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

Proceeding	92065725
Party	Defendant Menudo International LLC
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Submission	Motion to Suspend for Civil Action
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Date	05/01/2017
Attachments	Consented Motion to Suspend for Civil Action - Cancellation IMP Holdings.pdf(1047043 bytes) Declaration of Ralph H. Cathcart - Cancellation IMP Holdings.pdf(4275453 bytes)

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

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IMP HOLDINGS LLC, :
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 Petitioner, : Cancellation No. 92/065,725
 : Registration No. 4,558,767
 v. :
 :
 MENUDO INTERNATIONAL, LLC, :
 :
 :
 Respondent. :
 :
 :
-----X

RESPONDENT’S CONSENTED MOTION TO SUSPEND FOR CIVIL ACTION

Pursuant to 37 C.F.R. § 2.117, Respondent, Menudo International, LLC (“Menudo”), respectfully requests that the Trademark Trial and Appeal Board (“Board”) suspend this Cancellation proceeding pending the final disposition of a trademark infringement action between the Parties filed by Menudo and titled Menudo International, LLC v. In Miami Production, LLC – Civil Action No. 1:17-cv-21559 (KMW) in the United States District Court for the Southern District of Florida (“District Court Action”).

BACKGROUND

On March 28, 2017, Petitioner filed a Petition to Cancel Respondent’s MENUDO Registration No. 4,558,767. The Board assigned proceeding no. 92/065,725 (“Cancellation Proceeding”).

In Petitioner’s Petition to Cancel, Petitioner seeks to cancel Respondent’s MENUDO Registration No. 4,558,767, seemingly based on fraud in the prosecution and abandonment.

Petitioner has also opposed Menudo’s pending MENUDO Application No.

87/056,545 in Opposition No. 91/232,366. That Opposition action is in its infancy, Menudo recently filed an Answer (Dkt. 5) denying the salient allegations and interposed several affirmative defenses, noting its exclusive rights and Petitioner's unauthorized use of MENUDO. No discovery has been taken by either side.

On April 26, 2017, Menudo filed the District Court Action alleging exclusive and prior ownership of MENUDO, trademark infringement by Petitioner of Respondent's MENUDO trademarks, including MENUDO Registration No. 4,558,767, unfair competition and related state claims against Petitioner.

ARGUMENT

It is well established that when a pending civil action between the Parties to a proceeding before the Board may be dispositive of the Board proceeding, the Board may suspend those proceedings until final disposition of the civil action. *See, i.e.*, 37 C.F.R. § 2.117(a); TBMP § 510.02(a). *See also, General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2D 1933, 1936 (TTAB 1992); *The Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 U.S.P.Q. 125, 127 (TTAB 1974); *Tokaido v. Honda Associates, Inc.*, 179 U.S.P.Q. 861, 862 (TTAB 1973); *Whopper Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971). In fact, "it is deemed to be the better policy to suspend proceedings [before the Board] until the civil suit has been finally concluded". *Tokaido* 179 U.S.P.Q. at 861,

There are numerous reasons for this well settled policy. Indeed, "while a decision by the district court would be binding upon the Patent Office, a decision by the Trademark Trial and Appeal Board might only be advisory in respect to the disposition of the case pending in the District Court". *Id.*; *See also, Whopper Burger*, 171 U.S.P.Q. at 807.

Further, a final judgment in the district court would necessarily obviate the need for further litigation before the Board. Thus, suspension of the instant proceeding would be in the interest of judicial economy and avoiding the possibility of duplicative litigation or conflicting judgments being issued by the Board or the district court.

Here, Petitioner's Petition to Cancel alleges, among other things, that Respondent's MENU DO Registration should be cancelled based on abandonment and fraud in the prosecution.

In the District Court Action appended to the Cathcart Dec'l. as Exhibit A, Respondent alleges, *inter alia*, it owns the exclusive rights to MENU DO, that such rights are prior to any common law rights Petitioner claims to own and that Petitioner is infringing Respondent's MENU DO Registration No. 4,558,767.

Further, Respondent's unfair competition and other state law claims plead in the District Court Action could not be raised in this Cancellation Proceeding. As such, a final judgment in the District Court Action will require resolution of additional issues not presently before the Board. Conversely, a final judgment in the Cancellation Proceeding would not eliminate the need for continued litigation in the District Court Action.

In light of the above, suspension of these proceedings is in the interest of the Parties and judicial economy, comports with the practice and precedent of this Board and will avoid inconsistent judicial determinations of the matters before the Board and the District Court.

Accordingly, Menudo respectfully requests suspension of all further proceedings in this Cancellation proceeding until final disposition of the District Court Action. Petitioner's counsel, Johanna R. Hyman, Esq., has consented to this request.

Menudo is also simultaneously filing a consented motion to suspend the Opposition proceeding between the parties (Opposition No. 91/232, 366) which has not been consolidated yet with this Cancellation Action.

Respectfully submitted,
LADAS & PARRY LLP
Attorneys for Applicant

Dated: May 1, 2017

By: 

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