

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Baxley

Mailed: July 11, 2003

Cancellation No. 92/041,792

Cross Creek Seed, Inc. &  
Coating Supply, Inc.

v.

F. W. Rickard Seeds, Inc.

**Andrew P. Baxley, Interlocutory Attorney:**

This case now comes up for consideration of respondent's motion (filed May 5, 2003) to suspend proceedings pending final determination of a civil action between respondent and petitioner Cross Creek Seed, Inc. ("Cross Creek").<sup>1</sup> The motion has been fully briefed.

In support of its motion, respondent contends that suspension is appropriate inasmuch as respondent is involved in federal litigation with Cross Creek and that such litigation will have a bearing on this proceeding.

In response, petitioners filed (on May 27, 2003) a motion for summary judgment on their pleaded claim of genericness and contend that, inasmuch as the motion for

---

<sup>1</sup> Respondent filed its motion to suspend in lieu of an answer. The civil action is styled *F.W. Rickard Seeds, Inc. v. Cross Creek Seeds, Inc.*, Case No. 1:02CV01004, filed November 20, 2002 in the United States District Court for the Middle District of North Carolina.

**Cancellation No. 41,792**

summary judgment is potentially dispositive of this case, the motion for summary judgment should be decided before the Board considers the issue of suspension for the civil action. Petitioners further contend that suspension is inappropriate inasmuch as petitioner Coating Supply, Inc. ("Coating") is not a party to the civil action at issue in the motion to suspend and is not in privity with Cross Creek.

Trademark Rule 2.117(b) allows the Board discretion to consider petitioners' motion for summary judgment before considering the issue of suspension. However, the Board elects not to exercise that discretion in this case.<sup>2</sup> See TBMP Section 510.02(a).

Under Trademark Rule 2.117(a), whenever 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

---

<sup>2</sup> Petitioner's contention that it is standard practice for the Board to decide potentially dispositive motions before deciding motions to suspend is not well-taken. All but one of the cases upon which petitioners rely in support of this contention are based on an earlier version of Trademark Rule 2.117(b), which had required the Board to decide potentially dispositive motions before considering motions to suspend. Rule 2.117(b) was amended in 1983 to allow the Board discretion to suspend without first deciding the potentially dispositive motion. See Notice of Final Rulemaking, 48 Fed. Reg. 23122, 23129 (May 23, 1983). The remaining case upon which petitioners rely, *General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992), is inapposite inasmuch judgment had been entered in that proceeding when the potentially dispositive motion (one for relief from such judgment under Fed. R. Civ. P. 60(b)) and a motion to suspend were pending.

**Cancellation No. 41,792**

suspended until termination of the civil action.<sup>3</sup> After a thorough review of the complaint in the civil action, the Board finds that suspension of this case is appropriate because the civil action clearly has a bearing on this proceeding.

In particular, to prevail in the district court on its claim of unfair competition, respondent must prove the existence of its trademark rights in the K 326 mark. Thus, if the district court finds that such rights exist, the court's findings will have a bearing on petitioners' claims of genericness and fraud in this proceeding. More importantly, those findings would be binding upon the Board. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn 1986); *Other Telephone Co. v. National Telephone Co.*, 181 USPQ 79 (Comm'r Pats. 1974); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971). In short, the Board finds that these considerations outweigh the fact that a potentially dispositive motion is pending

---

<sup>3</sup> Petitioners' contends that suspension is improper because Coating is not a party to the civil action upon which respondent has based its motion to suspend and that, accordingly, the civil action is not dispositive of this proceeding with regard to Coating. Trademark Rule 2.117(a), however, was amended in 1998 and now requires only that the civil action in which a party or parties to the Board proceeding are engaged may have a bearing on the Board proceeding for suspension to be appropriate. See Notice of Final Rulemaking, 63 Fed. Reg. 48081, 48083 (September 9, 1998).

**Cancellation No. 41,792**

before the Board, that Coating is not a party to the civil action, and that Coating and Cross Creek are not in privity.

Therefore, in the interest of judicial economy and, consistent with the Board's inherent authority to schedule its proceedings, to avoid duplicating the effort of the district court and the possibility of reaching an inconsistent conclusion, respondent's motion to suspend this proceeding pending final determination, (i.e., following the termination of any and all appeals and remands), of Civil Action No. Case No. 1:02CV01004 is hereby granted. See Trademark Rule 2.117.

Accordingly, proceedings herein are **suspended** indefinitely, pending final determination of Civil Action No. Case No. 1:02CV01004.<sup>4</sup>

Bi-annual inquiry may be made as to the status of the civil action. Within twenty days after the final determination of the civil action, i.e., including any appeals and remands, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be

---

<sup>4</sup> The Board defers consideration of petitioners' motion for summary judgment and respondent's motion (filed June 16, 2003) to take discovery under Fed. R. Civ. P. 56(f) until proceedings are resumed. If and when proceedings herein are resumed, the Board will decide respondent's motion for Rule 56(f) discovery and reset time to respond to petitioners' motion for summary judgment.

**Cancellation No. 41,792**

notified of any address changes for the parties or their attorneys.