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

Mailed: February 12, 2009

Cancellation No. 92048480

Sinbad Grand Cafe, LLC

v.

AL-FAKHER FOR TOBACCO
TRADING & AGENCIES CO. LTD.
CORPORATION

Jennifer Krisp, Interlocutory Attorney:

On December 18, 2008, the Board issued an order (1) noting petitioner's motion (filed December 2, 2008) for sanctions, and (2) directing the parties to file a status report with respect to a pending civil action involving the subject mark. On January 17, 2009, petitioner filed a response, and on February 2, 2009, registrant filed a response.[1] The parties' responses indicate that the issue of whether it is appropriate for the Board to suspend this cancellation proceeding pending final determination of a civil action involving the subject mark is contested.

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[1] Registrant's response to the Board is untimely. Nevertheless, the Board has exercised its discretion in considering registrant's response in resolving the issue before it.

Accordingly, this proceeding is now before the Board for consideration of the issue of suspension of this proceeding pending final determination of a civil action pending before the United States District Court for the Central District of California, Case 2:07-cv-06104-DSF-CT, captioned *Sierra Network Inc. v. Akram Allos et al.* ("civil action").[2]

On February 10, 2009 the Board convened a telephone conference to resolve the issue presented.[3] Participating were petitioner's counsel Natu J. Patel, registrant's counsel Christopher Q. Pham, and the assigned Interlocutory Attorney.

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. *See* Trademark Rule 2.117(a); *see also* TBMP § 510.02(a) (2d ed. rev. 2004). 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 is often binding on the Board, while the Board decision is not

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[2] The parties submitted a copy of the second amended complaint, and answer thereto and counterclaim, which were filed in the civil action pending in the U.S. District Court for the Central District of California.

binding upon or is merely advisory to the district court. *See American Bakeries Co. v. Pan-O-Gold Baking Co.,* 650 F.Supp 563, 2 USPQ2d 1208 (D.Minn. 1986). Further, the Board may, in its discretion, suspend a proceeding pending final determination of a proceeding in which only one of the parties is involved. *See* TBMP § 510.02(a) (2d ed. rev. 2004). Finally, 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, 1953 (2d Cir. 1988).

A review of the pleadings in the civil action indicates that certain findings made by the U.S. District Court in the referenced civil action could have a bearing on the cancellation proceeding before the Board inasmuch as they involve or could involve common issues of law or findings of fact.

Accordingly, this cancellation proceeding is suspended pending final disposition of the above-referenced civil action between the parties.[4] Within twenty (20) days after

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[3] The Board may, upon its initiative, resolve a motion filed in an *inter partes* proceeding by telephone conference. Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004).

[4] It is noted that the Board's October 28, 2008 order reset the close of discovery to March 27, 2009, but did not include a resetting of the following pertinent dates: plaintiff's pretrial disclosures, defendant's pretrial disclosures, and plaintiff's rebuttal disclosures. It is further noted that registrant's

final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action.[5]

The Board will consider the motion for sanctions, as appropriate, at such time as proceedings are resumed.

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on

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January 9, 2009 form motion, "motion for an extension of answer or discovery or trial periods with consent" appears to have inappropriately requested a resetting of dates which had already passed, namely, registrant's time to answer, deadline for discovery conference, opening of discovery, initial disclosures, and expert disclosures. Moreover, registrant filed, on January 9, 2009, a "correction" of its earlier-filed motion to extend time, such correction addressing the issue of petitioner's counsel's lack of actual consent to said motion for an extension. Inasmuch as the Board has found it appropriate to suspend this proceeding pending final determination in a pending civil action, the Board will reset all dates pertinent to this proceeding, as appropriate, at such time as proceedings herein are resumed.

[5] A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e. a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. *See* TBMP § 510.02(b)(2d ed. rev. 2004).

the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm