

ESTTA Tracking number: **ESTTA648875**

Filing date: **01/08/2015**

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

Proceeding.	91219124
Applicant	Defendant American Steamboat Company, LLC
Other Party	Plaintiff American Cruise Lines, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	No

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, American Steamboat Company, LLC hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

American Steamboat Company, LLC has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

American Steamboat Company, LLC has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Robert P. Herre/
Robert P. Herre
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01/08/2015

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

In Re Trademark Application Serial Nos.: 86/297,459 and 86/277,094

Marks: AMERICAN COUNTESS and AMERICAN PRINCESS

Filed: 6/1/2014 and 5/9/2014

Published: 10/7/2014

AMERICAN CRUISE LINES, INC.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91219124
)	
AMERICAN STEAMBOAT COMPANY, LLC)	
)	
Applicant.)	

FILED VIA ESTTA

CONSENT MOTION TO SUSPEND

Applicant, American Steamboat Company, LLC (“Applicant” or “ASC”), by counsel, pursuant to Trademark Rule 2.117(a) (37 C.F.R. §2.117(a)) and §510.02(a) of the Trademark Board Manual of Procedure (“TBMP”), and with the consent of Opposer, American Cruise Lines, Inc. (“Opposer” or “ACL”), hereby moves that the Trademark Trial and Appeal Board (“TTAB” or the “Board”) suspend proceedings in the above-captioned opposition pending the disposition of a civil action between Opposer and Applicant and Applicant’s related-entities, HMS American Queen Steamboat Company LLC and American Queen Steamboat Operating Company LLC (collectively “Applicant”, unless otherwise specified herein), which raises the same issues of facts and law. In further support thereof, Applicant states as follows:

1. The parties in this Opposition are currently involved in pending litigation in the U.S. District Court for the District of Delaware, captioned *American Cruise Lines, Inc. v. HMS American Queen Steamboat Company LLC and American Queen Steamboat Operating Company, LLC*, Case No. 1:13-CV-00324 (“the Litigation”).

2. The Litigation involves, *inter alia*, claims of trademark infringement and/or unfair competition based on Applicants’ use and/or registration of the marks AMERICAN QUEEN, THE AMERICAN QUEEN STEAMBOAT COMPANY and AMERICAN EMPRESS and Opposer’s claim to ownership of marks and a family of marks incorporating the term “American.” A copy of the Second Amended Complaint in the Litigation is attached hereto as **Exhibit A**, and incorporated by reference herein.

3. Applicant, American Steamboat Company, LLC has expressly agreed to be bound to any determination made in the Litigation.

4. The Board may suspend proceedings when the parties “are engaged in a civil action or another Board proceeding which may have a bearing on the case.” 37 C.F.R. § 2.117. Indeed, “it is generally the Board’s policy to suspend when the parties are engaged in . . . a civil action.” *Boys Collection Ltd v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003).

5. Reasoning that the district court’s determination would be binding on the Board, but that the Board’s decision would merely be advisory to the district court, the Board has previously suspended proceedings when the parties are also engaged in a civil action to “avoid the undesirable result of the parties litigating the same issue in two forums, with potentially inconsistent results and would minimize waste of both the parties’ and the Board’s resources.” *see* TBMP § 510.02(a) (citing *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPTQ2d 1933 (TTAB 1992)); *Toro Co. v. Hardigg Indus., Inc.*, 187 USPQ 689 (TTAB 1975) *rev’d on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Tel. Co. v.*

Connecticut Nat'l Tel. Co., Inc., 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Sonora Cosmetics, Inc. v. L'Oreal S.A.*, 631 F.Supp. 626, 629 (S.D.N.Y. 1986) ("Moreover, . . .the Commissioner of Patents has held that, inasmuch as TTAB determination of the validity of registration are merely advisory to the courts, it is preferable for the TTAB to stay its own proceedings where parallel litigation occurs in the district court.").

6. The Board should suspend the present opposition proceeding because the disposition of the Litigation bears on the seminal issues before the Board in the opposition proceedings.

7. The District Court action involves the same parties and many of the same marks as the present opposition proceedings and any determination by the District Court would be dispositive of the same issues before this Board. *General Motors Corp.*, 22 USPQ2d 1933. Further, there are no pending dispositive motions before the Board, and neither party has entered the trial testimony period yet, thus there is no decision ripe for judgment. TBMP § 510.02(a), n.173 (citing *Boyds Collection Ltd.*, 65 U.S.P.Q.2d 2017; *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807, 808 n.3 (TTAB 1978); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (TTAB 1973)).

8. To that end, suspension of the opposition proceedings are warranted to avoid litigation of the same issues in two forums and to minimize waste of both the parties' and the Board's resources. *Sonora Cosmetics, Inc.* at p. 629.

9. Therefore, pursuant to Trademark Rule 2.117(a) and TBMP § 510.02(a), Opposer, with the consent of Applicant, respectfully requests the Board to suspend the above-styled opposition proceedings pending disposition of the Litigation.

WHEREFORE, for the reasons set forth above, Applicant prays for an Order of this Board suspending all opposition proceedings herein pending disposition of the previously filed civil action in the U.S. District Court for the District of Delaware.

Dated: December 22, 2014

Respectfully submitted,

/Robert P. Herre/

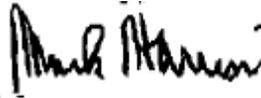
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COUNSEL FOR APPLICANT
AMERICAN STEAMBOAT
COMPANY, LLC

CONSENT

Opposer, by and through its attorneys, hereby consents to abandonment of the above-referenced application with prejudice.

December 22, 2014
Dated: _____



Mark B. Harrison
COUNSEL FOR OPPOSER
AMERICAN CRUISE LINES, INC.

CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION

The undersigned hereby certifies that a true and correct copy of this Consent Motion to Suspend has been submitted via ESTTA and served via electronic mail, on December 22, 2014, on the following counsel of record for Opposer:

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/Brian McGraw/

COUNSEL FOR OPPOSER