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

Proceeding	91239795
Party	Defendant Eymun Talasazan
Correspondence Address	KIRK EDWARD SCHENCK KULIK GOTTESMAN SIEGEL & WARE LLP 15303 VENTURA BOULEVARD 14TH FLOOR LOS ANGELES, CA 91403 UNITED STATES p@moradianlaw.com, kirkschenck@gmail.com 310-600-3800
Submission	Motion to Suspend for Civil Action
Filer's Name	Kirk Edward Schenck
Filer's email	kirkschenck@gmail.com
Signature	/Kirk Edward Schenck/
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Attachments	Starboy Talasazan Motion to Suspend Opp No. 91239795FinalFiled.pdf(465465 bytes)

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

XO TRADEMARKS, LLC

Opposer,

vs.

EYMUN TALASAZAN,

Applicant.

Opposition No: 91239795

Application No: 87383555

Mark: STARBOY

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APPLICANT/RESPONDENT EYMUN TALASAZAN'S MOTION TO
SUSPEND PROCEEDINGS PENDING DISPOSITION OF
DISTRICT COURT ACTION

TO:

Peter E. Nussbaum
Chiesa, Shahinian & Giantomasi, PC
One Boland Drive
West Orange, New Jersey 07052
Attys for Opposing Party

PLEASE TAKE NOTICE that Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Applicant/Respondent (“Respondent”) Eymun Talasazan, through its counsel, Kirk Edward Schenck, hereby submits the following motion and hereby does move to suspend the above-referenced proceedings (the “TTAB Proceedings”) pending final disposition of federal district court case Respondent filed on November 14, 2018 in the matter of *Eymun Talasazan vs. XO Trademarks, LLC, et al.* (CASE NO: 2:18-cv-09611) in federal district court for the Central District of California (the “District Court Action”).

Copies of the complaint and civil cover sheet in the District Court Action are attached as Exhibit 1.

The District Court Action complaint seeks a judgment that Petitioner XO Trademarks, LLC (“Petitioner”) is engaged in trademark infringement and false endorsement, in violation of Section 43(a) of the Lanham Act, based on its use of the trademark (Serial Number 87/649,533) that is at issue in this TTAB Proceeding.

When the parties are involved in civil court proceedings concerning the same marks and issues, the “standard procedure” of the Board is to suspend its administrative proceedings pending outcome of the civil litigation. *New Orleans*

Louisiana Saints LLC v. Who Dat? Inc., 99 USPQ2d 1550, 1552 (TTAB 2011) (quoting 6 McCarthy on Trademarks and Unfair Competition §32:47 (5th ed. updated September 2017)). The District Court Action need not even be dispositive of the Board proceeding to warrant suspension. Rather, it is sufficient that the District Court Action have bearing on the issues before the Board to justify a suspension. *Id.*

Here, the District Court Action involves the same parties, the same marks, and the same services and activities as those at issue in the TTAB Proceedings.

Respondent filed the District Court Action against the Petitioner in this TTAB Proceedings. Respondent contends he legitimately and exclusively owns and controls the trademarks upon which Petitioners' claims in the TTAB Proceedings are based and the marks Petitioner contends are infringing upon its rights in the District Court Action.

Respondent contends in the District Court Action that Petitioner, in violation of Respondent's rights, uses Respondent's trademark (Serial Number 87/649,533). This is the very mark that Petitioner is opposing in the TTAB Proceedings. Petitioner. The parties and marks in the TTAB Proceedings and the District Court Action are the same or sufficiently related, such that the District

Court Action will be dispositive of, or at least have a meaningful bearing upon, the issues before this Board.

In addition, the issues before this Board are also at issue in the District Court Action. Respondent's infringement claims involve the same issues the Board will be deciding in these TTAB Proceedings. But, the District Court Action will also involve other matters and broader issues, such as Petitioners' unauthorized use of other elements of Respondent's intellectual property without permission.

In the District Court Action, Respondent is seeking, among other remedies, damages and injunctive relief, which are not available to either party in the TTAB Proceedings. Because the parties, marks, and issues in the District Court Action are the same and because the outcome will be dispositive or at least impact the claims before the Board, suspension of the TTAB Proceedings pending the outcome of the District Court Action between the parties is warranted.

Moreover, judicial economy is served by immediately suspending all activity in the TTAB Proceedings including, without, all pending discovery and motions to compel discovery. See *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (1974). The parties are currently engaged in

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