

ESTTA Tracking number: **ESTTA467551**Filing date: **04/17/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204105
Party	Defendant Jones, Brenda F.
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Submission	Motion to Suspend for Civil Action
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Date	04/17/2012
Attachments	20120417 Motion to suspend opposition (FUQU.007).pdf ( 6 pages )(26140 bytes ) Exhibit A - Docket Report for 1_11-cv-09274.pdf ( 4 pages )(38318 bytes ) B-1.pdf ( 15 pages )(2436137 bytes ) B-2.pdf ( 2 pages )(336932 bytes ) B-3.pdf ( 2 pages )(197374 bytes ) B-4.pdf ( 2 pages )(196557 bytes ) B-5.pdf ( 2 pages )(23727 bytes ) B-6.pdf ( 3 pages )(25734 bytes ) B-7.pdf ( 2 pages )(26115 bytes ) B-8.pdf ( 2 pages )(20069 bytes ) B-9.pdf ( 2 pages )(268383 bytes ) B-10.pdf ( 2 pages )(19749 bytes ) B-11.pdf ( 2 pages )(58844 bytes ) B-12.pdf ( 2 pages )(27873 bytes ) B-13.pdf ( 16 pages )(74284 bytes ) B-14.pdf ( 2 pages )(58600 bytes ) B-15.pdf ( 2 pages )(20149 bytes ) B-16.pdf ( 15 pages )(430506 bytes ) B-17a.pdf ( 23 pages )(239961 bytes ) B-17b.pdf ( 25 pages )(904852 bytes ) B-17b2.pdf ( 30 pages )(953784 bytes ) B-17c.pdf ( 15 pages )(813766 bytes ) B-17c2.pdf ( 8 pages )(433544 bytes ) B-17d.pdf ( 10 pages )(539682 bytes ) B-17d2.pdf ( 18 pages )(1188266 bytes ) B-18.pdf ( 3 pages )(28974 bytes )

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

In the Matter of Application No.: 85/389,280  
For the Mark: SWERVE ON  
Date filed: August 4, 2011

**SWERVE IP LLC,**

**Opposer,**

**V.**

**JONES, BRENDA F.**

**Applicant.**

**Opposition No. 91204105**

**APPLICANT'S MOTION TO SUSPEND OPPOSITION PROCEEDING**

**PRELIMINARY STATEMENT**

Applicant Brenda F. Jones submits this motion to suspend the opposition proceedings herein pursuant to 37 C.F.R. § 2.117(a) and TBMP 510.02(a) in light of a civil action pending before the U.S. District Court for the Northern District Of Illinois, Eastern Division. See Applicant's Exhibit A.

"Whenever 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 which 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). Here, the Opposer in the pending opposition is involved in a civil action that may have a bearing on the Board case. "Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board." TBMP 510.02(a). Here, the outcome of Opposer's civil litigation will have a direct bearing upon the outcome of this opposition proceeding. Both proceedings involve the same registration and similar issues.

## **STATEMENT OF FACTS**

1. On August 4, 2011, Applicant filed a US trademark application (serial no. 85/389,280) for the SWERVE ON mark in International Class 032 for “energy drinks.”
2. On November 29, 2011, the application was approved for publication.
3. On January 3, 2012, the mark was published in the Trademark Official Gazette.
4. On February 29, 2012, Opposer filed a Notice of Opposition citing their US registration for the SWERVE mark (US Reg. No. 3679639) in International Class 030 for “natural sweetener” as the basis for opposition.
5. Previously on March 9, 2011, Opposer filed a Notice of Opposition (Opposition No. 91198921) citing the same registration as the basis for opposition of application serial number 85/153,870, filed by Wm. Wrigley Jr. Company, for the SWERVE mark in International Class 030 for “chewing gum.”
6. On December 29, 2011, the Wm. Wrigley Jr. Company filed a civil action No. 11-cv-09274 in the United States District Court For The Northern District Of Illinois Eastern Division seeking a declaratory judgment that its use of SWERVE as mark for a sour tropical flavor indicator for its 5 brand of chewing gum does not infringe any trademark rights of Opposer including U.S. Trademark Registration No. 3,679,639 for SWERVE in class 30 for natural sweetener, or otherwise subject the Wm. Wrigley Jr. Company to liability under state and/common law unfair competition laws, including the laws of the State of Illinois. See Applicant's Exhibit A for the Docket Report, and Applicant's Exhibits B1-B18 for each individual docket entry.
7. On March 2, 2012, Opposer filed an Answer with Counterclaims in the Illinois litigation, Exhibit B13, alleging trademark infringement under the Lanham Act (15 U.S.C. §§ 1114 and 1125); unfair competition under Illinois common law; and Unfair Competition under the Illinois Consumer Fraud and Deceptive Businesses Act (815 ILCS 505, *et seq.*).

