

ESTTA Tracking number: **ESTTA366190**

Filing date: **09/01/2010**

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

Proceeding	92045947
Party	Defendant Great Concepts, LLC
Correspondence Address	R. Milton Crouch Shapiro Fussell, LLP 1360 Peachtree St., Suite 1200 Atlanta, GA 30309 UNITED STATES mcrouch@shapirofussell.com, docketing@procopio.com, lmf@procopio.com, mlf@procopio.com, fkt@procopio.com
Submission	Other Motions/Papers
Filer's Name	Frederick K. Taylor
Filer's e-mail	docketing@procopio.com, fkt@procopio.com, tma@procopio.com,
Signature	/Frederick K. Taylor/
Date	09/01/2010
Attachments	Request_to_Remove_Stay_of_Proceedings.pdf (5 pages)(20406 bytes) Exhibit 1.pdf (34 pages)(1456182 bytes)

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

DAN TANA,)	
)	
Petitioner,)	Cancellation No. 92045947
)	
v.)	Registration No. 2929764
)	
GREAT CONCEPTS, LLC,)	Mark: Dantannas
)	
Registrant.)	
_____)	

GREAT CONCEPTS' REQUEST TO REMOVE SUSPENSION OF PROCEEDINGS

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir/Madam:

PLEASE TAKE NOTICE that Registrant Great Concepts, LLC (“Registrant”), hereby requests that the Suspension on the Cancellation Proceeding issued by this Board on February 4, 2010, be removed, and that new dates be set for Registrant’s Motion for Summary of Judgment as outlined below.

I. Introduction

Petitioner Dan Tana (“Petitioner”) initially filed this cancellation proceeding on June 6, 2006. Once Petitioner was faced with a motion for summary judgment from Registrant, in what this Board called an “apparent response to the motion for summary judgment,” Petitioner filed a copy of the complaint in the civil action, styled *Dan Tana v. Dantanna’s, Great Concepts, LLC, et al.*, Case No. CV 07-05532-ABC (JwJx), in the United States District Court for the Central District of California on August 23, 2007.

On September 12, 2007, a mere two weeks after Registrant filed its Motion for Summary Judgment in this proceeding, Petitioner filed his Motion to Stay the Cancellation Proceeding, pending the U.S. District Court's resolution of Petitioner's federal suit. Petitioner had filed its Motion to Stay without seeking the consent of Registrant. Petitioner even neglected to serve Registrant with a copy of his Motion to Stay. Registrant only had knowledge of the motion when the Board sent a notice of non-compliance to Petitioner a few days after the motion was filed. This Board eventually granted Petitioner's Motion to Stay on September 20, 2007.

Registrant then filed a Motion to Dismiss for Lack of Personal Jurisdiction in the U.S. District Court action on November 19, 2007. Petitioner opposed on December 3, 2007, and Registrant replied on December 10, 2007. On February 12, 2008, the U.S. District Court issued an order granting Registrant's Motion to Dismiss for Lack of Personal Jurisdiction with prejudice to refiling this action in California.

Petitioner then filed another lawsuit in federal district court. Petitioner filed an action styled *Dan Tana v. Dantanna's, Great Concepts, LLC, et al.*, Case No. CV 08-CV- 0975 TWT in the United States District Court for the Northern District of Georgia. The complaint in that action alleged claims of False Designation of Origin Under the Lanham Act § 43(a), 15 U.S.C. § 1125(a)), and related claims under Georgia statutes.

On February 26, 2009, after a full period of discovery, the same party which is the Registrant to this proceeding, Great Concepts, LLC, filed a motion for summary judgment. On September 15, 2009, the court granted Great Concepts' motion dismissing the action. On October 7, 2009, Petitioner filed a notice of appeal to the United States Court of Appeals for the Eleventh Circuit, Case No. 09-15123.

Both the Petitioner and Great Concepts fully briefed the issues raised on appeal. On July 15, 2010, the Court of Appeals issued an order, published opinion and judgment affirming the trial court's grant of the motion for summary judgment. A true and correct copy of that Court's Order, published opinion and Judgment are attached herein as Exhibit "1."

In granting affirming the district court's granting of summary judgment, the court stated, with regard to the likelihood of confusion:

Viewing the likelihood-of-confusion factors as a whole, there is minimal evidence of a likelihood of confusion between Plaintiff's and Defendants' restaurants aside from the initial similarity of their names and the fact that they both provide restaurant services. The remaining factors all weigh against a likelihood of confusion, some overwhelmingly so. There are stark differences between the two restaurants' cuisine and ambiance. There is virtually no evidence of confusion in advertising channels. No reasonable jury could find that Defendants intended to trade on Plaintiffs mark, and there is negligible evidence of any actual confusion between the two restaurants.

See, *Exhibit 1, Order and Opinion*, p. 29. Accordingly, despite the similarity in names, the Court ultimately upheld the dismissal of Petitioner's action.

II. Discussion

The Code of Federal Regulations which governs Motions to Suspend in TTAB actions states the following in pertinent part:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, *proceedings before the Board may be suspended until termination of the civil action* or the other Board proceeding.

37 CFR § 2.117(a) (emphasis added).

Given that the civil action before the U.S. District Court has now been terminated, and all matters before that Court are now disposed, Registrant hereby requests that this Board remove the suspension on proceedings. Registrant further requests that; new dates be set for Registrant's

Motion for Summary Judgment; that Petitioner's opposition to the same be due thirty days after the Order removing the Suspension of Cancellation Proceedings; and for Registrant's reply to said opposition be set seven days before the hearing on the summary judgment motion. Moreover, pursuant to this Board's suspension order of February 4, 2010, Registrant hereby notifies the Board of the disposition of District Court Case No. CV 07-05532-ABC (JwJx) and United States Court of Appeals Case No. 09-15123, and requests that this case may be called up for appropriate action.

III. Conclusion

Registrant respectfully requests that this Board remove the Suspension on the Cancellation Proceeding, and further, that this Board reset dates for the decision on Registrant's Motion for Summary Judgment, Petitioner's opposition, and Registrant's reply to the same.

Respectfully submitted,

Procopio Cory Hargreaves & Savitch LLP

Dated: September 1, 2010

By: /Frederick K. Taylor/
Fredrick K. Taylor
Lisel M. Ferguson
530 B Street, Suite 2100
San Diego, CA 92101
Telephone: (619) 515-3279
Facsimile: (619) 235-0398
Email: fkf@procopio.com

Milton Crouch
Shapiro Fussell, LLP
1360 Peachtree St., Suite 1200, Midtown Plaza
Atlanta, GA 30309

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.