

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

MBA

Mailed: February 6, 2012

Opposition No. 91202718

John Crane Production
Solutions Inc.

v.

R2 R&D, LLC

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of opposer's fully-briefed motion, filed January 10, 2012, to suspend this proceeding pending final resolution of a pending civil action between the parties herein (John Crane Production Solutions, Inc. v. R2R AND D, LLC et al., Case No. 3:11-cv-03237-D, pending in the U.S. District Court for the Northern District of Texas) (the "Federal Case").

By way of background, applicant seeks registration of FINALROD, in standard characters, for "Machines and machine tools, namely, fiberglass sucker rods and fiberglass suck rod end-fittings."¹ In its notice of opposition, opposer alleges prior use and registration² of FIBEROD and

¹ Application Serial No. 76707726, filed May 24, 2011 based on an alleged intent to use the mark in commerce.

² Registration Nos. 2918590 and 3270750, issued January 18, 2005 and July 31, 2007, respectively, both for "Machine tools, namely, fiberglass sucker rods and fiberglass sucker rod end-fittings." Opposer claims to have acquired the registrations by

variations thereof for "fiberglass sucker rods and related products," and that use of applicant's mark would be likely to cause confusion with opposer's marks. One of opposer's pleaded registrations is over five years old. In its answer, applicant denies the salient allegations in the notice of opposition.

Opposer filed the Federal Case on the same day it filed this one, and therein alleges prior use and registration of FIBEROD, including through its predecessor-in-interest, pleading the same registrations it pleads in this case, and trademark infringement. Complaint in Federal Case ¶¶ 9-17, 25, 37, 41-46. Opposer specifically references applicant's involved application in its Complaint in the Federal Case, and seeks a permanent injunction prohibiting applicant "[f]rom using or registering the FINALROD Marks" Id. ¶ 1, Prayer for Relief ¶ B(1).

Opposer argues "that the issues raised in the notice of opposition may be resolved by the" Federal Case, "which involves common issues of law and fact that may have a bearing on this proceeding."

In response, applicant argues that opposer did not in fact file its motion for suspension, but that instead a nonparty name "Juniper Networks, Inc." filed the motion.

assignment from one of the defendants in the Federal Case, as recorded at Reel 4537/Frame 0287. See also, Reel 4537/Frame 0305.

Applicant does not indicate why a nonparty might seek a suspension of a case it is not involved in, nor does it deny that the parties to this proceeding are also parties to the Federal Case. Applicant provides no evidence that a nonparty filed the motion to suspend. In any event, applicant concedes that in this case opposer "primarily argues a likelihood of confusion" and that in the Federal Case opposer is "relying principally on the presence of a likelihood of confusion." Applicant points out that during the *ex parte* examination of its involved mark, the Office did not issue any refusals under Section 2(d) of the Act, and complains that opposer waited until after applicant filed its answers in both proceedings to seek suspension of this one. Finally, applicant accuses opposer of attempting to "delay" this proceeding and the Board's determination of whether applicant's involved mark is entitled to registration.

Before addressing the substance of opposer's motion, applicant's argument that a nonparty filed the motion to suspend is not well-taken. The motion's caption, case number, the signature thereon and the exhibits thereto all establish that opposer filed the motion on its own behalf. A typographical error in identifying opposer in one place in the motion is not a ground for ignoring the motion.

With respect to substance, 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 applicant does not specifically dispute, that the Federal Case may have a bearing on this proceeding. Indeed, the same parties and marks are at issue in both proceedings, and as applicant admits, the primary issue in both proceedings is likelihood of confusion. In the Federal Case, opposer specifically requests an injunction prohibiting applicant from registering its involved mark. Therefore, suspension is appropriate, including because 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. 2011); 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). Indeed, as held in one of the cases upon which applicant relies, even if this case were to proceed, "[t]he District Court would still independently have to determine the validity and priority of the marks and the likelihood of consumer confusion as to the

source of the goods," so proceeding here would be inefficient at best. See, Goya Foods, Inc. v. Tropicana Products, Inc., 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988).

Applicant's arguments against suspension are unavailing. The results of the *ex parte* examination of applicant's involved application are not relevant in an *inter partes* proceeding such as this. Nor is it relevant that applicant prepared answers in both proceedings before opposer moved to suspend. Opposer moved relatively promptly after filing the Federal Case given the holiday season, and the effort applicant expended in drafting two answers will surely pale in comparison to the efforts it will undertake to defend either or both proceeding(s). Applicant's concern with delay is misplaced, because the Federal Case may very well terminate before this one would, and even if that was not the case, and this proceeding was not suspended, applicant would still have to await the final decision in the Federal Case to determine whether it will be prohibited from "using or registering the FINALROD Marks."

For all of these reasons, suspension is appropriate and opposer's motion to suspend is hereby **GRANTED**. Proceedings herein are suspended pending final disposition of the Federal Case. Within twenty days after the final determination of the Federal Case, the parties shall so

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notify the Board and call this case up for any appropriate action. During the suspension period the parties shall notify the Board of any address changes for the parties or their attorneys.
