

ESTTA Tracking number: **ESTTA69284**

Filing date: **03/03/2006**

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

Proceeding	91152940
Party	Plaintiff SINCLAIR OIL CORPORATION
Correspondence Address	JOHN C. STRINGHAM WORKMAN, NYDEGGER & SEELEY 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111
Submission	Other Motions/Papers
Filer's Name	Robyn L. Phillips
Filer's e-mail	rphillips@wnlaw.com, jgarcia@wnlaw.com
Signature	/Robyn L. Phillips/
Date	03/03/2006
Attachments	020 Motion to Suspend.pdf (7 pages)

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

In the matter of Trademark Application Serial No. 76/212,011
Published in the Official Gazette of May 28, 2002, on page TM 497, Int'l Class 35
Filed: February 20, 2001
Mark: STAACHI'S CO. 1996 & DESIGN

SINCLAIR OIL CORPORATION)	Opposition No. 91152940
Opposer,)	
v.)	MOTION TO SUSPEND AND
SUMATRA KENDRICK)	MEMORANDUM IN
Applicant.)	SUPPORT THEREOF

Pursuant to 37 C.F.R. § 2.117(c), Sinclair Oil Corporation (“Sinclair”) hereby requests that the present Opposition proceeding be suspended pending the decision on Sinclair’s Motion for Summary Judgment filed on March 1, 2006. In addition, Sinclair requests that in the event that its Motion for Summary Judgment is denied the discovery period to be reset to allow a short period of discovery on issues raised in Applicant’s Answer and the new causes of action added in Amended Notice of Opposition.

The present motion is supported by the Memorandum filed herewith.

DATED this 3^d day of March, 2006.

By: 
John C. Stringham, Registration No. 40,831
Robyn L. Phillips, Registration No. 39,330

WORKMAN | NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

Attorneys for Opposer
SINCLAIR OIL CORPORATION

MEMORANDUM

I. INTRODUCTION

Pursuant to 37 C.F.R. § 2.117(c), Sinclair Oil Corporation (“Sinclair”) hereby requests that (1) the Opposition proceedings be suspended pending the decision of Sinclair’s Motion for Summary Judgment filed on March 1, 2006; and (2) the discovery schedule be reset to allow discovery on the new causes of action provided in Sinclair’s Amended Notice of Opposition and Applicants’ Answer thereto. Sinclair previously moved to amend the Notice of Opposition. Concurrently therewith Sinclair moved to suspend the present Opposition and asked that if Sinclair’s Motion to Amend was granted the discovery period be reset to provide the same amount of time as existed at that time (five weeks). While the Trademark Trial and Appeal Board (“TTAB”) indicated that the motion was well taken and was granted, [*see* Dkt. No. 29, Notice mailed September 28, 2005], when the TTAB ruled to grant Sinclair’s Motion to Amend, the discovery period was not reset in accordance with Sinclair’s Motion to Suspend. In fact discovery was set to end one day after Applicant’s answer is due. [Dkt. No. 30, Order mailed January 31, 2006, at 2.]

As a result, Sinclair has not had an opportunity to receive any Answer filed by Applicant or to do any discovery in response to the same. Accordingly, Sinclair respectfully requests that the Board suspend the present Opposition proceedings until the Board issues such a decision.

II. ARGUMENT

A. The Board May Suspend Proceedings for Good Cause

Opposition “[p]roceedings may ... be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.” 37 C.F.R. § 2.117(c); *see Opticians Ass’n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 1181 (D.N.J. 1990); *see generally* TBMP § 510.01. The power to stay proceedings flows from the power inherent in the Board to schedule disposition of the cases on its docket with the goal of promoting fair and efficient adjudication. *Opticians Ass’n of America*, 734 F. Supp. at 1181.

B. Sinclair Has Good Cause for Requesting a Suspension of the Proceedings

During the discovery process, Sinclair learned that (1) Applicant's mark does not meet the requirements for registration under § 1(a) of the Trademark Act because Applicant has not used her mark in commerce, and (2) Applicant made false, material representations to the USPTO that Applicant knew to be false. Specifically, Sinclair learned that although Applicant represented to the USPTO in Application Serial No. 76/212,011 that Applicant had used the mark STAACHI'S CO. 1996 & DESIGN since March 20, 1996, Applicant admittedly never actually used the mark in commerce. Consequently, because of learning these facts during the discovery process, particularly those relating to Applicant's fraud on the USPTO, Sinclair was forced to file a Motion to Amend the pleadings to bring new causes of action.

