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

Baxley

Mailed: May 11, 2010

Cancellation No. 92052307

Austin Precision Products, Inc. d/b/a LaRue Tactical

v.

Richard E. Swan

Andrew P. Baxley, Interlocutory Attorney:

On May 4, 2010, respondent filed an unconsented motion to suspend this proceeding pending final determination of a civil action styled *Atlantic Research Marketing Systems, Inc. v. Austin Precision Products, Inc. d/b/a/ LaRue Tactical*, Case No. 1:09-cv-10034, filed in the United States District Court for the District of Massachusetts. In the interest of resolving such motion without undue delay, the Board determined that the motion should be resolved by telephone conference. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a) (2d ed. rev. 2004). On May 10, 2010, such conference was held between petitioner's attorney Gail Taylor Russell, respondent's attorney Stephen J. Holmes, and Board attorney Andrew P. Baxley.[1]

[1] Petitioner filed a brief in opposition to the motion to suspend on May 10, 2010, prior to the telephone conference.

In support of the motion, respondent contends that, in the counterclaim in the civil action, petitioner has alleged that involved Registration No. 3385512 is invalid because the registered matter does not does not function as a mark, is not inherently distinctive, and has not acquired distinctiveness. Accordingly, respondent contends that the civil action has a bearing upon this proceeding and that suspension is therefore warranted.

In opposition, petitioner contends that suspension is inappropriate because respondent is not a party to the civil action.

The Board generally suspends proceedings before it when any party to a pending Board proceeding is involved in a civil action which may have a bearing on the Board case. See Trademark Rule 2.117(a). The Board so suspends because, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *American Bakeries Co. v. Pan-O-Gold Baking Co.,* 2 USPQ2d 1208 (D.C. Minn. 1986).

Petitioner correctly notes that respondent is not a party to Case No. 1:09-cv-10034. Nonetheless, the fact that petitioner is a party both to that case and the above-

captioned proceeding is sufficient to warrant application of Rule 2.117(a).

Further, a review of the pleadings in Case No. 1:09-cv-10034 indicates petitioner's claims in the above-captioned proceeding that the registered matter does not function as a trademark and that the registered matter has not acquired distinctiveness are essentially identical to grounds set forth in its counterclaim in Case No. 1:09-cv-10034. As noted *supra*, the district court's findings with regard to those grounds will be binding upon the Board. Accordingly, the Board finds that Case No. 1:09-cv-10034 may have a bearing on this proceeding and that suspension of this proceeding pending final determination of Case No. 1:09-cv-10034 is therefore warranted.[2]

In view thereof, respondent’s motion to suspend is granted. Proceedings herein are suspended pending final determination, including any appeals or remands, of Case No. 1:09-cv-10034.

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[2] The Board notes that the parties are also involved in consolidated Cancellation Nos. 92052137 and 92052140, which were suspended in a May 4, 2010 order pending final determination of Case No. 1:09-cv-10034. The registered marks in the consolidated proceedings are configurations, whereas the the registered mark herein is #17 in standard character form. Because the the above-captioned proceeding and the consolidated proceedings involve different types of marks, the Board finds that consolidation of the above-captioned proceeding with the previously consolidated proceedings is unwarranted. See Fed. R. Civ. P. 42(a); TBMP Section 511.

The Board will make annual inquiry as to the status of Case No. 1:09-cv-10034. 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.