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

Proceeding	92064459
Party	Defendant TASER International, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	09/22/2016
Attachments	Motion to Stay Cancellation.pdf(2734300 bytes )

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

Phazzer Electronics, Inc.

Petitioner,

v.

Cancellation Action No.: 92064459  
Involving U.S. Registration No. 4,423,789

TASER International, Inc.,

Respondent.

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**RESPONDENT’S MOTION TO SUSPEND PROCEEDINGS PENDING THE  
OUTCOME OF FIRST-FILED FEDERAL COURT LITIGATION**

Respondent TASER International, Inc. (“TASER”), hereby moves the Trademark Trial and Appeal Board (“Board”) to suspend this cancellation proceeding pending the outcome of a civil action involving TASER and Petitioner Phazzer Electronics, Inc. (“Phazzer”) pending in the U.S. District Court for the Middle District of Florida, Orlando Division, Case No. 6:16-cv-00366-PGB-KRS. (A true and correct copy of the Complaint is attached hereto as Exhibit A). Specifically, the civil action was filed six months ago by TASER against the Petitioner and another defendant, and the claims unquestionably bear on the issues presented to the Board in the Petition, and would likely resolve them in their entirety. TASER, the Plaintiff in the civil action, alleges claims of infringement of the trademark at issue in this cancellation action, along with claims of patent infringement, false advertising and unfair competition against Petitioner and one other defendant.

It is the policy of the Board to suspend cancellation proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board’s proceedings. TBMP §510.02, citing 37 C.F.R. § 2.117(a); *see also New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011)(civil action

need not be dispositive of Board proceeding, but only needs to have bearing on issues before the Board); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975); *Tokaido v. Honda Associates, Inc.*, 179 USPQ 861 (TTAB 1973). This policy makes perfect sense. When a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the status of the Registration – even if it were cancelled – does not preclude TASER from asserting its trade dress infringement claims under common law. *See* TBMP § 510.02(a); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848 (2d Cir. 1988) (PTO registration would not affect the legal standard applied in infringement claim or the scope of the required fact-finding; the district court will still independently have to determine the validity of the mark). While the Supreme Court recently found that TTAB decisions can be binding on a federal court (*B&B Hardware Inc. v. Hargis Industries*, 135 S.Ct. 1293, 1310 (2015)), under no circumstances could this Board’s decision resolve all issues in the pending federal litigation, which encompass patent claims and common law rights not involved in this proceeding. As such, there is no reason for the parties or the Board to spend time and resources on this dispute when the resolution at the Board will not resolve the first-filed federal litigation between the same parties.

In the pending litigation, the district court and the jury will be charged with determining issues relating to U.S. Registration No. 4,423,789, including any defenses that may be asserted<sup>1</sup>; therefore the outcome of the civil action will directly impact and likely resolve all issues involved in this opposition proceeding. In particular, two of the purported grounds for cancellation set forth in the petition – functionality and lack of secondary meaning – are

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<sup>1</sup> Currently pending is a motion to dismiss by the Petitioner, which has delayed Petitioner’s requirement to answer the complaint or articulate its affirmative defenses.

elements that or defenses will be litigated in the infringement litigation. *See Epic Metals v. Souliere*, 99 F.3d 1034, 1038 (11th Cir. 1996). The third purported ground for cancellation, fraud, is a theory that is fatally flawed and insufficient, but Petitioner is nonetheless able to allege in the civil action. Alternatively, the issues of patent infringement, false advertising and trademark infringement based on common law rights will also be resolved at the federal court level, while none of these issues would be impacted by this cancellation action.

Equitable considerations also favor suspension of the opposition proceeding because conducting two trials involving the same parties and the same issues will undoubtedly result in duplication of effort and expense. There is also the potential that simultaneous proceedings on these issues could result in inconsistent results. Accordingly, TASER respectfully requests that the Board suspend these cancellation proceedings until final disposition of the civil action noted above.

Respectfully submitted this September 22, 2016.

/s/Ryan T. Santurri

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing (Motion to Stay) has been served by mailing said copy on September 22, 2016, via First Class Mail, postage prepaid to:

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Date: September 22, 2016

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