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

EJW

Mailed: September 30, 2010

Opposition No. 91186986

LOEST & McNAMEE, INC.

v.

SHAUN ROBERTS ALLEN

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of opposer's fully-briefed motion (filed April 20, 2010) to suspend this proceeding pending final determination of a revocation action for non-use in the Intellectual Property Office of New Zealand in connection with the New Zealand registration upon which the application involved herein is based.

On September 30, 2010, the parties, Loest & McNamee, Inc., opposer (represented by Paulette Carey of the Buchman Law Firm, LLP), and Shaun Roberts Allen, applicant (represented by James B. Astrachan of Astrachan Gunst & Thomas, P.C.), and Elizabeth Winter, the assigned Interlocutory Attorney, all participated in a telephone conference regarding the above-referenced motion. *See*

Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP § 502.06 (2d ed. rev. 2004).

This order summarizes the conference and sets forth the status of the proceeding. The Board presumes the parties' familiarity with the arguments submitted with respect to the subject motion.

Motion to Suspend

Applicant seeks registration of the mark SILVER FERN under Section 44(e) of the Trademark Act in connection with his New Zealand registration No. 707364. In response to opposer's first request for admissions, applicant informed opposer that his registration is the subject of a revocation action for non-use before the Intellectual Property Office of New Zealand. In view of the potential cancellation of the registration underlying the involved application, opposer has requested that the Board suspend this proceeding pending the outcome of the revocation proceeding. Applicant essentially argues that this proceeding should not be further delayed based on an event that has not occurred.

It is the policy of the Board 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. *See* Trademark Rule 2.117(a). *See also* TBMP § 510.02(a) (2d ed.

rev. 2004). Additionally, the Board has determined that because a U.S. trademark application filed under Section 44(e) is dependent upon the validity of the underlying foreign registration up until the time the U.S. registration based thereon is issued (*see Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, *recon. denied*, 1 USPQ2d 1308 (TTAB 1986)), when a proceeding is commenced in the applicant's country of origin wherein the validity of the foreign registration has been brought into question, it is appropriate to suspend the pending Board proceeding related to the U.S. application. *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (TTAB 1993). "Were the foreign registration found to be invalid, there would be no valid basis for this application, in which case the opposition would be sustained." *Id.* at 1794.

During the conference, the parties also advised the Board that they believed that a decision would be issued soon by the Intellectual Property Office of New Zealand.

In view of the foregoing, and for judicial economy, the Board concludes that suspension of this opposition proceeding is appropriate. Opposer's motion to suspend is granted. Accordingly, this proceeding is **SUSPENDED** pending final disposition of above-referenced revocation proceeding.

Within twenty days after the final determination of revocation proceeding in New Zealand, the parties shall so notify the Board and call this case up for any appropriate action.

The parties are also required to submit a copy of the decision issued by the New Zealand Intellectual Property Office for the Board's consideration.

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

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