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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051149
Party	Plaintiff Atwater Kent Manufacturing Company
Correspondence Address	Jason M. Drangel Epstein Drangel Bazerman & James, LLP 60 East 42nd Street, Suite 820 New York, NY 10165 UNITED STATES jdrangel@ipcounselors.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Dermot M. Sheridan
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Reg. No. 3,366,870
for the Trademark ATWATER KENT (Cls. 7 & 9), in
the name of Michael D. Leveillee d/b/a J.F. Sullivan Co. & Atwater Kent Manufacturing Company

ATWATER KENT MANUFACTURING COMPANY Petitioner, v. MICHAEL D. LEVEILLEE D/B/A J.F. SULLIVAN CO. & ATWATER KENT MANUFACTURING COMPANY Respondent.	Cancellation No. 92051149

MOTION FOR SUSPENSION OF PROCEEDING

Atwater Kent Manufacturing Company ("Petitioner"), pursuant to Trademark Act Rule 37 C.F.R. 2.117(a), requests that the instant cancellation proceeding involving the registration for ATWATER KENT, be suspended until a final determination of a civil action between the identical parties.

On February 2, 2011, Petitioner filed a complaint (Drangel Dec. ¶ 2, Exhibit 1) against Registrant in U.S. District Court for the District of Delaware, Civil Action No. CV-11-00110. A review of the complaint indicate that a decision by the district court will be dispositive on the issues in this proceeding. *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). The court action and this proceeding involve the identical parties, the ATWATER KENT mark at issue, and the same issues of fact and law.

WHEREFORE, based upon the reasons set forth herein and facts set forth in the Declaration of Jason M. Drangel, Petitionerr respectfully requests that the Board grant its motion to suspend this proceeding.

Respectfully submitted,

EPSTEIN DRANGEL LLP
Attorneys for Petitioner

Dated: 2/8/11

By:_____
Jason M. Drangel
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CERTIFICATE OF MAILING

I hereby certify that the foregoing Motion to Amend the Petition for Cancellation is being deposited on this 8th day of February, 2011 via the U.S.P.T.O's Electronic System for Trademark Trials and Appeals and by mail and e-mail to:

Peter Nils Baylor
Nutter McClennen & Fish LLP

World Trade Center West
155 Seaport Boulevard, Boston, MA 02210

By: _____
Jason M. Drangel

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DECLARATION OF JASON M. DRANGEL
IN SUPPORT OF PETITIONER'S MOTION FOR SUSPENSION OF PROCEEDINGS

JASON M. DRANGEL hereby declares as follows:

1. I am an attorney admitted to practice before the court of New York and with the U.S. Patent and Trademark Office. I am Petitioner's counsel in the present opposition proceeding. As such, I am fully familiar with the activities in this, and other pending litigation between the parties to date. I make this declaration from my own personal knowledge in support of Petitioner's Motion For Suspension of Proceeding.

2. On February 2, 2011, Petitioner filed a complaint against Registrant, in U.S. District Court for the District of Delaware, Civil Action No. CV-11-00110. A copy of the Complaint accompanies this Declaration as Exhibit 1. The court action and this proceeding involve the identical parties, the ATWATER KENT mark at issue, and the same issues of fact and law.

4. The above statements are true and accurate under penalty of perjury under the laws of the United States.

Dated: February 8, 2011

By: _____
Jason M. Drangel

EXHIBIT 1

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ATWATER KENT MANUFACTURING COMPANY Plaintiff, v. MICHAEL D. LEVEILLEE D/B/A J.F. SULLIVAN CO. & ATWATER KENT MANUFACTURING COMPANY Defendants.	C.A. No. _____ **JURY TRIAL DEMANDED**

COMPLAINT

Atwater Kent Manufacturing Company ("Plaintiff"), by its attorneys complaining of Defendant, Michael D. Leveillee, is an individual and citizen of the United States and is d/b/a J.F. Sullivan Co. & Atwater Kent Manufacturing Company, on knowledge as to Plaintiff, and otherwise upon information and belief, alleges as follows:

