

ESTTA Tracking number: **ESTTA1312719**
Filing date: **09/28/2023**

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

Proceeding no.	92083281
Party	Defendant Skydiving School, Inc.
Correspondence address	SKYDIVING SCHOOL, INC. PO BOX 75520 HONOLULU, HI 96836 UNITED STATES Primary email: frank@skydivehawaii.com 808 637-5498
Submission	Motion to Suspend for Civil Action
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Date	09/28/2023
Attachments	Can 2083281 Motion to Suspend for Civil Action 27Sept2023.pdf(87201 bytes) Exh. A CV 23-00292 DKW-WRP (D.Haw. 2023) DKT 1 Trademark Infrgmt file d 2023-07-13 SKYDIVE HAWAII v. GOJUMP Complaint .PDF(1717024 bytes)

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SKYDIVING SCHOOL, INC.,
dba SKYDIVE HAWAII

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

GOJUMP HAWAII LLC, a Hawai'i
limited liability company

Petitioner

vs.

SKYDIVING SCHOOL, INC. dba
SKYDIVE HAWAII, a Hawai'i
corporation,

Respondent/Registrant

Cancellation No. 92083281

**RESPONDENT/REGISTRANT'S
MOTION TO SUSPEND FOR
CIVIL ACTION; EXHIBIT A;
CERTIFICATE OF SERVICE**

Mark: SKYDIVE HAWAII

Reg. Nos.: 4182071 (word)

4194803 (word)

4246149 (design)

5627055 (design)

RESPONDENT/REGISTRANT'S
MOTION TO SUSPEND FOR CIVIL ACTION

COMES NOW, RESPONDENT/REGISTRANT SKYDIVING SCHOOL,

INC. dba SKYDIVE HAWAII (“Registrant”), by and through its attorney, DARBY IP & LAW CORPORATION, who respectfully moves the Trademark Trial and Appeal Board (“Board”) to suspend the proceedings in Cancellation Proceeding 92083281 (“the Proceeding”) pending the resolution of the civil action captioned Civil No. CV 23-00292 DKW-WRP (Trademark Infringement) (“Civil Action”), filed on July 13, 2023, in the U.S. District Court – District of Hawaii. Registrant is the plaintiff, and Petitioner is a defendant, in the Civil Action. A true and complete copy of the Complaint in the Civil Action (DKT 1) is submitted herewith as Exhibit A (“Complaint”).

This Motion is brought pursuant to TBMP Rule 510.2(a) and 37 CFR § 2.117(a), and is supported by good cause, namely the District Court’s determinations in the Civil Action of Petitioner’s assertions of genericness of the Marks and of Registrant’s representations under 15 USC § 1052(2)(f) have a bearing on the issues before the Board.

I. FACTS

Paragraphs 5 to 97 of the Complaint provide the factual background of the Civil Action. Infringement of Reg. Nos. 4182071 (word), 4194803 (word), 4246149 (design), and 5627055 (design) (collectively, “the Marks”) by Petitioner and other defendants is alleged in the Complaint.

¶¶ 98 to 109 of the Complaint comprise a count for trademark infringement

under 15 USC § 1125 and remedies under 15 USC §§ 1114, 1116, and 1117.

¶¶ 98 to 113 of the Complaint comprise a count for unfair competition under 15 USC § 1125 and remedies under 15 USC §§ 1116 and 1117.

¶¶ 114 to 122 of the Complaint comprise counts under Hawaii law for breach of settlement agreement and for intentional interference with contractual relations.

II. PROCEDURAL CONSIDERATIONS

In ¶¶ 16 and higher of Petitioner’s Consolidated Petition for Cancellation (“Petition”), Petitioner alleges as bases for cancellation of the Marks: genericness of the Marks (Count I), fraud in Registrant’s claiming the benefit of “Lanham Act 2(f)” (Count II), and non-use of the Marks (Count III).

Petitioner’s bases for moving to dismiss the entire Complaint (DKT 42 in the Complaint) are identical to Counts I and II of the Petition, and presumably will be among Petitioner’s defenses in the ongoing Civil Action. A hearing on Registrant’s Motion for Preliminary Injunction against Petitioner and other defendants, and on Petitioner’s (and other defendants’) Motions to Dismiss, is currently scheduled for October 12, 2023, before Chief Judge Derrick K. Watson in U.S. District Court (District of Hawai‘i). Registrant will promptly file in the Proceeding a status update that relays the District Court’s decisions on those Motions.

Counts III and IV of the Complaint are state law matters outside the jurisdiction of the Board. “A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond the right to registration and, therefore, judicial economy is usually served by suspension. * * * Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” TBMP Rule 510.2(a)

The District Court’s determinations of Petitioner’s assertions of genericness of the Marks and of Registrant’s representations under 15 USC § 1052(2)(f) have a bearing on the issues before the Board. Therefore, Registrant respectfully moves the Board to suspend the Proceeding pending the resolution of the Civil Action.

DATED: Honolulu, Hawai‘i, September 27, 2023

/ George E. Darby /
GEORGE E. DARBY
Attorney for Respondent/Registrant
SKYDIVING SCHOOL, INC.,
dba SKY DIVE HAWAII

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