

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

Mailed: June 17, 2010

Cancellation No. 92052388

Pac-Dent International, Inc.

v.

Sulzer Mixpac AG

**Frances S. Wolfson, Interlocutory Attorney:**

Petitioner's motion (filed June 14, 2010) for default judgment is denied as premature. The fact that there is a pending contested motion to suspend for civil action is good cause for respondent's failure to file its answer herein. Moreover, petitioner will not be substantially prejudiced by the delay, as trial dates may be reset upon resumption of proceedings; and the Board is reluctant to enter a default judgment and tends to resolve any doubt in favor of the defendant. See *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990); TBMP §312.02 (2d ed. rev. 2004).

Turning to respondent's motion to suspend (filed June 7, 2010), the Board notes that defendants in the civil action (one of whom is petitioner herein) were ordered to appear on April 1, 2010 in the U.S. District Court for the

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Southern District of New York to show cause why they should not be permanently enjoined from "selling, offering for sale, distributing or advertising dental mixing tips that infringe the Mixpac Colored Dome Mark." Pending the hearing, petitioner was temporarily restrained from "selling, offering for sale, distributing or advertising dental mixing tips that infringe the Mixpac Colored Dome Mark."

Petitioner has filed a response to respondent's motion to suspend this proceeding pending final determination of the civil action. Petitioner argues that the civil action involves infringement, whereas the cancellation action involves registrability and respondent's entitlement to maintain its registration.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971). Moreover, to

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the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding, and a non-prevailing party in a Board proceeding may then bring a civil action in a district court pursuant to 15 U.S.C. § 1071(b), and then receive a *trial de novo* on the exact same issue decided by the Board. See, for example, *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988); and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208 (D. Minn. 1986).

In the instant case, petitioner's right to use the mark which forms the subject matter of Reg. No. 3762233 (i.e., a "colored dome mark" as described in the court order)<sup>1</sup> may have a bearing on the issues in the cancellation action. Petitioner alleges that it has standing to bring the cancellation action based on its practice of "offering for sale and selling mixing tips for use with dispensers of two-

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<sup>1</sup> The description of the mark in the registration reads as follows, and the color teal is claimed as a feature of the mark: "The mark consists of the color teal and the configuration of a futuristic, dome-façade tip having a smooth bottom portion, a slightly indented middle portion, an upper portion angled inwardly which narrows and restricts to a top portion that attaches to a transparent stem which encases a corkscrew like element. The dotted outline of the bottom tab and top tabs on the dome-façade tip, the slightly indented middle portion consisting of uniform continuous ridges, the stem and the corkscrew like element is intended to show position of the mark on the goods and is not part of the mark."

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part compositions for dental applications" including in the color "teal." *Petition to Cancel*, para. 1. Petitioner further alleges the existence of the civil action between the parties and that it will be damaged "by the existence on the register of [respondent's registration] as a result of said Civil Action." *Petition to Cancel*, para. 21.

In view thereof, suspension of these proceedings is appropriate. Accordingly, proceedings are 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 Board should be notified of any address changes for the parties or their attorneys.