

ESTTA Tracking number: **ESTTA1301827**

Filing date: **08/04/2023**

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

Proceeding no.	91284592
Party	Defendant Sweet James, LLP
Correspondence address	WENDY C. LARSON PIRKEY BARBER PLLC 1801 EAST 6TH STREET SUITE 300 AUSTIN, TX 78702 UNITED STATES Primary email: tmcentral@pirkeybarber.com Secondary email(s): wlarson@pirkeybarber.com, akuhn@pirkeybarber.com, drausa@pirkeybarber.com 512-322-5200
Submission	Motion to Suspend for Civil Action
Filer's name	Brandon M. Ress
Filer's email	tmcentral@pirkeybarber.com, wlarson@pirkeybarber.com, akuhn@pirkeybarber.com, drausa@pirkeybarber.com, bress@pirkeybarber.com
Signature	/Brandon M. Ress/
Date	08/04/2023
Attachments	Applicants Motion to Suspend Pending Determination of a Related Civil Action.pdf(541671 bytes)

On August 4, 2023, Applicant filed a complaint initiating the California District Lawsuit. **Exhibit A** to this motion contains a copy of the as-filed complaint. In the litigation, Applicant alleges Opposer’s use of SWEET JUSTICE infringes Applicant’s prior rights in the marks SWEET JAMES, JUSTICE WITH SWEET JAMES, SWEET JUSTICE, and other SWEET-formative marks (the “SWEET Marks”) among other related claims. Applicant seeks a variety of remedies, including a determination by the Court that Opposer is not entitled to registration of the mark SWEET JUSTICE and order refusing registration of the mark SWEET JUSTICE by Opposer.

II. The Board should suspend this proceeding until final resolution of the California District Litigation.

The Board may suspend proceedings when “a party or parties to a case pending before it are involved in a civil action that may have a bearing on the Board case.” TBMP § 510.02(a); *accord* Trademark Rule 2.117(a) (allowing suspension whenever “a civil action . . . may have a bearing on a pending [Board] case”). “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.” TBMP 510.02(a). Because a civil action may consider broader issues beyond right to registration, “judicial economy is usually served by suspension.” *Id.* For that reason, the Board’s “policy [is] to suspend in favor of a civil action.” *Id.*; *see also New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (noting this Board policy and granting suspension).

Here, the California District Lawsuit involves the same parties and there is substantial overlap in the operative facts at issue in this proceeding, with very closely related legal claims as they relate to Applicant's prior rights in the SWEET Marks, and Opposer's infringement of Applicant's SWEET Marks through use of the mark SWEET JUSTICE, and Opposer's lack of entitlement to registration of the mark SWEET JUSTICE.

At the same time, the California District Lawsuit will also involve related issues *beyond* simply the right to registration that is the subject of this Opposition. *See* TBMP 510.02(a). Specifically, in the District Court action Applicant has asked the District Court to enjoin Opposer's use of the mark SWEET JUSTICE, award an accounting of profits and actual damages as a result of Opposer's use of the mark SWEET JUSTICE, among other remedies.

Because Applicant has raised issues in the litigation beyond just the right to registration, judicial economy is best served by suspension. *See* TBMP 510.02(a).

CONCLUSION

The California District Lawsuit is closely related to this proceeding and will be potentially dispositive of the claims and issues here. Thus, this proceeding should be suspended until final determination of the California District Lawsuit.

DATED: August 4, 2023

Respectfully submitted,

/Brandon M. Ress/

Wendy C. Larson

Brandon M. Ress

PIRKEY BARBER PLLC

1801 East 6th Street, Suite 300

Austin, TX 78702

(512) 322-5200

(512) 322-5201 (fax)

wlarson@pirkeybarber.com

Counsel for Applicant

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.