

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER (GENERAL)  
(With Certificate of Mailing by Express Mail)

Docket No.  
FinalRod-001

Name of Applicant: R2 R&D, LLC

Serial No., if Any: Opposition No. 91202718

Registration No.:

Trademark: FINALROD

761707,726

TO THE COMMISSIONER FOR TRADEMARKS

Transmitted herewith is the following document(s):

- Return postcard;
- Response to Motion to Suspend Proceedings Pending Final Disposition of Civil Action;
- Certificate of Service; and
- Exhibit A.

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Signature

Dated: January 25, 2012

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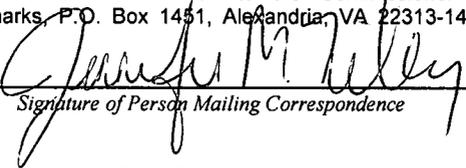


01-25-2012

U.S. Patent & TMO/PTM Mail Repl. Bl. #01

cc: Finnegan, Henderson, Farabow, Garrett & Dunner  
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Opposer (i.e., filer is not a party in the proceedings), but some entity called “Juniper Networks, Inc.” (Motion at Pg. 2.) Because the filing of the Motion does not meet the requirements of 37 C.F.R. § 2.117(c), as set forth above, and the requirements of 37 C.F.R. § 2.193(e) (“Documents filed in connection with a trademark application or registration must be signed by a proper person.”), the Motion should not be granted by the TTAB.

### **Factual Background of Opposition and Motion to Suspend**

Because the request to suspend the Opposer’s own opposition to Applicant’s registration is left to the discretion of the TTAB, 37 C.F.R. § 2.117(a), a brief factual background is warranted to establish the reasons why the TTAB should not suspend the opposition in this case, in addition to the important reason set forth above.

Applicant filed an application for the registration of the trademark, FINALROD, which is the application at issue in this opposition, on May 24, 2011. After an in-depth search by the United States Patent and Trademark Office (USPTO), no likelihood of confusion was found by the USPTO, with regard to any pending or registered trademarks, that would bar registration of the trademark, FINALROD, and the FINALROD application was published for opposition on October 18, 2011. (See Notice of Opposition attached as Exhibit “A,” herein). John Crane’s opposition was filed on November 22, 2011, and the opposition primarily argues a likelihood of confusion between Applicant’s FINALROD and John Crane’s trademark FIBEROD, which disputes the search results and findings for “no likelihood of confusion” by the USPTO. On the same day, John Crane filed a Complaint in the United States District Court for the Northern District of Texas alleging Lanham Act and state common law trademark infringement, and relying principally on the presence of a likelihood of confusion between John Crane’s FIBEROD trademark and Applicant’s FINALROD trademark for such infringement allegation(s).

Applicant filed its responsive answer to the opposition on January 6, 2012, and included a number of affirmative defenses. (Answer at Pg. 4.). On January 9, 2012, Applicant also filed responsive pleadings to John Crane's Complaint in Federal District Court. One day after the filings in District Court, this Motion was filed to suspend the Opposer's own opposition to the registration of the trademark, FINALROD, before Applicant could file a brief supporting its affirmative defenses, as asserted on page four of its Answer, and including arguments to show the TTAB that Opposer's claims are completely without merit and are nothing more than a tactic to delay the registration of Applicant's mark, which is important to Applicant's business.

#### **Response to Motion to Suspend**

Pursuant to the requirements of 37 C.F.R. § 2.117(c), a motion filed to suspend proceedings before the TTAB, must be filed by the parties and must state a good cause for the suspension. The Motion to suspend proceedings, as filed on January 10, 2012, was not submitted by the parties and fails to establish sufficiently a good cause for the suspension of the proceedings.

From the Notice of Opposition, it is clear that the Opposer's primary argument for its opposition is an allegation of a likelihood of consumer confusion between Applicant's FINALROD and John Crane's trademark FIBEROD. However, the USPTO has searched and reviewed Applicant's mark, FINALROD, and has made a determination that there is no likelihood of consumer confusion with regard to any pending or registered trademarks, including such trademarks as FIBEROD.

In addition, from the above facts, it is clear that the goal of the Motion filed on January 10, 2012, in requesting a suspension of the proceedings before the TTAB, is more about delaying the proceedings and the registration of the mark, FINALROD, which prejudices Applicant. Applicant and its subsidiaries are building and conducting their business in the fiberglass

composite sucker rod industry, under the name Finalrod, Inc. To prevent further harm to Applicant's business, Applicant should be entitled to a prompt determination by the TTAB as to whether Applicant's mark FINALROD, for use in connection with Applicant's fiberglass composite sucker rod products, is registrable. In moving to suspend its own opposition to the registration of the FINALROD trademark, and causing Applicant to await the final disposition in the civil action, Opposer is merely conducting a delay tactic toward Applicant, to control and/or eliminate any business competition in the industry. Accordingly, the Motion should not be granted by the TTAB.

