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

Proceeding no.	91273569
Party	Defendant WRB, Inc.
Correspondence address	WRB, INC. 5865 NEAL AVE N / #113 STILLWATER, MN 55082 UNITED STATES Primary email: trademark@hammerschlagen.com 844-942-2548
Submission	Motion to Suspend for Civil Action
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Date	12/29/2021
Attachments	Motion to Suspend.pdf(88017 bytes) Exhibits.pdf(2908492 bytes)

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

In the matter of:

Application Serial No. **90453221**
For The Mark **Hammer-Schlagen**

DAMM, LLC,

Opposer,

v.

WRB, Inc.,

Applicant.

Opposition Number **91273569**

**Petitioner's Motion to Suspend
Proceedings Pending Disposition Of
Civil Action**

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Petitioner WRB, Inc. ("Petitioner") hereby moves the Board to suspend the above-referenced proceeding (this "TTAB Proceeding") pending final disposition of federal district court case *WRB, Inc. V. Damm, LLC, et al.*, No. 0:21-CV-01899-NEB-TNL (the "Federal Proceeding"), filed August 23, 2021, in federal district court for the District of Minnesota (Third Division, Saint Paul). True and correct copies of the Complaint, civil cover sheet, and Answer from this action are attached hereto as **Exhibit I**.

ARGUMENT AND CITATION TO AUTHORITY

The counterclaims made in the Answer of the Federal Proceeding seeks, *inter alia*, the same substantive relief sought in this TTAB Proceeding, namely, a judgment that Applicant's registration for the mark at issue (Application Serial No. 90453221) in this TTAB Proceeding be denied. Moreover, the Complaint and Answer both seek additional relief under the Lanham Act and other laws with respect to: Opposer's trademark and trade dress infringement, unfair competition, false designation of origin, violations of the Anticybersquatting Consumer Protection Act, and related federal and state law claims

based on the Hammer-Schlagen family of intellectual property owned by Applicant to which the trademark at issue in this TTAB Proceeding belongs; and Opposer's counterclaims alleging fraud and its desire for Applicant's trademark registrations to be canceled.

Given that the parties were involved in the Federal Proceeding concerning the same marks and issues involved prior to the commencement of this TTAB Proceeding, the "standard procedure" of the Board is to suspend its administrative proceeding pending outcome of the civil litigation. *New Orleans Louisiana Saints LLC et al. v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011) (quoting *6 McCarthy on Trademarks and Unfair Competition* § 32:47 (5th ed. updated September 2017)).

Generally, a civil action need not even be dispositive of a 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 Federal Proceeding would, in fact, be dispositive of the matter before the Board, and it involves the same parties and marks subject to this TTAB Proceeding, as well as the same nucleus of operative facts, as a plain reading of the Complaint and Answer demonstrates.

Moreover, the pending Federal Proceeding involves other parties and matters outside Board jurisdiction (including related issues of damages and injunctive relief) and involves the consideration of broader issues beyond right to registration of the mark for which application was made. Therefore, pursuant to TBMP § 510.02(a), judicial economy is served by the requested suspension. *Accord The Other Tel. Co. V. Connecticut Nat'l Tel. Co.*, 181 U.S.P.Q. (BNA) ¶ 125 (T.T.A.B. Feb. 11, 1974).

Additionally, the parties are currently engaged in discovery both in this TTAB Proceeding as well as in the Federal Proceeding, but minimal written discovery has taken place as the parties were previously attempting to settle their dispute with some documents having already been produced by both parties in the Federal Proceeding. No depositions

have occurred or been noticed in the Federal Proceeding. And, fact discovery in the Federal Proceeding is set to close on September 1, 2022. Because the Federal Proceeding involves not only the issues currently before the Board, but also issues of trademark and trade dress infringement, unfair competition, false designation of origin, violations of the Anticybersquatting Consumer Protection Act, and related federal and state law claims, discovery in the Federal Proceeding will involve documents, depositions, and other information that is not being and will not be gathered or produced in this TTAB Proceeding. Thus, suspending the TTAB Proceeding, including as to all outstanding written discovery requests and deadlines 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 (T.T.A.B. Aug. 13, 2002) (citing *The Other Tel.*, 181 U.S.P.Q. (BNA) ¶ 125) (“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 federal court.)

CONCLUSION

For these reasons, Petitioner submits that an order from the Board immediately suspending the TTAB Proceeding, including all outstanding answer, discovery requests, and scheduled deadlines, is warranted. Petitioner respectfully requests that its motion be duly granted.

Dated: December 29, 2021

Respectfully Submitted,

WRB, INC.

/s/ James Martin

By its CEO, James Martin

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Stillwater, MN 55082

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Applicant

CERTIFICATE OF SERVICE

I hereby certify that, on December 29, 2021, a copy of the foregoing motion was sent via e-mail to Opposer's counsel of record, as follows:

Paul Dietz
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/s/ James Martin
WRB, Inc.
By its CEO, James Martin

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