

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

Mailed: December 14, 2011

Opposition No. 91184529

GEORGIA-PACIFIC CONSUMER
PRODUCTS LP

v.

GLOBAL TISSUE GROUP, INC.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of opposer's motion (filed October 31, 2011) to suspend this opposition proceeding pending the disposition of a civil action between the parties.¹ The motion has been fully briefed.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (3d ed. 2011). On December 12, 2011, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's

¹ The referenced civil action is *Georgia-Pacific Consumer Products LP v. Global Tissue Group, Inc.*, Civil Action 11-CIV-7643, filed October 27, 2011, and pending in the United States District Court for the Southern District of New York.

counsel R. Charles Henn, Jr., Esq., applicant's counsel R. Glenn Schroeder, Esq., and the assigned interlocutory attorney.

Analysis

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board proceeding. The applicable authority, Trademark Rule 2.117(a), reads as follows:

- (a) Whenever 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.

See also TBMP § 510.02(a) (3d ed. 2011); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the district court. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn

1986). Suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. See TBMP § 510.02(a) (3d ed. 2011).

Opposer submitted with its motion a copy of the complaint filed in the civil action so as to aid the Board in determining whether the final decision in the civil action may have a bearing on the issues in this opposition. See TBMP § 510.02 (3d ed. 2011).

A review of the pleadings filed herein, as well as those filed in the civil action, indicates that the two matters involve the identical parties, involve common questions of law and/or fact, and involve rights in the mark QUILTY and QUILT-formative marks. In particular, in the civil action, opposer (as plaintiff therein) asserts ownership of several of the same registrations it asserts in the opposition, and sets forth claims of, inter alia, federal trademark infringement, federal unfair competition, and federal trademark dilution. Opposer seeks therein, inter alia, a determination that its registrations are valid, and that applicant should be enjoined from using any name or symbol that incorporates a "Quilt-" formative on or in connection with any of its consumer paper goods. Although the Board notes applicant's intention to file, in the civil action, a motion to dismiss the declaratory

judgment claim ("Count VIII") for lack of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1), the fact remains that applicant's use of its applied-for mark is a statutory condition precedent to obtaining a registration, and a determination affecting applicant's right to use or continue using its mark or marks is likely to bear on its ability to obtain a registration. At a minimum, in this manner, the civil action may have a bearing on this opposition proceeding.

It is noted that the Board's jurisdiction is limited to determining the right to registration; it does not have jurisdiction over the right to use, infringement or unfair competition claims. Whether a party's use of a mark is appropriate under authorities governing infringement is beyond the Board's jurisdiction. See TBMP § 102.01 (3d ed. 2011), and cases cited therein.

Finally, the Board notes that judicial economy will be served, and the possibility of reaching contrary outcomes will be avoided, through suspension of this opposition.

In view of this record, the Board determines that the outcome in the civil action may have a bearing on the opposition proceeding. Opposer's motion to suspend pursuant to Trademark Rule 2.117(a) is hereby granted.

Accordingly, this proceeding is suspended pending final disposition of the civil action. Within twenty (20) days

after the final determination of the civil action, the parties shall so notify the Board by filing notification(s) of this herein, so that the Board can call this case up for any appropriate action.²

During the suspension, the Board may issue periodic inquiries regarding the status of the pending civil action.

During the suspension, the parties shall notify the Board of any address changes for the parties or their attorneys.

² A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e. a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. See TBMP § 510.02(b) (3d ed. 2011).