

TAB

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



In the Matter of:	)	08-12-2002
	)	U.S. Patent & TMO/TM Mail Rcpt Dt. #26
KULKONI, INC.	)	Opposition No. 121,226
(Texas Corporation)	)	
	)	Application Serial No.:
Opposer,	)	75/670,023
	)	Mark: Miscellaneous Design
v.	)	
	)	Filed: March 29, 1999
USHA MARTIN AMERICAS, INC.	)	Published: August 29, 2000
(Texas Corporation)	)	
	)	
Applicant.	)	

APPLICANT'S MOTION TO SUSPEND PROCEEDINGS AND  
INCORPORATED MEMORANDUM OF LAW

Pursuant to the provisions of Rule 2.117(a) of the Trademark Rules of Practice of the United States Patent and Trademark Office, Applicant, USHA Martin Americas, Inc., (hereinafter "USHA Martin") moves to suspend the above-captioned opposition pending disposition of Opposition No. 121,226 filed by third-party Southwest Wire Rope, Inc. (hereinafter "Southwest"). Third-party Southwest filed Opposition No. 121,226 to oppose the registration of application Serial No. 75/670,023, the same trademark application that is the subject of the instant opposition.

The disposition of Opposition No. 121,226 will determine whether USHA Martin has the right to register the mark that is the subject of application Serial No. 75/670,023 over the rights of third party Southwest. Should USHA Martin prevail, the instant

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opposition could resume and Opposer would not be prejudiced. Should Southwest prevail, USHA Martin would not be able to register the mark in question and the present opposition would be moot.

I. PROCEDURAL HISTORY

On March 29, 1999, USHA Martin filed application Serial No. 75/670,023. The application was filed based on an intent-to-use. The mark was approved for publication on August 28, 2000.

Three parties opposed the registration of USHA Martin's mark. Opposer filed a Notice of Opposition on September 28, 2000 to initiate the present opposition. Wire Rope Corporation of America, Inc. also filed a Notice of Opposition on September 28, 2000 to initiate Opposition No. 121,227. Southwest Wire Rope, Inc. filed a Notice of Opposition on December 5, 2000 to initiate Opposition No. 121,226.

Opposer filed a motion for summary judgment on March 1, 2001. The motion was denied on July 26, 2001 .

USHA Martin filed a motion for summary judgment in the present opposition on October 30, 2001. USHA Martin also filed a motion for summary judgment in Opposition Nos. 121,226 and 121,227 on October 30, 2001.

One of USHA Martin's motions for summary judgment was granted. USHA Martin's motion for summary judgment in Opposition No. 121,227 was granted on March 5, 2002. USHA Martin's motion for summary judgment in Opposition No. 121,226 was denied on March 8, 2002.

USHA Martin's motion for summary judgment in the present opposition was denied on April 19, 2002.

USHA Martin's testimony period is scheduled to begin in Opposition No. 121,226 on August 14, 2002.

The parties are currently in the discovery period in the instant opposition.

## II. ISSUE

Whether the Board should suspend an opposition during the discovery period when the application in question is subject to another opposition, and the other opposition is in the trial period?

## III. ARGUMENT

### I. The Board May Suspend an Opposition Proceeding Pending the Outcome of Another Opposition Proceeding Under a Recent Amendment To 37 C.F.R. § 2.117(a).

The Board may suspend an opposition proceeding pending the outcome of another opposition proceeding under a recent amendment to 37 C.F.R. § 2.117(a). Section 2.117(a) states:

[w]henever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action **or another Board proceeding** which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action **or the other Board proceeding**.

37 C.F.R. § 2.117(a) (emphasis added). Thus, the instant opposition may be suspended in view of the current opposition proceedings between USHA Martin and Southwest.

## II. Opposer Is Not Prejudiced By Suspension

Opposer is not prejudiced by suspension. Typically, the decision to grant a motion to suspend will depend upon what relief is being sought in the parallel proceeding. See e.g. *Toro Co. v. Hardigg Industries, Inc.*, 187 U.S.P.Q. 689, 692 (TTAB 1975) rev'd on other grounds 549 F.2d 785, 193 U.S.P.Q. 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 U.S.P.Q. 125, 126-27 (TTAB 1974), petition denied, 181 U.S.P.Q. 779 (Comm'r 1974). Since Southwest is seeking to prevent USHA Martin from registering the mark shown in application Serial No. 75/670,023 in Opposition No. 121,226, both Southwest and Opposer are seeking the same relief.

The instant case is analogous to *Argo & Company, Inc. v. Carpetsheen Manufacturing, Inc.*, 187 U.S.P.Q. 366 (TTAB 1975). In *Argo*, the Board suspended opposition proceedings pending the outcome of a Missouri state court lawsuit between two of the applicant corporation's incorporators. The opposer argued that the opposition should proceed because the opposer was not party to the suit, nor was it in privity with any of the parties involved in the suit. However, the Board suspended the opposition because the outcome of the pending civil suit could have had a direct bearing on the applicant's right to register. *Id.* at 367.

In the instant case, Opposer is in the same position as the Argo opposer. The outcome of Opposition No. 121,226 will have a direct bearing on USHA Martin's right to register. Should USHA Martin prevail, the instant opposition could resume and Opposer would not be prejudiced. Should Southwest prevail, USHA Martin would not be able to register the mark in question and the present opposition would be moot. Opposition No. 121,226 is closer to a resolution because Opposer Southwest has completed its direct testimony, while the instant opposition is still in the discovery period.

Finally, the instant opposition can be suspended because there are no dispositive motions before the Board. Suspension would not impose additional costs upon either Opposer or USHA Martin. Thus, judicial economy can be served by a suspension of the instant proceeding.

IV. CONCLUSION

The foregoing establishes that the Board should suspend the instant opposition proceedings pending resolution of Opposition No. 121,226.

Respectfully submitted,

USHA MARTIN AMERICAS, INC.



By:

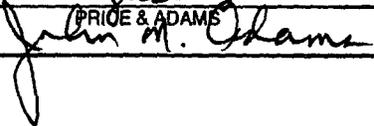
John M. Adams  
Attorney for Applicant

August 9, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

August 9, 2002

PRICE & ADAMS



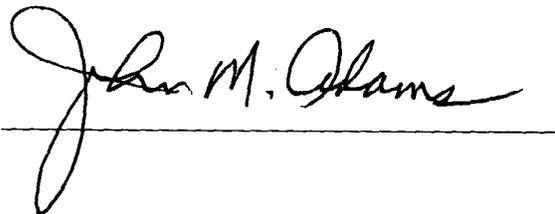
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CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of August, 2002, a true and correct copy of the foregoing APPLICANT'S MOTION TO SUSPEND PROCEEDINGS AND INCORPORATED MEMORANDUM OF LAW was deposited in the U.S. Mail, first class postage prepaid, addressed to:

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