

ESTTA Tracking number: **ESTTA1060242**

Filing date: **06/05/2020**

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

Proceeding	9125551
Party	Defendant C F Burger Creamery
Correspondence Address	JULIE A GREENBERG FISHMAN STEWART PLLC 800 TOWER DRIVE SUITE 610 TROY, MI 48098 UNITED STATES tmdocketing@fishstewip.com, jgreenberg@fishstewip.com, mather- ton@fishstewip.com 248-594-0600
Submission	Motion to Suspend for Civil Action
Filer's Name	Julie A. Greenberg
Filer's email	jgreenberg@fishstewip.com, mstewart@fishstewip.com, Bman- dell@fishstewip.com, MAterton@fishstewip.com, mfeather@fishstewip.com
Signature	/Julie A. Greenberg/
Date	06/05/2020
Attachments	Motion to Suspend Vol 1.pdf(2216002 bytes) Motion to Suspend Vol 2.pdf(2795204 bytes) Motion to Suspend Vol 3.pdf(5125108 bytes)

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

DAVID FLORENCE)	
)	
Opposer,)	
)	Opposition No. 91255551
v.)	Application Serial No. 88550770
)	Mark: TWIN PINES FARM DAIRY
C. F. BURGER CREAMERY,)	
)	
Applicant.)	
<hr style="border: 0.5px solid black;"/>		

APPLICANT’S MOTION TO SUSPEND FOR CIVIL ACTION

Applicant, C.F. Burger Creamery, by and through its undersigned counsel, hereby moves pursuant to Trademark Rule of Practice 2.117(a) (37 C.F.R. § 2.117(a)) and TBMP § 510.02(a) that the Board suspend Opposition No. 91255551, pending final disposition of a recently-filed civil action between the same parties (*C.F. Burger Creamery v. David Florence*, Civil Action No. 2:20-cv-02936-EAS-EPD (U.S. Dist. Ct., S.D. Ohio)), as the civil action raises identical issues of fact and law as in the opposition. As grounds for this motion, Applicant states as follows:

BACKGROUND

On July 30, 2019, Applicant filed Application Serial No. 88550770 for the mark TWIN PINES FARM DAIRY, which currently recites: “*Dairy products, namely, cream, half and half, table cream, light cream, whipping cream, non-alcoholic egg nog*” in International Class 29. This application was published for opposition on December 31, 2019. On January 29, 2020, Opposer requested a 30-day extension of time to oppose, which was granted. Subsequently, Opposer requested a 60-day extension of time to oppose, which was likewise granted.

On April 29, 2020, Opposer filed a Notice of Opposition, wherein Opposer appears to assert allegations relating to likelihood of confusion and priority of trademark rights.¹

The instant Opposition appears to have been fueled by the recent development of Applicant charging Opposer with trademark infringement for commencing sales of dairy products under Applicant's TWIN PINES mark. Despite several written requests to cease plans to sell under the mark, Opposer has refused to comply, causing Applicant to file the attached federal complaint. See **Exhibit A** (hereafter, the "Complaint").

The lawsuit seeks an injunction and damages associated with Opposer's use of the mark TWIN PINES DAIRY in connection with dairy products. This motion seeks to suspend the instant Opposition while the federal lawsuit proceeds, under TBMP § 510.02(a).

ARGUMENT

It is standard procedure for the Board to suspend administrative proceedings such as this, pending the outcome of a civil action between the same parties involving related issues. *See e.g.*, 6 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:47 (4th ed. 2013) (citing *New Orleans La. Saints L.L.C. & NFL Prop. L.L.C. v. Who Dat, Inc.*, 99 U.S.P.Q.2d 1550 (TTAB 2011) (opposition proceedings suspended because in pending civil litigation applicant alleged infringement of the same mark by the parties who are opposers)).

The instant Opposition proceedings should be suspended pending the outcome of Applicant's civil action against Opposer as Opposer and Applicant are the only parties to the both proceedings, and the opposition has at its core the same issues of law as here.

Specifically, the Complaint recites a priority of rights and likelihood of confusion (i.e., trademark infringement). Opposer claimed the same ground – likelihood of confusion – in the

¹ The pleadings appear to claim priority in the TWIN PINES mark, although they are unintelligible.

instant proceeding. Inherent in each proceeding is an analysis of Applicant's priority of trademark rights over Opposer.

Therefore, the federal civil action will likely be dispositive of the issues in this Opposition proceeding, and will, at the least, have a bearing on the issues. Where the District Court's decision will be dispositive of the issues before the Board, a "motion to suspend proceedings is well taken." See *Gen. Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933 (TTAB 1992), *abrogation on other grounds recognized by Gaylord Entm't. Co. v. Calvin Gilmore Prods., Inc.*, 59 U.S.P.Q.2d 1369 (TTAB 2000).

While suspension of this proceeding is generally within the discretion of the Board, it is respectfully asserted that the pending federal court case merits suspension. TBMP § 510.02(a) (cases cited). Specifically, the TBMP states that: "Unless 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.*" See TBMP § 510.02(a) (emphasis added).²

In this case, the parties to this Opposition are identical to those of the federal court proceeding. The issues will likely be identical. In addition, suspension would avoid the undesirable result of the parties litigating the same issue in two forums, with potentially inconsistent results and would minimize waste of both the parties' and the Board's resources. For these reasons, Applicant requests that this matter be suspended pending the outcome of the federal court litigation.

² Referencing *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 35 U.S. 1293 (2015), 113 USPQ2d 2045, TBMP 510.02(a) points out that, although the Supreme Court in *B&B Hardware* held that issue preclusion can be based on a decision by the Board in a case in which the ordinary elements of issue preclusion are met, the Board's policy to suspend in favor of a civil action has not changed. As here, a civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration and, therefore, judicial economy is usually served by suspension.

WHEREFORE, Applicant respectfully requests that this Opposition proceeding be suspended until termination of the above-referenced civil action, including all appeals and remands.

Respectfully submitted,

Date: June 5, 2020

By: Julie A. Greenberg/
Julie A. Greenberg
Michael B. Stewart
Barbara L. Mandell
Melissa R. Atherton
Fishman Stewart PLLC
800 Tower Drive., Suite 610
Troy, MI 48098
(248) 594-0600
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing *Applicant's Motion to Suspend for Civil Action* upon Opposer by causing a true and correct copy thereof to be sent via e-mail to frauditors@aol.com.

Date: June 5, 2020

/Marilyn Feather/
Marilyn Feather

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.