NATURE OF THE ACTION, JURISDICTION, AND VENUE

1. Defendants have undertaken a course of conduct to intentionally copy and use Plaintiff's corporate name, service mark, trade name and name of the former founder, ATWATER KENT and ATWATER KENT MANUFACTURING CO. in order to offer the same goods and services that Plaintiff is best known. These acts include maintaining a website using Plaintiff's corporate name, service mark and trade name as a domain name (ATWATERKENTMFG.COM), and connecting,

linking or re-directing consumers to Defendant's various web pages where consumers can purchase goods/services, all with full knowledge of Plaintiff's corporate name, service mark and trade name rights.

2. This is an action for false designation of origin and false description pursuant to 15 U.S.C. § 1125; violation of the Anticybersquatting Consumer Protection Act (15 U.S.C. § 1125(d)); and for related claims under Delaware State law of trade name infringement, initial interest confusion and unfair competition. For the federal, state and common law wrongs alleged in the Complaint, Plaintiff seeks injunctive relief, an accounting, compensatory damages, trebling of the accounting and/or compensatory damages, punitive damages, attorney's fees and costs, as authorized by the federal Trademark Act of 1946, as amended, and the applicable state statutory and common law.

3. The Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331, 1338 and 1367. The Defendants are subject to personal jurisdiction in this District in that they transact or otherwise conduct business nationwide, including in Delaware.

4. Venue is proper in this District pursuant to 28 U.S.C. §§1391.

THE PARTIES

5. Plaintiff, Atwater Kent Manufacturing Company ("Plaintiff"), is a Delaware company, with a business address of 101 Springer Building, 3411 Silverside Road, Wilmington, DE 19810.

6. Defendant, Michael D. Leveillee, is an individual and citizen of the United States and is d/b/a J.F. Sullivan Co. & Atwater Kent Manufacturing Company with a business address of 12 Jacques Street, Worcester, Massachusetts 01603-1926 ("Defendant").

PLAINTIFF'S HISTORY

7. Plaintiff is a Delaware company founded in 1919 and run by Arthur Atwater Kent ("Atwater Kent"). Atwater Kent invented the closely timed ignition system, and operated the world's largest radio factory in Pennsylvania.

8. Atwater Kent was always interested in automobiles and, particularly, in the means of igniting internal combustion engines. He patented the contactor, a breaker point mechanism, and the distributor to enable the use of a single coil. Income from his ignition systems enabled Atwater Kent to enter the radio business with a fully equipped manufacturing facility.

9. Atwater Kent was also very careful to defend its reputation. Plaintiff's radios were of very high quality and reliability with strong customer appeal.

10. By the 1930s, Plaintiff released a new cycle of approximately 15 radio models each year. In the middle thirties, Atwater Kent recognized the changing market for radio receivers. His business was based on moderately priced consoles with a tolerance for high-quality table models. However, he did not accept the market for cheap sets and preferred to stop selling radios rather than compromise his name and reputation.

11. ATWATER KENT products have become collector's items and are often for sale and re-sale at auction and on websites such as Ebay.

12. In 1936, Atwater Kent closed the factory and moved to California where he spent a well earned retirement until his illness and death in 1949.

13. Plaintiff has always used the Atwater Kent Manufacturing Company corporate name and trade name to identify its goods and services. Plaintiff is now owned and run by the descendants of Atwater Kent.

14. Plaintiff exists for a number of reasons, including, most notably to protect the history and good name of the Plaintiff and its founder Atwater Kent.

DEFENDANTS' CONDUCT

15. Defendant is conducting business under the trade name Atwater Kent Manufacturing Company using the domain name ATWATERKENTMFG.COM where it hosts an active website ("Website").

16. On its Website, Defendant makes/has made false claims to both an association with both Atwater Kent himself, and Defendant. For instance, at one time, Defendant claimed on its website that "originally founded in 1895, we still hand-craft specific items for your automotive or radio collection." Defendant also provided a complete history of the founder (including photos) and the company.

