

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

MBA

Mailed: July 11, 2012

Opposition No. 91194504

Sutherland Centennial Lumber
Co., LLC, Sutherland
Building Materials Centers
LP and Sutherlands West
Texas, Inc.

v.

Cimarron Lumber and Supply
Company

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of applicant's motion, filed June 29, 2012, to suspend this proceeding pending final resolution of a pending civil action between, among others, the parties herein (Cimarron Lumber and Supply Company v. McLiney Lumber and Supply, LLC; Sutherland Building Material Centers, LP; Sutherlands West Texas, Inc.; and Sutherland Centennial Lumber Co., LLC, Case No. 2:12-cv-02240-JAR-KMH, pending in the U.S. District Court for the District of Kansas) (the "Federal Case"). The motion is fully briefed.

By way of background, applicant seeks registration of SUTHERLAND LUMBER COMPANY, in standard characters and with LUMBER COMPANY disclaimed, for "Retail lumber, building

supply and home improvement store services.”¹ In their notice of opposition, opposers allege co-ownership, and prior use, of SUTHERLAND LUMBER COMPANY and SUTHERLANDS for lumber yards, that use of applicant’s mark would be likely to cause confusion with opposers’ marks, fraud, nonuse and non-ownership. In its answer, applicant denies the salient allegations in the notice of opposition.

In the Federal Case, applicant is the plaintiff and opposers, among others, are the defendants. In its Complaint in the Federal Case, applicant alleges that it “manages and enforces the Sutherlands brand,” including the marks SUTHERLANDS and SUTHERLAND LUMBER COMPANY for “retail lumber, building supply, and home improvement goods and services.” Complaint in Federal Case ¶¶ 12, 14. Among other counts, applicant alleges that defendants’ use of certain SUTHERLAND marks is likely to cause confusion and thus constitutes trademark infringement. Applicant specifically alleges that it terminated the defendants’ license to use SUTHERLAND marks and seeks an injunction preventing their continued use of SUTHERLAND marks. In their answer to the Complaint in the Federal Case, opposers deny the salient allegations therein and counterclaim for cancellation of certain of applicant’s prior registrations

¹ Application Serial No. 77784368, filed July 19, 2009, alleging first use dates of December 31, 1936 and seeking registration under Section 2(f).

of SUTHERLAND marks, and for a declaration that the parties co-own these marks.

Applicant argues that like this proceeding, the Federal Case "concerns the allegation of likelihood of confusion" between the parties' marks, and that the Federal Case may "be determinative" of this one. Applicant also claims that the Federal Case "presents the most comprehensive and binding mechanism to resolve all trademark claims between the parties."

Opposers argue, however, that the Board should exercise its discretion to proceed with this case, because a Board ruling on the merits would be "instructive" and likely issue prior to a decision in the Federal Case, and because the Federal Case will not be "directly determinative" with respect to the involved application.

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); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB 1992). Here, it is clear from the Complaint in the Federal Case, and opposers do not specifically dispute, that the Federal Case "may have a bearing" on this proceeding. Trademark Rule 2.117(a). In fact, the issue of which party or parties owns the SUTHERLAND marks is directly at issue in

the Federal Case, as well as this one. The issue of whether the parties' SUTHERLAND marks are likely to be confused is part of both proceedings. Fraud is at issue in both proceedings.

Opposers' arguments against suspension are unavailing. It is far from certain whether this proceeding would terminate before the Federal Case, especially because discovery is not yet closed in this proceeding, and preliminary injunctive relief may be available in the Federal Case, and often leads to a more expeditious ultimate resolution of disputes. More importantly, even if it was certain that this case would be decided before the Federal Case, the Board's ruling would be more disruptive than "instructive." Indeed, the point is that the decision in the Federal Case may be "binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a) (3d ed. rev. 2012); 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). Therefore, proceeding here would risk inconsistent judgments, which establishes that judicial economy would in fact be best served by waiting for the Court, which has extensive experience in deciding trademark issues, to resolve the parties'

trademark-related disputes if they cannot resolve them on their own.

For all of these reasons, applicant's motion to suspend this proceeding pending final determination of the Federal Case is hereby **GRANTED**. Accordingly, proceedings herein are suspended pending final disposition, or suspension,² of the Federal Case.³ 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.

² In the event the Court suspends the Federal Case in favor of this one, this proceeding will be promptly resumed.

³ The parties should amend the pleadings in the Federal Case or take other steps to ensure that the Court specifically addresses whether the involved application should issue and what should happen with respect to the parties' related SUTHERLAND applications and registrations.