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

Proceeding	91193735
Party	Plaintiff Taylor Brands, LLC
Correspondence Address	Robert O. Fox Luedeka, Neely & Graham PC P.O. Box 1871 Knoxville, TN 37901 UNITED STATES RFox@LNG-patent.com
Submission	Motion to Suspend for Civil Action
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TAYLOR BRANDS, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	**Opposition No. 91193735**
	)	Serial No. 77/559,092
MARGARET LU D/B/A/ WUU JAU CO. INC.	)	
	)	
Applicant.	)	

MOTION TO SUSPEND

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Opposer, Taylor Brands, LLC, hereby moves pursuant to 37 C.F.R. § 2.117(a) to suspend Opposition No. 91193735, pending disposition of Civil Action No. 2:10-cv-00069, filed on April 2, 2010, by Opposer against Applicant in the United States District Court for the Eastern District of Tennessee. Applicant has filed an Answer, but the discovery period has not opened and no dispositive motions are pending before the Board.

The civil action pending between the parties in the district court involves issues in common with those in a proceeding before the Board, along with additional issues that could not be raised with the Board. A copy of the civil Complaint is appended hereto.

The district court action involves issues beyond the issue of registrability of the mark of Application Serial No. 77/559,092, including other uses of the terminology "Old Henry" by Applicant, along with infringement, unfair competition, and dilution claims. Accordingly, given the irreparable harm that is being caused to Opposer as a result of Applicant's actions as set forth in the Complaint, the interest in prompt adjudication of these matters weighs heavily in favor of suspension of the Opposition until final determination of the civil action.

Suspension of Opposition No. 93735, pending disposition of Civil Action No. 2:10-cv-00069 is therefore respectfully requested.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By: _____

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Reg. No. 34,165
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Certificate of Service

This is to certify that a true and correct copy of the foregoing is being served on counsel of record, by first class mail, postage prepaid, addressed as follows:

Ryan W. Hearne, Esq.
BROWN & GOULD, PLLC
701 N. Broadway, Suite 510
Oklahoma City, OK 73102

Date: April 6, 2010

_____
Robert O. Fox

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TENNESSEE

TAYLOR BRANDS, LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	No._____
	)	
WUU JAU CO. INC.	)	JURY TRIAL REQUESTED
	)	
Defendant.	)	

COMPLAINT FOR FEDERAL TRADEMARK INFRINGEMENT, TRADEMARK DILUTION, AND COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

Plaintiff, Taylor Brands, LLC ("Taylor Brands"), for its complaint against Defendant, Wuu Jau Co. Inc. ("Wuu Jau"), states as follows:

PARTIES

1. Taylor Brands is a limited liability company of the state of Tennessee and has its principal business address at 1043 Fordtown Road, Kingsport, Tennessee 37663.

2. On information and belief, Wuu Jau is a corporation of the state of Oklahoma and has its principal place of business at 2600 S. Kelly Avenue, Edmond, Oklahoma 73013.

JURISDICTION AND VENUE

3. This is an action for infringement, unfair competition, and dilution of trademark rights under the United States Trademark Act of 1946, the Lanham Act, 15 USC § 1051, et seq. and the common law.

4. On information and belief, the matter in controversy exceeds the sum or value of Seventy-Five Thousand Dollars ($75,000.00), exclusive of costs and interest, and the citizenship of Taylor Brands is diverse from the citizenship of Wuu Jau.

5. This Court has jurisdiction of the subject matter pursuant to 15 U.S.C § 1121, 28 U.S.C. §§ 1331, 1332, 1338, and under this Court's pendent jurisdiction over related state claims

arising under the same facts and circumstances pursuant to 28 U.S.C. § 1367.

6. Venue is proper in this district pursuant to 28 USC § 1391(b) and (c).

NATURE OF THE ACTION

7. Taylor Brands is the owner of record of U.S. Trademark Registration No. 818,241, issued November 8, 1966, for the trademark UNCLE HENRY for pocket knives ("the '241 Registration").

