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

Proceeding	92055728
Party	Defendant ANON ARTS LLC
Correspondence Address	ANON ARTS LLC 2145 DONALD DRIVE, APARTMENT 6 MORAGA, CA 945561451 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	Paul W. Kruse
Filer's e-mail	trademarks@bonelaw.com
Signature	/Paul W. Kruse/
Date	07/16/2012
Attachments	Motion to Suspend Action with Copy of Complaint (00776992).PDF (23 pages) (2044631 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DigiCel, Inc.,)
)
 Petitioner,)
) Cancellation No. 92055728
 v.)
) Reg. Nos. 3590670
 Anon Arts, LLC,)
)
 Registrant.)
)
 Attorney Ref. No. 003892-60802)

MOTION TO SUSPEND ACTION PENDING DISPOSITION OF CIVIL ACTION

Box TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

Anon Arts, LLC, requests that the Board suspend action on this cancellation proceeding pending the outcome of Civil Action No. 3:12-cv-00715.

As grounds for the motion, Registrant avers as follows:

2. The Board is empowered to determine only the right to register a mark. See Sections 17, 18, 20, and 24 of the Act of 1946, 15 U.S.C. §§ 1067, 1068, 1070, and 1092.

3. The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. See *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), aff'd, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution {00776989.1 })

laws); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (cannot adjudicate unfair competition issues); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition) aff'd (unpub'd), 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Section 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); and *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

3. In order to resolve the parties' differences once and for all, the right to use FLIPBOOK and/or similar variations thereof as well as questions of infringement and/or unfair competition must be decided. Consequently, Registrant initiated a civil action in the United

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States District Court for the Middle District of Tennessee. A copy of Registrant's complaint is submitted herewith.

4. The final determination of the civil action will have a bearing on the issues before the Board in this cancellation proceeding.

5. Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board. See 37 CFR § 2.117(a) and, for example, *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ 1933 (TTAB 1992) (relief sought in Federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Section 2(d) claim before Board), petition denied, 181 USPQ 779 (Comm'r 1974). See also *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971).

WHEREFORE, Registrant requests that action on this cancellation proceeding be suspended pending the outcome of Civil Action No. 3:12-cv-00715.

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Please direct all communications to the undersigned at (615) 238-6300 or trademarks@bonelaw.com.

Anon Arts, LLC



By: _____

Name: Paul W. Kruse

Title: Attorney

Date: July 12, 2012

Submitted by:

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