

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: December 9, 2015

Opposition No. 91221590

Emerson Electric Co.

v.

S.C. Ion Mos S.R.L.

Andrew P. Baxley, Interlocutory Attorney:

In a September 28, 2015 order, the Board, among other things, deferred consideration of Opposer's motion (filed August 24, 2015) to suspend this case pending final determination of civil actions involving the basic and international registrations upon which Applicant's involved Section 66(a) application is based and allowed Opposer until October 27, 2015 to file copies of the pleadings in the Romanian and international civil actions and translations thereof where necessary so that the Board can determine whether suspension of this proceeding is warranted. On October 26, 2015, Opposer filed the requested documents.

Under Trademark Rule 2.117(a), "[w]henver it shall come to the attention of the ... Board that a party or parties to a pending case are engaged in a civil action ... 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." *See also* TBMP § 510.02(a) (2015).

Applicant filed its involved application Serial No. 79138965 for the mark EMERSON TECHNIK and design for goods in International Classes 7 and 11 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1182960, which was issued on May 13, 2013. In a civil action styled *Emerson Electric Co. v. S.C. Ion Mos S.R.L.*, Case No. 31837/3/2014 (“the Romanian civil action”), filed in the Bucharest Tribunal, Civil Division, Opposer, among other things, seeks to cancel Applicant’s Romanian Registration No. 104588, upon which the international registration is based. Cancellation of the Romanian registration would result in the cancellation of the international registration. *See* World Intellectual Property Organization (“WIPO”), Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Article 6(3)-(4) (November 12, 2007); WIPO, Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, Rule 22 (January 1, 2015). If the international registration were cancelled, any extension of protection to the United States based on that registration would be cancelled.¹ *See* Trademark Act Section 70(a), 15 U.S.C. § 1141j(a). Based on the foregoing, the Board finds that the Romanian civil action may have a bearing upon this proceeding and that suspension under Trademark Rule 2.117(a) is therefore warranted.

¹ However, in the event of cancellation of that extension of protection, Applicant could file an application under Trademark Act Sections 1 or 44, 15 U.S.C. §§ 1051 or 1126, “for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration.” Trademark Act Section 70(c), 15 U.S.C. § 1141j(c).

Proceedings herein are suspended pending final determination, including any appeals or remands, of the Romanian civil action. The Board will make annual inquiry concerning the status of the Romanian civil action. Within twenty days of the final determination of the Romanian civil action, Opposer shall notify the Board so that appropriate action may be taken in this case. The parties shall keep their correspondence addresses current while this case is suspended.