

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: January 21, 2009

Opposition No. 91175363

Ronald Creatore

v.

Parker Intangibles LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

Pursuant to the Board's November 18, 2008 order, opposer filed a copy of the pleadings filed in *PNH, Inc., Diversified Process Components, Inc., Hevun Diversified Corporation, and Ronald Creatore v. Parker Hannifin Corporation* (CIV -07-18267), filed in the Court of Common Pleas, Civil Division, Cuyahoga County, Ohio.

During the Board's November 17, 2008 phone conference, applicant Parker Intangibles LLC indicated that Parker Hannifin Corporation is applicant's parent company.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action pending between the parties in a state court which may be dispositive of or have a bearing on the Board case. See

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Trademark Rule 2.117(a); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983) (state court infringement action); *Professional Economics Incorporated v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion); and *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application). Here, among other remedies, opposer seeks to enjoin applicant's use of opposer's trademark PERFORMANCE STAINLESS, the subject of opposed Application Serial No. 766421000. If opposer is successful in obtaining the injunction, the civil action will have a bearing on this proceeding.

Accordingly, proceedings are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>