

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

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Mailed: January 31, 2011

Opposition No. **91197014**

Big Creek Expeditions, Inc.,
Nantahala Outdoor Center, Inc.,
Outdoor Adventures, Inc.,
Smoky Mountain Outdoors
Unlimited, Inc., and
Rapid Expeditions, LLC

v.

RITS, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

On January 27, 2011, the Board held a telephone conference to hear argument and rule on applicant's motion (filed December 27, 2010) to suspend or dismiss the current proceeding in favor of a civil action between the parties (*RITS, LLC v. Big Creek Expeditions, Inc., Outdoor Adventures, Inc., Rip Roaring Adventures, Inc. and Rapid Expeditions, LLC*, Case No. 3:10-cv-00558, pending in the U.S. District Court for the Eastern District of Tennessee, Northern Division). The motion is fully briefed. Jacob Horton, Esq. appeared as counsel for opposers and Michael Robinson, Esq. appeared as counsel for applicant.

Background

In involved application Serial No. 85019492, applicant seeks registration of RAFTING IN THE SMOKIES in standard characters for "providing outdoor recreational services in the nature of rafting" in International Class 41.¹ Opposers filed a notice of opposition on October 20, 2010, alleging mere descriptiveness under Section 2(e)(1) of the Trademark Act, geographic descriptiveness under Section 2(e)(2), genericness under Section 23, and fraud.

On December 23, 2010, applicant instituted a civil action in the U.S. District Court for the Eastern District of Tennessee against three of the five opposers in the Board proceeding alleging unfair competition, trademark infringement and violation of the Tennessee Consumer Protection Act.

The Parties' Positions

In support of its motion to suspend, applicant argues that "the federal court litigation involves issues in common with those in this proceeding" to the extent that "the issues likely to be raised by opposers in their response to the complaint [in the civil action] are substantially the same as those involved in these proceedings" and that a "final determination of the issues in the federal litigation

¹ The application was filed April 21, 2010, under a claim of acquired distinctiveness under Section 2(f) of the Trademark Act and published for opposition on September 21, 2010, with a disclaimer of RAFTING.

will likely have a bearing on the issues presently before the Board." *Applicant's Brief in Support of Motion to Stay or Dismiss Proceedings* ("Applicant's Brief"), pp. 2-3.

In response, opposer argues that "two of the Opposers (NOC [Nantahala Outdoor Center, Inc.] and Smoky Mountain Outdoors) are not parties" to the civil action and, as such, "it is highly unlikely that any judgment rendered in the [civil action] would serve to simplify the issues in the present Opposition with respect to NOC or Smoky Mountain Outdoors, and suspension of the present Opposition would only serve to unnecessarily delay the outcome of the present Opposition with regard to NOC and Smoky Mountain Outdoors." *Response to Motion to Stay or Dismiss Proceedings* ("Opposer's Response"), pp. 2-3. Opposer further adds that suspension by the Board is discretionary and not mandatory. *Id.*

Opposers elaborated on their position during the phone conference. The Board has carefully reviewed the parties' arguments and submissions.

Decision

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). During the telephone conference, opposer confirmed that, at the very least, the issues of mere descriptiveness and genericness of applicant's mark will be determined in the civil action. Therefore, it cannot be disputed that the civil action will, at the very least, have a bearing on the current Board proceeding. Further, as these are issues that go to the nature of the mark and is not unique to the party asserting them, that two of the opposers in the Board proceeding are not parties to the civil action is of no event. Indeed, the mere fact that the parties in the two proceedings are not identical or that a party is not involved in the civil action does not preclude a suspension of the Board proceeding in favor of the civil action. See, e.g., *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (suspended in favor of state court action between applicant and third party).

In view thereof, suspension of this proceeding is appropriate and applicant's motion to suspend is hereby **GRANTED**.² Proceedings are suspended pending final disposition of the civil action.³ Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for any

² As there is no provision in Trademark Rule 2.117(a) pursuant to which a party can seek dismissal of the Board proceeding in favor of a civil action, applicant's motion is **DENIED**.

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appropriate action. During the suspension period, the Board shall be notified of any address changes for the parties or their attorneys.

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³ In view of the Board's decision to suspend, applicant's motion (filed December 29, 2010) for an extension of time to file its answer is **MOOT** and will be given no further consideration.