The timing of the motion for suspension is also evidence of such a delay tactic by Opposer, and the lack of merit in the opposition. The opposition was on filed on November 22, 2011, the same date as the filing of the Federal District Court Complaint. Rather than immediately moving to suspend the opposition, Opposer waited until all responsive pleadings were filed as to both proceedings. This tactic caused Applicant to have to respond to two petitions, one in District Court and another in the TTAB, and gave Opposer the opportunity to review and evaluate Applicant's responses. Applicant had to spend time, money, and resources to prepare and respond to both pleadings. Now that Applicant has met its burden of responding in both proceedings and Opposer recognizes the lack of merit in its opposition, Opposer has taken it upon itself to allege and determine that the continuation of the two simultaneous proceedings will somehow be duplicative. In fact, if there is any alleged duplication, then the proceedings were just as duplicative before Applicant filed a response in this proceeding and the Federal District Court. Any alleged duplicity is therefore not a good cause for suspension.

Further, if Opposer were truly concerned with the registration of the trademark based upon a likelihood of consumer confusion, it would want to proceed with its own opposition of

the registration and prove that the likelihood of confusion exists, both before the TTAB and the District Court, as it required Applicant to respond to both allegations before moving to suspend this proceeding.

Whether to suspend or continue a TTAB proceeding under 37 C.F.R. § 2.117(a) is left to the discretion of the TTAB. (“Whenever it shall come to the attention of the (TTAB) 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.” (emphasis added)). While a determination of the TTAB is not binding on the District Court, that does not preclude or lessen the importance of determining whether to issue the trademark, and actually weighs in Applicant’s favor as a reason why the proceedings should continue.

The question to be determined by the TTAB is only whether or not the trademark is registrable, not Lanham Act infringement and common law claims. *See Goya Foods, Inc. v. Tropicanna Products, Inc.* 846 F.2d 848, 854 (2d Cir.1988). The TTAB action is thus narrower and focused on any likelihood of confusion with regard to the trademark registration, and the parties may proceed without prejudice to either of their claims or defenses in the District Court. *Id.* However, “[p]resumably, awaiting the PTO’s registration decision would allow the District Court to enlist the PTO’s reasoning and even its results in support of its own conclusions, assuming the registration decision rested on the grounds relevant to the infringement claim.” *Id.* In this proceeding, a finding by the TTAB with regard to the allegation of likelihood of confusion and a decision by the TTAB regarding the registration of Applicant’s mark FINALROD, are both relevant to the alleged infringement claims, which are based primarily

upon a claim of likelihood of confusion, also. Accordingly, the Opposer's opposition should proceed before the TTAB.

Thus, in this case, where Opposer filed the trademark opposition and trademark infringement proceedings on the same date, with claims that are without merit in law and fact, and required Applicant to file responses to both its opposition and complaint before moving to suspend the opposition, the TTAB should exercise its discretion and continue the proceeding. The Opposer should not get the benefit of requiring Applicant to spend time and resources to respond, the benefit of seeing Applicant's response, and then trying to suspend its own opposition once it realizes how unmeritorious its claims are in law and fact, before Applicant is provided an opportunity to have its dispositive motion(s) heard and its trademark registered.

Accordingly, Applicant respectfully requests that the United States Trademark Trial and Appeal Board deny the Motion and continue all proceedings, pursuant to the Trademark Rules.

Dated: January 25, 2012

Respectfully Submitted,



Terry L. McCutcheon  
Texas Bar No. 24039045  
USPTO Reg. No. 68,122

***CERTIFICATE OF SERVICE***

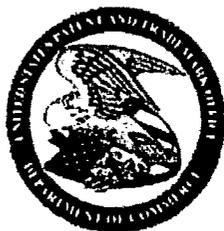
Pursuant to 37 C.F.R. §2.119, the undersigned certifies that a true and correct copy of the foregoing Response to Motion is being served, via Certified Mail, Return Receipt Requested, on Opposer John Crane Production Solutions, Inc., on this 25<sup>th</sup> day of January, 2012, at the following address:

John Crane Production Solutions, Inc.  
6400 West Oakton Street  
Morton Grove, Illinois 66053  
USA

Courtesy Copy To Counsel:  
Via Certified Mail, Return Receipt Requested, No. 7011 1570 0000 9065 2598  
Julia Anne Matheson  
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP  
901 New York Ave., N.W.  
Washington, D.C. 20001-4413

  
Terry L. McCutcheon

Side - 1

**NOTICE OF PUBLICATION UNDER §12(a)****MAILING DATE: Sep 28, 2011****PUBLICATION DATE: Oct 18, 2011**

The mark identified below will be published in the Official Gazette on Oct 18, 2011. Any party who believes they will be damaged by registration of the mark may oppose its registration by filing an opposition to registration or a request to extend the time to oppose within thirty (30) days from the publication date on this notice. If no opposition is filed within the time specified by law, the USPTO may issue a Notice of Allowance.

To view the Official Gazette online or to order a paper copy, visit the USPTO website at <http://www.uspto.gov/web/trademarks/tmog/> any time within the five-week period after the date of publication. You may also order a printed version from the U.S. Government Printing Office (GPO) at <http://bookstore.gpo.gov> or 202-512-1800. To check the status of your application, go to <http://tarr.uspto.gov/>.

**SERIAL NUMBER: 76707726**  
**MARK: FINALROD**  
**OWNER: R2 R&D, LLC**

Side - 2

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 COMMISSIONER FOR TRADEMARKS  
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