8. The right of Taylor Brands to exclusive use of the trademark UNCLE HENRY of the '241 Registration is incontestable for the goods stated therein in accordance with 15 U.S.C. §1065, with the effect given under 15 U.S.C. §1115(b) that the validity of the UNCLE HENRY trademark and Taylor Brands' right to exclusive use of the trademark for the goods in commerce are conclusively established.

9. Taylor Brands is the owner of record of U.S. Trademark Registration No. 717,513, issued June 27, 1961, for the trademark OLD TIMER for pocket knives ("the '513 Registration").

10. The right of Taylor Brands to exclusive use of the trademark OLD TIMER of the '513 Registration is incontestable for the goods stated therein in accordance with 15 U.S.C. §1065, with the effect given under 15 U.S.C. §1115(b) that the validity of the OLD TIMER trademark and Taylor Brands' right to exclusive use of the trademark for the goods in commerce are conclusively established.

11. Taylor Brands is, along with its predecessors in interest, at all times relevant hereto, in the business of, among other things, manufacturing and selling knives and related goods, including pocket knives under the trademarks UNCLE HENRY and OLD TIMER.

12. As a result of extensive and substantially continuous use and promotion of the trademarks UNCLE HENRY and OLD TIMER in interstate commerce in the United States by Taylor Brands and its predecessors in interest, such trademarks have become famous and well known throughout the United States.

13. Taylor Brands is the owner and beneficiary of all the goodwill associated with the UNCLE HENRY trademark and the OLD TIMER trademark.

14. On information and belief, Wuu Jau has been and is now engaged in the manufacture, importation, distribution, use, and/or sale of wholesale knives and swords in commerce in the United

States, including in this district.

15. In connection with its knife business, Wuu Jau has used and is now using the terminology OLD HENRY and OLD HENRY BLADES, or a similar variation thereof, as a trademark to identify pocket knives ("Infringing Mark"). A printout from Wuu Jau's website showing use of the Infringing Mark is attached as Exhibit A.

16. Taylor Brands has priority of use of its UNCLE HENRY and OLD TIMER trademark as compared to Wuu Jau for its use of the Infringing Mark.

17. At the time Wuu Jau commenced use of the Infringing mark, Wuu Jau was on constructive notice of Taylor Brand's registrations for the trademarks UNCLE HENRY and OLD TIMER, and is believed to have had actual notice of the same.

18. Wuu Jau is currently a customer of Taylor Brands for knife goods and, on information and belief, it knew that OLD TIMER brand knives were being sold side-by-side with UNCLE HENRY brand knives and it knew that taking the term "Old" from one trademark and "Henry" from the other trademark would trade on the goodwill and name recognition established by both OLD TIMER and UNCLE HENRY trademarks.

19. Taylor Brands placed Wuu Jau on actual notice of its rights in the trademarks UNCLE HENRY and OLD TIMER and demanded that Wuu Jau cease its use of the Infringing Mark, but Wuu Jau has refused to cease use of the Infringing Mark.

COUNT I

FEDERAL TRADEMARK INFRINGEMENT

20. Taylor Brands restates all of the averments listed above as if fully set forth herein, and for its Count I states as follows:

21. Wuu Jau unlawfully trades on the goodwill associated with the UNCLE HENRY trademark and infringes Taylor Brand's rights with the UNCLE HENRY trademark by selling, offering for sale, importing, distributing and/or advertising in interstate commerce knives or related goods identified using the Infringing Mark which is a reproduction, counterfeit, copy, or colorable imitation of Taylor Brand's UNCLE HENRY trademark.

22. The Infringing Mark is a clear combination of Taylor Brand's UNCLE HENRY and OLD TIMER trademarks, with the Infringing Mark being comprised primarily of the terminology "Old Henry," and the Infringing mark is likely to cause confusion among customers and otherwise dilute the OLD TIMER and UNCLE HENRY trademarks of Taylor Brands.

