

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

MBA

Mailed: November 14, 2008

Opposition No. 91183674

The Grip Master Co. Pty.
Ltd.

v.

The Grip Master USA, Inc.

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of opposer's motion, filed October 9, 2008, to suspend this proceeding in favor of a pending federal court action between the parties, which includes claims of, among other things, trademark infringement (The Grip Master Co. Pty. Ltd. v. The Gripmaster USA, Inc. and Harry E. Sewill, Civ. Action No. 4:07-cv-04116, pending in the U.S. District Court for the Southern District of Texas) (the "Federal Case"). Applicant opposes the motion.

By way of background, applicant seeks to register THE GRIP MASTER, in standard characters, with GRIP disclaimed, for "golf club grips,"¹ and in its notice of opposition, opposer alleges that applicant's mark is likely to be

¹ Application Serial No. 76683027, filed October 17, 2007, alleging a date of first use in commerce of September 3, 2003.

confused with opposer's identical mark for identical goods, and that opposer has priority of use.² Opposer also alleges that applicant's use of its mark "is likely to mislead consumers into mistakenly concluding that Applicant's goods are sponsored or approved by Opposer" In its answer, applicant admits that its mark "resembles" opposer's, but otherwise denies the salient allegations in the notice of opposition.

In its motion, opposer alleges that the Federal Case is "related" to this one, and implicitly argues that it "may have a bearing" on this proceeding. Opposer also submits as exhibits to the Declaration of Mark G. Chretien, its counsel, copies of the pleadings in the Federal Case. The pleadings reveal that in the Federal Case, opposer alleges among other things that applicant's use of THE GRIP MASTER constitutes trademark infringement; opposer specifically alleges that applicant's use of the mark is likely to cause confusion with opposer's identical mark, and alleges, at least implicitly, that opposer has priority of use. Although opposer does not oppose registration of applicant's application in the Federal Case, or reference applicant's application in its prayer for relief, opposer alleges that

² Opposer also pleads ownership of application Serial No. 77446537, filed April 11, 2008, for the mark THE GRIP MASTER, in standard characters, for "golf club grips," alleging a date of first use in commerce of March 2, 1999.

applicant "committed fraud on the U.S. Patent and Trademark Office" during prosecution of its application, and that the "filing of this trademark application is another act of trademark infringement."

In its response to opposer's motion, applicant argues that the Board "has the power to determine and decide the respective rights Applicant and Opposer have to registration of a trademark ... [and] to determine priority of use" Applicant alleges that opposer's "inaction" in not filing its application until April 11, 2008 "shows a lack of diligence in asserting its recently-filed application claiming priority of use of the mark," but does not explain what this allegation, if true, may have to do with the matter at hand. Finally, applicant claims that opposer has not served any discovery requests in this proceeding, but again does not explain what this might have to do with the matter at hand.

The Board's well-settled policy is to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); TBMP § 510.02(a) (2d ed. rev. 2004). Here, the Federal Case involves the same parties and marks at issue in this proceeding, and the same issues, including which party has priority. Therefore, suspension is appropriate.

Applicant's arguments do not establish otherwise. While the Board "has the power" to determine whether a party is entitled to registration as a general matter, "the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a); see also, The Other Telephone Co. v. Connecticut National Telephone Co., Inc., 181 USPQ 779 (Comr. 1974); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971). Furthermore, opposer's alleged "inaction" in not filing its application sooner is not relevant to the issue of priority of use, and opposer's decision to not yet serve discovery in this proceeding has nothing to do with whether the Federal Case may have a bearing on this one. A review of the pleadings reveals that it may.

Accordingly, opposer's motion to suspend is **GRANTED**. Trademark Rule 2.117(a); TBMP § 510.02(a). Proceedings herein are suspended pending final disposition of the Federal Case. Within **twenty days** after the final determination of the Federal Case, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period the Board shall be notified 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/stdagmnt.htm>
