inc.*, 179 U.S.P.Q. 861, 862 (TTAB 1973); *Whopper Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971). In fact, "it is deemed to be the better policy to suspend proceedings [before the Board] until the civil suit has been finally concluded". *Tokaido* 179 U.S.P.Q. at 861,

There are numerous reasons for this well settled policy. Indeed, "while a decision by the district court would be binding upon the Patent Office, a decision by the Trademark Trial and Appeal Board might only be advisory in respect to the disposition of

the case pending in the District Court”. *Id.*; See also, *Whopper Burger*, 171 U.S.P.Q. at 807.

Further, a final judgment in the district court would necessarily obviate the need for further litigation before the Board. Thus, suspension of the instant proceeding would be in the interest of judicial economy and avoiding the possibility of duplicative litigation or conflicting judgments being issued by the Board or the district court.

Here, Opposer’s Notice of Opposition alleges, among other things, that Applicant’s MENUDO Application should be denied registration based on Opposer’s alleged prior common law rights in MENUDO.

In the District Court Action appended to the Cathcart Declaration as Exhibit A, Applicant alleges, *inter alia*, that it owns the exclusive rights to MENUDO, that such rights are prior to any common law rights Opposer claims to own and that Opposer is infringing Applicant’s rights in MENUDO.

Further, Applicant’s unfair competition and other state law claims plead in the District Court Action could not be raised in this Opposition Proceeding. As such, a final judgment in the District Court Action will require resolution of additional issues not presently before the Board. Conversely, a final judgment in the Opposition Proceeding would not eliminate the need for continued litigation in the District Court Action.

In light of the above, suspension of these proceedings is in the interest of the Parties and judicial economy, comports with the practice and precedent of this Board and will avoid inconsistent judicial determinations of the matters before the Board and the District Court.

Accordingly, Applicant respectfully requests suspension of all further proceedings in this Opposition proceeding until final disposition of the District Court Action.

Opposer's counsel, Johanna R. Hyman, Esq. has consented to this request.

Menudo is also simultaneously filing a consented motion for suspension of Cancellation No. 92/065,725 between the parties, which action has yet to be consolidated with this Opposition proceeding.

Respectfully submitted,
LADAS & PARRY LLP
Attorneys for Applicant

Dated: May 1, 2017

By: 

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