

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
**Trademark Trial and Appeal Board**  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Mailed: September 2, 2004

Cancellation No. 92043502

WEB TRACKING, LLC<sup>1</sup>

v.

Huntana LLC and Webstat.com  
LLC (joined as party  
defendant)<sup>2</sup>

Cindy B. Greenbaum, Attorney:

This case now comes up on respondents' motion, filed August 13, 2004, to suspend this cancellation proceeding pending the final determination of a civil action styled Webstat.com, LLC v. Web Tracking Services LLC, filed in the United States District Court for the District of Utah,

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<sup>1</sup> It appears that petitioner mistakenly identified itself in the Board proceeding as Web Tracking, LLC. Petitioner's correct name appears to be Web Tracking Services, LLC, as noted in petitioner's response to the motion to suspend, and petitioner's summary judgment motion.

<sup>2</sup> Webstat.com recorded the assignment at Reel 2686, Frame 0433 on March 4, 2003, and again at Reel 2728, Frame 0686 on April 16, 2003. Inasmuch as petitioner filed the petition to cancel on July 8, 2004, the Board may substitute Webstat.com for Huntana as party defendant. However, in light of the grounds for cancellation, the Board instead joins Webstat.com as a party defendant to facilitate discovery. See authorities cited in TBMP S512.01.

Central Division, Civil Case No. 2:03-CV-977 PGC. The Board notes petitioner's opposition to the motion to suspend.<sup>3</sup>

In support of the motion to suspend, respondents submitted (i) a copy of the complaint in the civil action, (ii) a motion to dismiss, and (iii) the District Court's order denying the motion to dismiss, in part, converting the issues remaining therein to a motion for summary judgment, and allowing the parties until September 15, 2004 to conduct limited discovery and to submit their discovery findings to the court.

Respondents' motion for suspension of the Board proceedings is granted as well taken. It is the policy of the Board 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.<sup>4</sup> See Trademark Rule 2.117(a).

A review of the complaint, motion to dismiss, and court order in the civil case indicates that a decision by the

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<sup>3</sup> The Board also notes petitioner's concurrently filed summary judgment motion. Neither the response nor the summary judgment motion includes a certificate of service of a copy thereof on counsel for respondents.

<sup>4</sup> Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board, whereas the Board decision is merely advisory to the district court. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Further, Board decisions are appealable to the district court. See Section 21 of the Trademark Act, and *Goya Foods, Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, at 1953 (2d Cir. 1988).

district court could be dispositive of, or have a bearing on, the issues in this cancellation proceeding.

Accordingly, proceedings are suspended pending final disposition of the civil action noted above.

In view thereof, the parties' stipulation to extend respondents' time to file an answer or other response to the petition to cancel is moot.

Notwithstanding the suspended status of this proceeding, petitioner is allowed until THIRTY DAYS from the mailing date of this order to (i) file with the Board proof that petitioner served on counsel for respondents a copy of petitioner's response to respondents' motion to suspend and petitioner's summary judgment,<sup>5</sup> and (ii) clarify its proper name. If there has been a change of name, petitioner must provide to the Board appropriate evidence thereof; if there has been no change of name, and petitioner simply made a typographical error in the case caption of the petition to cancel, thereby misidentifying itself, petitioner must so inform the Board.

Within twenty days after the final determination of the civil action, 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 notified of any address changes for the parties or their attorneys.

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<sup>5</sup> Petitioner is advised that the Board may not consider any future filings from petitioner that do not comply with Trademark Rule 2.119.