

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

FSW/rk

Mailed: September 10, 2009

Cancellation No. 92051033

Brunson Instrument Company

v.

Hubbs Machine & Manufacturing  
Inc.

**Frances S. Wolfson, Interlocutory Attorney:**

On September 3, 2009, the Board held a telephone conference to hear argument and rule on respondent's motion (filed July 8, 2009) to suspend the current proceeding in favor of a civil action between the parties (Hubbs Machine & Manufacturing, Inc. v. Brunson Instrument Co., Case No. 4:09-cv-00701, pending in the U.S. District Court for the Eastern District of Missouri) ("Federal Case") or, alternatively, to dismiss the proceeding for failure to state a claim. The motion is fully briefed. Rebecca Stroder, Esq. appeared as counsel for petitioner and Paul Denk, Esq. and Charles McCloskey, Esq. appeared as counsel for respondent. Participating for the Board were interlocutory attorneys Richard Kim and Frances Wolfson.

**Background**

Respondent owns Registration No. 3531432 for the mark SM in stylized form for "surveying laser tracker target mount used to hold in place a spherical mounted retro reflector and a theodolite sphere or photogrammetry sphere" (the "Registration").<sup>1</sup> Petitioner filed a petition for cancellation on May 29, 2009, alleging descriptiveness under Section 2(e)(1) of the Trademark Act, genericness under Section 23, functionality under Section 2(e)(5) and fraud in the procurement of the Registration.

**The Parties' Positions**

In support of its motion to suspend, respondent argues that respondent and petitioner "are both parties to a civil action currently pending in the U.S. District Court, Eastern District of Missouri, involving the identical mark at issue in this cancellation proceeding." Respondent's Motion to Suspend Pending the Outcome of Another Proceeding filed July 8, 2009 (the "Motion"), p. 3.

In opposition to the motion, petitioner essentially argues that the pleaded claim of fraud in the procurement of a federal registration "involves a matter of PTO procedure" and, as such, "the TTAB is in a better position than is the [district] court to determine matters of PTO procedure" and

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<sup>1</sup> Issued November 11, 2008.

"[f]or that reason alone, this proceeding should not be suspended or dismissed." Petitioner's Response to Respondent's Motion to Suspend filed July 28, 2009 (the "Response"), pp. 1, 3.

In its reply, respondent asserts that "both the TTAB and the [district] court may decide issues of fraud, that judicial economy will be served by the TTAB's suspension of cancellation proceedings" and that "[r]egardless of the outcome of the cancellation proceeding, several issues, including infringement and unfair competition, call for a decision by the district court." Respondent's Reply to Petitioner's Response to Respondent's Motion to Suspend filed August 17, 2009 (the "Reply"), p. 3.

The parties elaborated on their positions during the phone conference. The Board has carefully reviewed the parties' arguments and submissions.

**Decision**

The Board's well-settled policy is 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. Trademark Rule 2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB 1992). Respondent noted and petitioner confirmed that the grounds that form the basis of the current proceeding are the same grounds put forth by petitioner as defenses in the

Federal Case. Therefore, it cannot be disputed that the civil action will, at the very least, have a bearing on the current Board proceeding.

Moreover, the courts are not unfamiliar with issues of fraud, including allegations of fraud on the USPTO. See, e.g., Pony Exp. Courier Corp. of America v. Pony Exp. Delivery Service, 872 F.2d 317 (9<sup>th</sup> Cir. 1989); San Juan Products, Inc. v. San Juan Pools of Kansas, Inc., 849 F.2d 468 (10<sup>th</sup> Cir. 1988); 3M Co. v. Intertape Polymer Group, Inc., 423 F.Supp.2d 958 (D. Minn. 2006). The doctrine of primary jurisdiction does not apply in this case to change the result.

Therefore, suspension is appropriate and respondent's motion to suspend is hereby **GRANTED**.<sup>2</sup> Proceedings are suspended pending final disposition of the Federal Case. Within **TWENTY DAYS** after the final determination of the Federal Case, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the Board shall be notified of any address changes for the parties or their attorneys.

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<sup>2</sup> Since the motion to dismiss is made in the alternative, in view of the grant of the motion to suspend, the motion to dismiss has not been considered.