23. Use by Wuu Jau of the Infringing Mark for or in connection with the sale, offering for sale, importation, distribution and/or advertising of knives and/or related goods is likely to cause confusion, or cause mistake or to deceive in violation of 15 U.S.C. § 1114.

24. On information and belief, Wuu Jau will continue to sell, offer for sale, import, distribute and/or advertise knives and/or related goods under the Infringing Mark and variations thereof in violation of Taylor Brand's rights under federal law unless and until enjoined by this Court.

25. Taylor brand has been irreparably damaged and will be further irreparably damaged by Wuu Jau's use of the Infringing Mark for or in connection with the sale, offering for sale, importation, distribution and/or advertising of knives and/or related goods, and Taylor Brands has no adequate remedy at law.

COUNT II

FEDERAL UNFAIR COMPETITION AND RELATEDS VIOLATIONS

26. Taylor Brands restates all of the averments listed above as if fully set forth herein, and for its Count II states as follows:

27. Taylor Brands' UNCLE HENRY and OLD TIMER trademarks have been used in commerce by Taylor Brands for knife products since long before any first use of the Infringing Mark by Wuu Jau and are valuable assets of the business of Taylor Brands representing considerable goodwill in connection with the business of Taylor Brands.

28. The Infringing Mark used by Wuu Jau is confusingly similar to the previously used UNCLE HENRY trademark of Taylor Brands, is a combination of the previously used UNCLE HENRY and OLD TIMER trademarks of Taylor Brands, and is for the same or a closely related product; and use by Wuu Jau of the Infringing Mark or any other confusingly similar variation of previously used marks of Taylor Brands is likely to cause confusion, or to cause mistake or to deceive in violation of 15 U.S.C. § 1125(a).

29. Use by Wuu Jau of the Infringing Mark falsely represents or suggests to the consumer and to the trade in general that the knives sold, offered for sale, imported, distributed and/or advertised by Wuu Jau are distributed or sold with the permission of or authorization from the source of goods distributed or sold bearing the UNCLE HENRY trademark and/or the UNCLE HENRY and OLD TIMER trademarks or Taylor Brands, and/or that such knives have been manufactured, packaged or distributed in compliance with the quality standards maintained by Taylor Brands for products sold bearing its trademarks, in further violation of 15 U.S.C. § 1125(a).

30. The unauthorized uses by Wuu Jau of the Infringing Mark as alleged herein constitutes false designation of origin in violation of 15 U.S.C. § 1125(a).

31. On information and belief, Wuu Jau has by its use of the Infringing Mark falsely represented to and deceived the purchasing public and the trade in general as to the origin or source of the knives sold in interstate commerce by Wuu Jau so as to cause members of the purchasing public and the trade in general to believe that Wuu Jau has been authorized by, sponsored by or approved by the source of goods bearing the trademarks of Taylor Brands, and to falsely believe that

the knives emanate or are approved by the source of goods bearing the trademarks of Taylor Brands.

32. The unlawful use of the Infringing Marks by Wuu Jau was and is being undertaken by Wuu Jau with knowledge of the prior use by Taylor Brands of the UNCLE HENRY and OLD TIMER trademarks and with the deliberate intent to infringe upon the rights of Taylor Brands and to divert trade and goodwill from Taylor Brands.

33. The acts of Wuu Jau alleged in this Count have caused and will continue to cause substantial and irreparable harm, damage and injury to Taylor Brands and will continue unless and until enjoined and restrained by this court.

