

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: July 20, 2009

Opposition No. 91186718
Opposition No. 91186723
Opposition No. 91187785
Cancellation No. 92050878
Cancellation No. 92051101

Pennington Seed, Inc. and
Pennington Seed, Inc. of
Nebraska

v.

OMS Investments, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on OMS Investments, Inc.'s (hereafter, OMS) motion to suspend this proceeding pending the disposition of the civil litigation between the parties. No response thereto was filed by opposers.¹

Before turning to that motion, the Board addresses the issue of consolidation. In its May 28, 2009 order the Board consolidated the oppositions to OMS' WATER SMART marks and noted Pennington Seed, Inc. and Pennington Seed, Inc. of Nebraska's (PS) recent filing of a petition to

¹ Opposer did provide the Board with notice of the related proceeding.

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cancel OMS' Registration No. 3477872 for the mark WATER SMART. On June 15, 2009, PS filed a petition to cancel OMS' Registration No. 3632062, also for the mark WATER SMART, which was instituted as Cancellation No. 92051101.

Inasmuch as the two cancellations involve the same WATER SMART term at issue in the oppositions, the Board sua sponte consolidates Cancellation Nos. 92050878 and 92051101 with this consolidated proceeding. With the exception for the need for a separate answer in each proceeding, papers addressing matters in any of the consolidated proceedings should be filed only in parent Opposition No. 91186718 and should include the caption listing each consolidated proceeding as shown at the top of this order.

OMS' motion to suspend is supported by a copy of the complaint filed in *OMS Investments, Inc. and The Scotts Company LLC v. Pennington Seed, Inc., Pennington Seed, Inc. of Nebraska, and Central Garden & Pet Company*, Case No. 2:09 CV 470, now pending in the United States District Court for the Southern District of Ohio, Eastern Division. In addition to involving the same parties, review of the complaint indicates that the civil action and this consolidated proceeding involve similar issues of law and fact. Specifically, OMS seeks, among other things, a declaratory judgment that it is entitled to use and

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register the WATER SMART marks which are the subject of the consolidated proceedings.

Accordingly, OMS' motion to suspend proceedings pending final disposition of the civil action between the parties is GRANTED.

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. Upon resumption of proceedings, OMS' time to file an answer to the petition to cancel in Cancellation No. 92051101 will be reset.

During the suspension period the Board should be notified 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 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>