17. On its Website, Defendant claims to manufacture and sell radio and automotive parts as did Plaintiff and Atwater Kent.

18. On February 26, 2002, Defendant filed a U.S. trademark application for ATWATER KENT for goods in Class 9, with the Defendant herein identified as the owner of the trademark. The registration issued on May 17, 2005 as Reg. No. 2,952,925. This registration has been cancelled.

19. On November 23, 2005, Defendant filed a U.S. trademark application for ATWATER KENT for goods in Class 7 & 9, with the Defendant herein identified as the owner of the trademark. The registration issued on January 8, 2008 as Reg. No. 3,366,870. Plaintiff has moved to cancel this registration.

20. On July 7, 2009, Defendant filed a U.S. trademark application for ATWATER KENT for goods in Class 9, with the Defendant herein identified as the owner of the trademark. The

registration issued on August 31, 2010 as Reg. No. 3,839,998. Plaintiff intends to move to cancel this registration in due course.

21. Defendant is neither the owner nor exclusive licensee of ATWATER KENT trademark or trade name.

22. Defendant was not and is not authorised to register a trademark containing Atwater Kent's name.

23. Defendant applied to register the trademark ATWATER KENT without authorization to do so. If the trademarks were to be registered at all, they should have been registered in the name of the Plaintiff, the owner of the Atwater Kent trademark, and Atwater Kent Manufacturing Company corporate and trade name.

24. Defendant knew, at the time it filed its trademark applications that the ATWATER KENT trademark rights ultimately lie with the beneficiary/assignees of the estate of Atwater Kent.

25. Defendant applied to register the trademark ATWATER KENT with knowledge that it did not own or have the exclusive right to use said mark in commerce.

DAMAGES COMMON TO ALL CLAIMS

26. Defendants' wrongful conduct has deprived Plaintiff of goodwill and injured its relationship with its customers.

27. As a result of Defendants' conduct, Plaintiff is suffering, and will continue to suffer irreparable harm and damage. Defendants will, unless restrained and enjoined, continue to act in the unlawful manner complained of herein, to Plaintiff's irreparable injury. Plaintiff's remedy at law is not adequate to compensate for the injuries suffered and threatened.

28. By reason of Defendants' acts complained of herein, Plaintiff has suffered and continues to suffer monetary damages in an amount thus far not determined.

FIRST CLAIM FOR RELIEF

(False Designation of Origin and False Description)

29. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

30. This association is unauthorized and likely to cause confusion and mislead consumers in the marketplace as to the authenticity and reliability of goods originating from Defendant.

31. This association is unauthorized and likely to cause confusion and mislead consumers in the marketplace as to the source of goods originating from a Defendant's nearly identical trade name as used by Plaintiff.

32. Defendant's registrations of ATWATER KENT falsely suggests a connection with and/or brings into disrepute the name, trademark, trade name, corporate name and identity of Atwater Kent and Plaintiff.

33. Defendant's unauthorized registration of ATWATER KENT interferes with Plaintiff's right to use, register and license the ATWATER KENT trademark, corporate name and trade name.

34. Defendant is using the ATWATER KENT trademark to misrepresent the source of the goods/services in connection with which the ATWATER KENT mark is used. Defendant has deliberately sought to pass off its goods as those of Plaintiff on its website, and in advertising and promotions indicating an association with the founder Atwater Kent and Plaintiff itself.

35. By reason of the foregoing acts, Defendants are in violation of 15 U.S.C. §1125(a) in that Defendants' unauthorized use of the Plaintiff's service mark constitutes false designation of origin

and a false or misleading description or representation of facts which are likely to cause confusion, to cause mistake, and/or to deceive.

SECOND CLAIM FOR RELIEF

(Cyberpiracy)

36. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

37. With a bad faith intent to profit therefrom, Defendant registered and is presently using the domain name ATWATERKENTMFG.COM which is almost identical and confusingly similar to Plaintiff's Atwater Kent Manufacturing Company corporate name, service mark and trade name.

