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

Proceeding	92076850
Party	Defendant ZA CORP.
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Submission	Motion to Suspend for Civil Action
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Attachments	Motion for Suspension of Cancellation Proceedings.pdf(2696302 bytes)

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

In the Matter of Trademark Registration No. 6,175,436

Mark: PIZZAZZ

MVGMM, INC.,)	
)	
Petitioner,)	
)	
-vs-)	CANCELLATION PROCEEDING
)	NO. 92076850
ZA CORPORATION,)	
)	
Respondent.)	
)	

RESPONDENT’S MOTION FOR SUSPENSION OF ALL PROCEEDINGS
PENDING DISPOSITION OF RELATED CIVIL ACTION

Respondent Za Corporation (“Za”), through its undersigned counsel, states as follows for its Motion for Suspension of All Proceedings Pending Disposition of a Related Civil Action.

I. INTRODUCTION

This matter concerns Proceeding No. 92076850 filed by Petitioner MVGMM, Inc. (“MVGMM”) seeking cancellation of Za’s federal registration of its mark PIZZAZZ (U.S. Registration No. 6,175,436, issued on October 13, 2020).

On January 25, 2021, Za, *et al.*, initiated a civil action against MVGMM, *et al.*, in the District Court for the Northern District of Ohio, Case No. 1:21-cv-00204 (the “District Court Action”), which action remains pending. A true and accurate copy of the Complaint filed in the District Court Action is attached as Exhibit 1.

In the District Court Action, Za has alleged, among other things, that it owns

enforceable rights in the PIZZAZZ mark, that such rights are evidenced by U.S. Registration No. 6,175,436, on the principal register, and that MVGMM has infringed and otherwise violated Respondent Za's rights.

The District Court Action thus will have a direct impact on these cancellation proceedings. In accordance with well-established principles, including those codified in 37 C.F.R. § 2.117(a) and set forth in Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Za respectfully requests that the Board suspend these cancellation proceedings pending a final determination of the District Court Action.

II. FACTS AND PROCEDURAL HISTORY

In the District Court Action Complaint (the "Complaint"), Za alleges, among other things, that it owns rights in the PIZZAZZ mark that are superior to MVGMM's claimed rights in the PIZZAZZ mark, that MVGMM's use of the PIZZAZZ mark is confusingly similar to Za's PIZZAZZ mark, and that MVGMM has infringed Respondent Za's rights. (*See* Complaint.)

III. ARGUMENT

When parties to a Board proceeding are involved in a civil action that may be dispositive of the issues before the Board, the Board generally will suspend its proceedings pending the final determination of the civil action. *See* 37 C.F.R. § 2.117(a). This rule is set forth in TBMP 510.02(a), which states: "[w]henver it comes to the attention of the Board that 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, proceedings before the Board may be suspended until final determination of the civil action." TBMP § 510.02(a); *see also Farah v. Topiclear Beauty Prods.*, 2003 TTAB LEXIS 405, at *17 (Trademark Trial & App. Bd. August 21, 2003) (suspension granted because it "would avoid the undesirable

result of the parties litigating the same issue in two forums, with potentially inconsistent results and would minimize waste of both the parties' and the Board's resources"); *GMC v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2D (BNA) 1933, 1992 TTAB LEXIS 7 (Trademark Trial & App. Bd. March 26, 1992) (granting a motion for suspension where "[a] decision by the district court [would] be dispositive of the issues before the Board"); *Tokaido v. Honda Assocs.*, 1973 TTAB LEXIS 169, 179 U.S.P.Q. (BNA) 861 (Trademark Trial & App. Bd. November 14, 1973) (suspending proceeding "pending final determination of the civil suit in which the parties are now involved").

The question before the Board, therefore, is whether the District Court Action will have a "bearing" on the cancellation proceedings. *See* TBMP § 510.02(a); *Jafar Abukhalil, Inc. v. Roor Int'l BV*, 2018 TTAB LEXIS 522, at *2 (Trademark Trial & App. Bd. November 5, 2018). "It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation . . . involving related issues." *Oneida Indian Nation v. United States DOI*, 336 F. Supp. 3d 37, 45 (N.D.N.Y. 2018) (*citing New Orleans Louisiana Saints LLC & NFL Properties LLC*, 99 U.S.P.Q.2d 1550 (T.T.A.B. July 22, 2011) (quoting 6 McCarthy on Trademarks and Unfair Competition §32:47 (4th ed. updated June 2011))). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1953-55 (2d Cir. 1988).

Here, the Complaint in the District Court Action raises issues that are identical to those at issue in the cancellation proceedings before the Board. The cancellation

proceedings therefore should be suspended pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a).

As discussed above, Za has alleged in the District Court Action that it owns enforceable rights in the PIZZAZZ mark and that MVGMM's use of the PIZZAZZ mark is confusingly similar to Za's PIZZAZZ mark, and that MVGMM has infringed Respondent Za's rights. Za's District Court Action also seeks to enjoin MVGMM's use of the PIZZAZZ mark. These matters, as raised in Za's Complaint against MVGMM, are central to the District Court Action. Any final determination by the District Court of the likelihood of confusion between the parties' marks and the priority of rights would resolve the questions before the Board in the cancellation proceedings at issue here. For these reasons, the District Court Action not only will have a "bearing" on the issues before the Board, but also likely will be dispositive. *See GMC*, 1992 TTAB LEXIS 7 (granting a motion for suspension where "[a] decision by the district court [would] be dispositive of the issues before the Board").

Accordingly, Za respectfully submits that the Board should grant its Motion for Suspension of All Proceedings Pending Disposition of Related Civil Action and stay all proceedings in this matter pending resolution of the District Court Action.

IV. CONCLUSION

For the foregoing reasons, Za respectfully requests that the Board stay Proceeding No. 92076850 seeking cancellation of Za's registration of the PIZZAZZ mark pending a final resolution of the District Court Action.

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