As a result, on September 13, 2005, Sinclair moved to amend the Notice of Opposition and concurrently therewith filed a Motion to Suspend the Proceedings to provide that Sinclair would have the same amount of time as then currently remained in the discovery period (five weeks). [Dkt. No. 28.] On January 31, 2006, the TTAB mailed an Order granting Sinclair's Motion to Amend and ordered Applicant to file an Answer to the Amended Notice of Opposition. [Dkt. No. 30, at 2.] In its Order the TTAB made no reference to the Motion to Suspend but did reset the schedule. [*Id.*] Unfortunately, the schedule was a shortened schedule and Applicant's Answer was due one day before the close of discovery. [*Id.* at 2.]

In the meantime, on March 1, 2006, Sinclair filed a Motion for Summary Judgment. [Dkt. No. 31.] By the present motion Sinclair moves that in the event that Sinclair's Motion for Summary Judgment is denied, the schedule for this opposition be reset to provide some limited amount of time for the parties to conduct discovery on issues related to Applicant's Answer and the new causes of action. As of the time of filing the present motion, Sinclair has not received a copy of any answer filed by Applicant and the electronic docket for the present opposition available on-line at the web site of the United States Patent and Trademark Office does not show that an Answer was filed. As a result, Sinclair does not have time to do discovery in response to the Answer from Applicant or any of the new causes of action.

In its prior Motion to Suspend Sinclair requested that the discovery period be reset to allow as much time for completion of discovery as was remaining at the time of the filing of Sinclair's Motion to Amend (September 13, 2005 and October 21, 2005 or **over five weeks**). Sinclair renews this request in the event its Motion for Summary Judgment is denied so as to allow discovery on all the issues to be completed. Opposer respectfully submits that suspending these proceedings would be the most efficient course of action for the parties and the Board.

C. Applicant Will Not be Prejudiced by a Suspension of the Proceedings

Applicant will not be prejudiced by this Motion. Sinclair is only requesting that the status quo be maintained and that the Scheduling Order be suspended until a decision can be rendered by the Board on Sinclair's Motion for Summary Judgment. Once a decision is made on Sinclair's Motion for Summary Judgment, if necessary discovery can be completed on Applicant's Answer to the Amended Notice of Opposition and the new causes of action.

Sinclair respectfully submits that there are no facts supporting any allegation of bad faith or dilatory motive on the part of Sinclair in seeking a suspension of the proceedings. On the contrary, since Applicant's own admissions raise serious questions of misrepresentation to the USPTO, justice requires that Sinclair have the opportunity to question Applicant once she serves her Answer.

IV. CONCLUSION

Based on the foregoing, Opposer respectfully submits that it is proper to suspend the present Opposition proceeding pending a decision by the Board regarding Sinclair's for Summary Judgment and that the Scheduling Order be reset upon issuance of the Board's decision. Accordingly, Sinclair's Motion should be granted.

DATED this 3rd day of March, 2006.

By: Robyn L. Phillips

John C. Stringham, Registration No. 40,831
Robyn L. Phillips, Registration No. 39,330

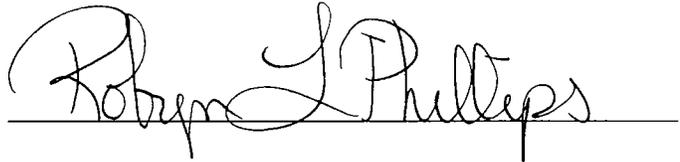
WORKMAN | NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

Attorneys for Opposer
SINCLAIR OIL CORPORATION

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **MOTION TO SUSPEND AND MEMORANDUM IN SUPPORT THEREOF** was served on Applicant by mailing a true copy thereof, by First Class Mail, postage prepaid, this 3rd day of March, 2006, in an envelope addressed as follows:

Sumatra Kendrick
P.O. Box 434
Berkeley, California 94701



J:\15027203\020 Motion to Suspend.doc