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

Proceeding	92076859
Party	Defendant CasperLabs, LLC
Correspondence Address	CASPERLABS, LLC 1908 THOMES AVENUE CHEYENNE, WY 82001 UNITED STATES Primary Email: varun@adaptive.holdings No phone number provided.
Submission	Motion to Suspend for Civil Action
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VLAD ZAMFIR	Cancellation No. 92076859
Petitioner,	In re: Reg. No. 6,131,157
v.	Mark: CASPERLABS
CASPERLABS, LLC	Issued: August 18, 2020
Registrant.	

REGISTRANT’S MOTION TO SUSPEND PROCEEDING PENDING DISPOSITION OF
DISTRICT COURT ACTION

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Registrant CasperLabs, LLC (“Registrant”) hereby requests the Board to suspend the above-referenced proceeding (the “Cancellation Proceeding”) pending final disposition of the civil action in the United States District Court of the Southern District of California, namely, *Vlad Zamfir v. CasperLabs, LLC*, Case No. 21cv474-TWR(AHG), filed on March 17, 2021 (“Civil Action”). A copy of the complaint (“Complaint”) and the civil cover sheet are attached as Exhibit 1.

Registrant is the owner of the federal registration for the CASPERLABS mark in Registration No. 6,131,157 (“Registration”), which registered on the Principal Register on August 18, 2020. A copy of the registration certificate is attached as Exhibit 2. On April 9, 2021, Petitioner Vlad Zamfir (“Petitioner”) filed a Petition to Cancel. Registrant’s Answer to Petitioner’s Petition to Cancel is due on May 19, 2021.

In his Complaint, Petitioner claims that Registrant’s use of the mark including the word “Casper” that is the subject of the Registration is false designation of origin in violation of Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), and constitutes unfair competition

under California law. Complaint ¶¶ 62, 69. In particular, Petitioner alleges in the Complaint of the Civil Action that Registrant’s use in commerce of the mark including the word “Casper” is likely to deceive consumers as to the origin, source, sponsorship, or affiliation of Registrant’s Proof-of-Stake (PoS) blockchain network, and is likely to cause consumers to believe that Registrant’s PoS blockchain network is sold, authorized, endorsed, or sponsored by Petitioner, or that Registrant is affiliated with or sponsored by Petitioner. *Id.* ¶ 61.

The Complaint seeks damages and an injunction prohibiting Registrant from using the mark and other marks including the word “Casper.” Petitioner also filed a motion for a temporary restraining order and preliminary injunction, which the Court denied. The Court’s Order Denying Plaintiff’s Motion for Temporary Restraining Order and Preliminary Injunction is attached as Exhibit 3. The response to the Complaint is currently due on May 10, 2021.

The outcome of the Civil Action may have a bearing on or may be dispositive of this Cancellation Proceeding. “It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have bearing on the Board case... Judicial economy lies in the suspension of Board proceedings because, *inter alia*, the Board has limited jurisdiction involving the issue of registrability only; the Board’s decision is advisory to the Court, while a U.S. District Court decision is binding on the parties before this administration Board.” *Black Box Corp. of Pa. & BB Techs., Inc. v. Better Box Communs. Ltd.*, 2002 TTAB LEXIS 253 (TTAB 2002).

Generally, when the parties are involved in court proceedings concerning the same marks and potentially similar issues, the “standard procedure” of the Board is to suspend its administrative proceedings pending the outcome of the civil litigation. *See New Orleans Louisiana Saints LLC v. Who dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (*quoting 6 McCarthy on*

Trademarks and Unfair Competition § 32:47 (5th ed. Updated September 2017)). The civil action need not even be dispositive of the Board proceeding to warrant suspension. Rather, it is sufficient that the civil action has bearing on the issues before the Board to justify a suspension. *Id.*

Here, the Civil Action is inclusive of the same parties, the same or sufficiently related mark, and the same related goods and services at issue in the Cancellation Proceeding. Petitioner filed the Civil Action against Registrant. Registrant owns the trademark registration for the CASPERLABS mark, which is the very mark that Petitioner is seeking to cancel in this Cancellation Proceeding. Additionally, the CASPERLABS mark is sufficiently related to and contains the word “Casper” in its entirety which Petitioner contends is infringing upon its rights in the Civil Action.

Accordingly, the parties and the mark in the Cancellation Proceeding and the Civil Action are the same or sufficiently related, such that the Civil Action may be dispositive of, or at least may have a meaningful bearing upon, the issues before the Board. In addition, the issues before the Board may also be at issue in the Civil Action. Petitioner’s false designation of origin claims involve issues similar to or possibly bearing on those the Board will be deciding in the Cancellation Proceeding.

Because the parties are the same in and the marks and issues in the Civil Action may be similar and because the outcome may be dispositive or may at least impact the claims before the Board, suspension of the Cancellation Proceeding pending the outcome of the Civil Action between the parties is warranted.

For these reasons, Registrant submits that an order from the Board immediately suspending all activity related to the Cancellation Proceeding is warranted. The same is respectfully requested.

Respectfully submitted,

Date: April 15, 2021

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