

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

FSW/kk

Mailed: February 27, 2007

Cancellation No. 92046853

STEPHEN SLESINGER, INC.

v.

DISNEY ENTERPRISES, INC.

Frances S. Wolfson, Interlocutory Attorney:

On February 2, 2007, respondent filed a motion to suspend proceedings pending the outcome of a civil action between the parties.¹ Petitioner has filed a response to the motion.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties

¹ Case No. CV-02-08508 FMC, pending before the U.S. District Court for the Central District of California.

in the Board case. See *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

After careful review of the record, including petitioner's "Fourth Amended Answer and Counterclaims" (filed by petitioner as defendant in the civil suit), it is determined that suspension is appropriate. Petitioner seeks a "declaration" from the Court to "correct the title" to any registrations that it believes respondent has obtained improperly. Inasmuch as petitioner believes respondent obtained the registrations that are the subject of this Board proceeding improperly, the final disposition of petitioner's request for such declaration from the Court is likely to have a bearing on the Board proceeding. Moreover, a decision of a federal district court is binding upon the parties in a Board proceeding, whereas a decision of the Board is not binding. The non-prevailing party in a Board proceeding may then bring a civil action in a district court pursuant to 15 U.S.C. § 1071(b), and receive a *trial de novo* on the exact same issue decided by the Board. See, for example, *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988); and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208 (D. Minn. 1986).

In view thereof, judicial economy is best served by allowing the civil action to proceed and suspending the Board case until final disposition of the civil action.

Accordingly, proceedings are suspended pending final disposition of the civil action between the parties.² The Board may make biannual inquiry as to the status of the civil action. If, however, the case is resolved, the parties 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.

² In view thereof, respondent's motion (filed February 19, 2007) is moot. Upon resumption of proceedings, respondent will be allowed additional time to file its answer, and discovery and trial dates will be reset.