COUNT III

FEDERAL TRADEMARK DILUTION

34. Taylor Brands restates all of the averments listed above as if fully set forth herein, and for its Count III states as follows:

35. The UNCLE HENRY and OLD TIMER trademarks of Taylor Brands are distinctive and famous for knife products, including pocket knives, and use by Wuu Jau of the Infringing Mark and/or other marks and indicia on or in connection with knives which are the same as, counterfeits or colorable imitations of or confusingly similar variations of the famous trademarks of Taylor Brands has diluted and will continue to dilute the distinctive quality of such trademarks of Taylor Brands in violation of 15 U.S.C. § 1125(c).

36. Wuu Jau willfully and deliberately intended to trade upon the reputation and goodwill of Taylor Brands associated with the famous UNCLE HENRY and OLD TIMER trademarks of Taylor Brands and to cause dilution thereof.

37. Wuu Jau's use of the Infringing Mark to promote, market, and/or sell knives constitutes willful trademark dilution under 15 U.S.C. § 1125(c).

38. The acts of Wuu Jau alleged in this Count have caused and will continue to cause substantial and irreparable harm, damage and injury to Taylor Brands for which Taylor Brands has no fully adequate remedy at law, and will continue unless and until enjoined and restrained by this Court.

COUNT IV

COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

39. Taylor Brands restates all of the averments listed above as if fully set forth herein, and for its Count IV states as follows:

40. On information and belief, Wuu Jau knowingly manufactures, imports, sells, offers for sale, and/or distributes in interstate commerce knives and/or related goods under a mark or marks containing the terminology "Old Henry", which mark or marks are confusingly similar to the trademark UNCLE HENRY previously used by Taylor Brands, and is a combination of the previously used UNCLE HENRY and OLD TIMER trademarks of Taylor Brands, which activities will or are likely to cause confusion and deception as to the true source or origin of the goods.

41. The activities of Wuu Jau as alleged herein constitute unfair competition in violation of the common law and have been undertaken in order to cause confusion and deception among the purchasing public and the trade in general.

42. The acts of Wuu Jau alleged herein have or are likely to engender a false belief in the mind of the public and trade in general that Wuu Jau is affiliated with, sponsored by or associated with the source of goods sold bearing the previously used UNCLE HENRY trademark of Taylor Brands and/or the previously used UNCLE HENRY and OLD TIMER trademarks of Taylor Brands.

43. By reason of the foregoing, Wuu Jau has engaged in acts of trademark infringement and unfair competition in violation of the common law and on information and belief Wuu Jau will continue to engage in such acts inflicting irreparable harm and damage to Taylor Brands unless and until Wuu Jau is enjoined by this Court.

44. Taylor Brands has fully complied with 15 U.S.C. §§ 1051 et seq. and any and all other applicable statutes and federal and local rules to bring this action against Wuu Jau such that any determination by this Court of infringement, dilution, or other misuse of the Taylor Brands Marks by Wuu Jau should result in a full measure of appropriate damages including, without limitation, monetary damages, to Taylor Brands to compensate for such infringement.

WHEREFORE, Taylor Brands prays for at least the following relief:

a. A preliminary and permanent injunction and such other and further relief as is available under 15 U.S.C. § 1116 to prevent any further violation of Taylor Brands' exclusive rights under 15 U.S.C. §1114 in the incontestable federally registered OLD TIMER mark and the federally registered UNCLE HENRY mark.

b. A preliminary and permanent injunction and such other and further relief as is provided for under 15 U.S.C. § 1116 to prohibit any further violation of the exclusive rights under 15 U.S.C. §1125(a), and prohibiting Wuu Jau from unfairly competing with Taylor Brands through the use of spurious designations substantially identical with or confusingly similar to the previously used trademarks of Taylor Brands.

c. A preliminary and permanent injunction and such other and further relief as is provided for under 15 U.S.C. § 1116 to prohibit any further violation of the exclusive rights of Taylor Brands in the distinctive and famous UNCLE HENRY and OLD TIMER trademarks of Taylor Brands under 15 U.S.C. §1125(c), and to prohibit Wuu Jau from causing any further dilution of the distinctive quality of the trademarks of Taylor Brands.

