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

Proceeding	91251046
Party	Plaintiff Scivation, Inc.
Correspondence Address	CRAIG M SPIERER HARRIS BEACH PLLC 333 EARLE OVINGTON BLVD SUITE 901 UNIONDALE, NY 11553 UNITED STATES Primary Email: cspierer@harrisbeach.com Secondary Email(s): ktangney@harrisbeach.com, hlink@harrisbeach.com, bpal-freyman@harrisbeach.com 516-880-8379
Submission	Motion to Suspend for Civil Action
Filer's Name	Craig M. Spierer
Filer's email	cspierer@harrisbeach.com, bpalfreyman@harrisbeach.com, ktang-ney@harrisbeach.com, hlink@harrisbeach.com
Signature	/Craig M. Spierer/
Date	09/24/2020
Attachments	Xtend5 - Motion to Suspend - FINAL.pdf(1106399 bytes)

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

In the matter of Trademark Application Serial No. 88/269,896
For the Mark: **XTEND5**
Published in the Official Gazette: on May 21, 2019

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SCIVATION, INC.	:	
	:	
Opposer,	:	Opposition No. 91251046
	:	
v.	:	
	:	
XTEND5 LLC	:	
	:	
Applicant,	:	
-----X	:	

**OPPOSER’S MOTION SUSPEND PROCEEDINGS PENDING
DISPOSITION OF DISTRICT COURT ACTION**

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Opposer Scivation, Inc. (“Opposer”) hereby moves the Board to suspend the above-referenced proceedings (the “Opposition”) pending final disposition of federal district court case No. 1:20-cv-00986, filed September 24, 2020, in federal district court for the Western District of Texas (the “Lawsuit”). Copies of the complaint and civil cover sheet are attached as Exhibit A.

The complaint seeks a judgment, *inter alia*, that Applicant Xtend5 LLC (“Applicant”) is engaged in trademark infringement, unfair competition, and trademark dilution in violation of the Lanham Act and common law based on Applicant’s use of the same trademark at issue in the Opposition, i.e., XTEND. When the parties are involved in 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. *See 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)). Put differently, “[u]nless 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.” TBMP 510.02(a). The civil action need not even be dispositive of the Board proceeding to warrant suspension. Rather, it is sufficient that the civil action have bearing on the issues before the Board to justify a suspension. *Id.* Here, the parties are the same (Scivation, Inc. and Xtend5, LLC), the marks are the same (Opposer’s XTEND family of marks and Applicant’s XTEND5 mark), and the goods are the same (Opposer’s dietary supplements and Applicant’s dietary supplements).

In addition, the issues before the Board are also at issue in the Lawsuit. Opposer’s trademark infringement, unfair competition, trademark dilution claims in the Lawsuit involve the same issues the Board will be deciding in the Opposition. But, the civil proceeding will also involve other matters and broader issues, such as Applicant’s unauthorized use in commerce of Opposer’s trademarks and a state law claim for injury to business reputation. In the Lawsuit, Opposer is seeking, among other remedies, damages, injunctive relief, and attorneys’ fees, none of which are not available in the Opposition. Because the parties, marks, goods, and issues in the Lawsuit are the same and because the outcome will be dispositive or at least impact the claims in the Opposition, suspension of the Opposition pending the outcome of the Lawsuit is warranted.

No motions, dispositive or otherwise, are pending before the Board.

Moreover, judicial economy is served by immediately suspending all activity in the Opposition. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (1974). While Opposer has a deadline to produce documents under the Board’s Order dated August 28, 2020 and Applicant has served a notice of deposition, the discovery period is not

scheduled to close until October 30, 2020. Opposer respectfully requests that the deadline to produce documents set in the Board's August 28, 2020 order be suspended as well, retroactively if necessary. Because the Lawsuit involves not only the issues currently before the Board, but also issues of unfair competition and injury to business reputation, discovery in the Lawsuit will involve documents, depositions, and other information that is not being and will not be gathered or produced in the Opposition. Thus, suspending the Opposition would avoid wasted time and expenses for both parties and the Board. *See, e.g., Softbelly's Inc v. Ty, Inc.*, 2002 WL 1844210, *3 (citing *Other Telephone*, 181 USPQ 126-27) ("It would be a waste of the Board's and the parties' time and resources to proceed to litigate this case at the Board when the same issues" are pending in court.)

Given the foregoing, an immediate suspension of the proceedings, including all outstanding and pending discovery, is warranted. Finally, the Board has reached this conclusion in similar circumstances. In *Other Telephone*, the Board stated that "it is clear" that a civil action alleging infringement and unfair competition would "directly affect the resolution" of a proceeding before it involving a likelihood of confusion claim, which is the very claim at issue in the Opposition. 181 USPQ 125, 126-27. In that proceeding, the Board granted the motion to suspend despite the fact that the moving party had only 8 days left in the its testimony period.

For these reasons, Opposer respectfully requests an order from the Board immediately suspending all activity related to the Opposition.

Date: September 24, 2020

By: /s/Craig M. Spierer
Craig M. Spierer, Esq.
Brendan M. Palfreyman, Esq.
HARRIS BEACH PLLC
333 Earle Ovington Blvd. Suite 901
Uniondale, NY 11553

Attorneys for Opposer Scivation, Inc.

CERTIFICATE OF MAILING

On September 24, 2020, I served a true and complete copy of the **OPPOSER'S MOTION SUSPEND PROCEEDINGS PENDING DISPOSITION OF DISTRICT COURT ACTION** on the persons listed below by electronic mail to:

blila@mandourlaw.com
jmandour@mandourlaw.com

Dated: September 24, 2020

By: /s/Kerri L. Tangney
Kerri L. Tangney

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