

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

EJW

Mailed: April 7, 2010

Cancellation No. 92051847

Oxford 2005 Holdings, LLC

v.

Baney Corporation

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

Respondent's motion (filed March 2, 2010) to suspend this proceeding pending final determination of a civil action¹ between the parties is noted. Petitioner has not filed a response thereto.

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).

The Board notes that in the declaratory judgment complaint in the civil action plaintiff, respondent herein, asserts, *inter alia*, that there is no likelihood of confusion (§§ 60 and 61); that plaintiff's use of its marks would not

¹ Civil Case No. CV-10-06040-TC, entitled Baney Corporation (Plaintiff) v. Sage Hospitality Resources, Inc. and Oxford 2005 Holdings, LLC (Defendants), pending in the U.S. District Court, District of Oregon, Portland Division.

Cancellation No. 92051847

constitute false designation of origin (¶63); that such use would not cause dilution of the purported distinctive quality of defendants' trademarks or trade names (¶65); that, as between plaintiff and defendants, plaintiff is the senior user of the term OXFORD in connection with hotel services; and that plaintiff seeks an order enjoining defendants from maintaining the present cancellation action and requiring the USPTO to dismiss the cancellation proceeding with prejudice (prayer, ¶¶ 3 and 4).

In view of the foregoing, inasmuch as petitioner's claims in this proceeding are based on allegations of priority and likelihood of confusion, false suggestion of a connection, and dilution, said civil action may be dispositive of this proceeding. Suspension of this proceeding is therefore appropriate and respondent's motion is hereby granted as well taken. Accordingly, this proceeding is **SUSPENDED** pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.