d. That the Court preliminarily and permanently enjoin and restrain Wuu Jau and all of its employees, owners, officers, agents, attorneys, affiliates, all persons or entities in privity with it, and all those who receive notice thereof, from and against any and all further use of the Infringing Mark or any other mark confusingly similar to the trademarks of Taylor Brands, alone or in combination with any other words, for or in connection with the knife goods of Wuu Jau, or any related goods or services including, but not limited to, any use thereof on the Internet, in any metatags, electronic links, electronic banner ads, electronic pop-up ads, or any other print or electronic media.

e. An accounting and recovery under 15 U.S.C. § 1117(a) of all of Wuu Jau's profits from sales of or other activities associated with goods bearing or sold under the Infringing Mark and recovery under 15 U.S.C. § 1117 (a) of damages by Taylor Brands in an amount to be determined.

f. Trebling of Wuu Jau's profits or damages, whichever is greater, together with a reasonable attorney's fee and expenses and prejudgment interest, under 15 U.S.C. § 1117(a) and/or (b), due to the deliberate and willful misuse by Wuu Jau of federally registered and previously used

trademarks of Taylor Brands and Wuu Jau's use of a counterfeit mark in violation of 15 U.S.C. § 1114(1).

g. An award under 15 U.S.C. § 1117 to Taylor Brands of its costs in this action and reasonable attorney's fees and expenses due to the deliberate and willful nature of Wuu Jau's infringement and its continued infringement after a justified demand by Taylor Brands that Wuu Jau cease and desist its infringement necessitating this action, which should not have been necessary had Wuu Jau acted responsibly in recognition of clear superior and exclusive rights by Taylor Brands in the asserted trademarks.

h. That all goods, labels, signs, prints, packages, wrappers, catalogs and other promotional or advertising literature in the possession or control of Wuu Jau bearing the Infringing Mark, or any other colorable imitation or confusingly similar variation of the UNCLE HENRY and OLD TIMER trademarks of Taylor Brands be delivered up to an officer of the Court for destruction pursuant to 15 U.S.C. § 1118.

i. Such other, further, and additional relief as this Court may deem reasonable and just.

Taylor Brands demands a jury to try the issues joined.

Respectfully submitted,

By: _____

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ATTORNEYS FOR PLAINTIFF

EXHIBIT A

Wuu Jau Co. Inc.

Catalog Account Cart Track

Search for Enter Item # Search WuuJau :1-800-772-5760, Neptune :1-888-637-8723

AIRSOFT GUNS BLOWGUNS DAGGERS DISPLAY STANDS HANDMADE LETTER OPENER MARTIAL ARTS MEDIEVAL MISCELLANEOUS
NAME BRANDS NOVELTY SWORDS ORIENTAL OUTDOOR SPORTS POCKET KNIVES SECURITY EQUIPMENT SPECIAL BUY SWORDS
THROWING KNIVES THROWING STARS WALKING CANES

Old Henry

YO-123-1
3PC 3" MINI POCKET KNIFE

YO-123-2
3PC 3" MINI POCKET KNIFE

YO-123-3
3PC 3" MINI POCKET KNIFE

YO-123-4
3PC 3" MINI POCKET KNIFE

YO-15-1
2.25", MINI POCKET KNIFE KEYCHAIN WITH CASE

YO-15-2
2.25", MINI POCKET KNIFE KEYCHAIN WITH CASE

YO-15-3
2.25", MINI POCKET KNIFE KEYCHAIN WITH CASE

YO-15-4
2.25", MINI POCKET KNIFE KEYCHAIN WITH CASE

YO-20-1
3.5" MINI POCKET KNIFE WITH CASE

YO-20-2
3.5" MINI POCKET KNIFE WITH CASE

YO-20-3
3.5" MINI POCKET KNIFE WITH CASE

YO-20-4
3.5" MINI POCKET KNIFE WITH CASE

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