8. On March 28, 2012, Opposer filed a Motion for a Preliminary Injunction in the Illinois litigation, Exhibit B17.

### **LEGAL ARGUMENT**

#### **A. This Opposition Proceeding Should Be Suspended Because the Civil Action Will Have a “Bearing On” the Present Opposition**

This Board has the discretion to suspend its proceedings pending the final resolution of a civil action whereas here the outcome of the civil action “may have a bearing on” issues presented herein. 37 C.F.R. § 2.117(a). TBMP 510.02(a) (“Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.”); *Other Tel. Co. v. Connecticut Nat’l Tel. Co.*, 181 U.S.P.Q. 125, 127 (T.T.A.B. 1974) (ruling for suspension when “the outcome of the civil action will have a bearing on the issues involved in the proceeding.” See also Kearns-Tribune, LLC v. Salt Lake Tribune Publishing Co., 2003 WL 22134916 at \*3 (T.T.A.B. 2003) (“[s]uspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case.”); SoftBelly’s Inc. v. Ty, Inc., 2002 WL 1844210 at \*2 (T.T.A.B. 2002) (“[w]henever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties are engaged in a civil action ... which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action.”). Although these cases are not precedential, they are nevertheless persuasive examples of circumstances similar to those in this case in which the Board appropriately suspended its proceedings pending the outcome of separate civil actions.

Here, issues presented in this Opposition Proceeding are also before the District Court. Specifically, the District Court will determine the likelihood of confusion issues unique to “natural

sweetener” products that may be used in, or on, virtually any consumable product. The resolution of such issues definitely will “have a bearing on the case” before the Board.

In short, TTAB proceedings should be suspended whereas here a court will resolve issues that overlap with and therefore have a “bearing on” the resolution of issues before the TTAB. Whopper-Burger, Inc. v. Burger King Corp., 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971). Accordingly, because the pending civil action “involves many of the issues ... raised” before the Board, a suspension “can go a long way in resolving the problems relating to the issuance and existence of the registrations” at issue herein. Miller v. B&H Foods, Inc., 209 U.S.P.Q. 357, 359 (T.T.A.B. 1981) (indicating that “under normal circumstances ... it is the practice to suspend the proceeding before the Board to await the outcome of the civil action and to determine its effect on the issues.”). For these reasons, Opposer's motion for a suspension of Board proceedings should be granted.

**B. Suspension of TTAB Proceedings Will Avoid Duplicative Piecemeal Proceedings and Unnecessary Burden to the Parties and This Board**

The TTAB's practice of favoring suspension of opposition proceedings pending the outcome of civil actions reflects a policy of favoring the efficient adjudication of all issues presented in a single forum, rather than in piecemeal adjudications that waste the resources of the parties and the TTAB itself. In short, a suspension of this Opposition Proceeding will avoid unnecessary duplication of proceedings on registration issues that will ultimately be subject to appeal and resolution by the District Court itself. Such issues are now pending before the Court and their resolution may have a direct bearing on the outcome of this Opposition Proceeding. Accordingly, this Opposition Proceeding should be suspended to conserve the resources of the parties and this Board alike.

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