38. Defendant's aforesaid acts constitute cyberpiracy of Plaintiff's Atwater Kent Manufacturing Company corporate name, service mark and trade name, in violation of Section 43(d)(1) of the Federal Trademark Act, 15 U.S.C. § 1125(d)(1).

THIRD CLAIM FOR RELIEF

(Initial Interest Confusion)

39. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

40. Consumers looking for Plaintiff's website are drawn instead to Defendant's Website.

41. Defendants' aforesaid acts constitute initial interest confusion under the common law of the State of Delaware.

FOURTH CLAIM FOR RELIEF

(Common Law Unfair Competition)

42. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

43. Defendants' acts constitute unfair competition under the common law of the State of Delaware.

FIFTH CLAIM FOR RELIEF

(Common Law Trade Name Infringement)

44. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

45. Defendants' acts constitute trade name infringement under the common law of the State of Delaware.

SIXTH CLAIM FOR RELIEF

(Violation of Delaware Consumer Fraud Act, 6 Del. C. § 2511 *et seq.*)

46. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

47. The State of Delaware has an important interest in ensuring that persons and entities doing business with Delaware residents comply with Delaware law and the false and misleading statements of defendants implicate the public interests.

48. Defendants' false and misleading advertising and promotional statement are material to consumer purchasing decisions and have caused and are likely to continue to cause consumer confusion in Delaware.

49. The conduct complained of herein constitutes unlawful consumer fraud deceptive trade practices, in violation of Delaware Consumer Fraud Act, 6 Del. C. § 2511 *et seq.*

50. Defendants' conduct as aforesaid has caused great and irreparable injury to plaintiffs, and unless such conduct is enjoined, it will continue and plaintiffs will continue to suffer great and irreparable injury.

SEVENTH CLAIM FOR RELIEF

(Violation of Delaware Uniform Deceptive Trade Practices Act, 6 Del. C § 2531 *et seq.*)

51. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 28 of this Complaint.

52. The State of Delaware has an important interest in ensuring that persons and entities doing business with Delaware residents comply with Delaware law and the false and misleading statements of Defendant implicate the public interest.

53. Defendant's false and misleading advertising and promotional statements are material to consumer purchasing decisions and have caused and are likely to continue to cause consumer confusion.

54. Upon information and belief, defendants have knowingly disparaged Plaintiff's business by false and/or misleading representation of fact, and knowingly created a likelihood of confusion and/or misunderstanding among plaintiffs' and defendants' consumers.

55. The conduct complained of herein constitutes deceptive trade practices, in violation of the Delaware Uniform Deceptive Trade Practices Act, 6 Del. C § 2531 *et seq.*

56. Defendant's conduct as aforesaid has caused great and irreparable injury to Plaintiff, and unless such conduct is enjoined, it will continue to plaintiffs will continue to suffer great and irreparable injury. Plaintiffs have no adequate remedy at law.

WHEREFORE, Plaintiff requests that this Court enter judgment:

1. Permanently enjoining Defendant, its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of the order by personal service or otherwise, from:
   (a) registering, using or displaying the trade name and service mark ATWATER KENT and ATWATER KENT MANUFACTURING CO alone or in combination with other words, letters, numbers or designs, or any mark confusingly similar to Plaintiff's corporate name, trade name and service mark, as a business name, corporate name, trademark or service mark, domain name or in any other manner other than when referring to Plaintiff;
   (b) stating or implying that Defendant is associated with Plaintiff;
2. Requiring Defendants to transfer ownership of the domain name ATWATERKENTMFG.COM to Plaintiff;
3. Cancelling Defendant's ATWATER KENT U.S. trademark registrations;
4. Requiring Defendant to account for, and pay to, Plaintiff any and all profits derived by it and all damages sustained by Plaintiff by reason of the acts complained of herein, and that the damages and profits be trebled;

5. Requiring Defendant to pay punitive damages to Plaintiff;

6. Requiring Defendant to pay to Plaintiff its costs and attorneys' fees along with prejudgment interest;

7. Ordering such other and further relief as this Court deems just and proper.

By: _____

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