

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

Mailed: October 20, 2010

Cancellation No. 92051963

SYLVESTER STEWARD, pka SLY STONE,
dba SLY AND THE FAMILY STONE

v.

EVEN ST. PRODUCTIONS, LTD.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

This case now comes up on respondent's motion, filed June 14, 2010, to suspend proceedings pending disposition of a civil action between the parties.¹ Petitioner filed a response thereto.

In support of its motion, respondent argues that resolution of the issues in the state court action will have a bearing on the issues in the Board proceeding, particularly with respect to petitioner's ownership rights in the mark SLY AND THE FAMILY STONE.

In response, petitioner argues that suspension is not appropriate because he is not asking the state court to determine ownership. Instead, according to petitioner, the state court action concerns misappropriation of royalties due to petitioner while the Board proceeding seeks a determination of ownership, among other claims. Petitioner notes that he anticipates the state court action to be pending for a long time for various reasons, including that

the issues presented therein date back over twenty years, there are eighteen causes of action, and there are approximately twenty-eight parties. Petitioner states that the Board has the expertise to decide the claims stated in the petition to cancel. Petitioner expresses his opinion that respondent brought the motion to suspend to delay the cancellation proceeding.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of that civil action. Suspension may be ordered where the civil action is in state court, even though a state court decision, unlike a federal court decision, is not binding on the Board. See TBMP §510.02(a) (2d ed. rev. 2004). Nonetheless, specific findings of fact may be made in state court that may have a persuasive, if not a preclusive, effect on questions present in the Board proceeding.

The Board has reviewed the pleadings in the state court litigation. While the plaintiff therein has not asked for any direct determination to be made with respect to the ownership of the mark, at a minimum, his cause of action for unjust enrichment is based on an alleged misappropriation of petitioner's intellectual property, including the mark at issue herein;² and at least one of his fraud claims in the state court proceeding includes an

¹ *Sylvester Stewart, etal v. Gerald Goldstein, etal*, Case No. BC 430809 in the Superior Court of the State of California, County of Los Angeles.

allegation that defendants made intentional misrepresentations to the Court regarding the ownership of, among other things, the trademark.³ As to many other of the causes of action before the state court, although not directly asked, the court may very well make a determination of ownership of the mark in resolving the matters.

Accordingly, opposer's motion to suspend is granted. Proceedings are suspended pending final disposition of the civil action between the parties. A schedule for briefing and consideration of petitioner's motion to compel, filed July 6, 2010, is also stayed.

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. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

² See, for example, plaintiff's third cause of action in the first amended complaint, para. Nos. 150-152.

³ See, for example, plaintiff's seventh cause of action, para. No. 180. The Board notes that some of the individual defendants identified collectively as "Goldstein collaborators" are also identified as officers and directors of respondent. Para. Nos. 10 and 27 of the first amended complaint.