

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

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Mailed: June 15, 2011

Cancellation No. 92053703

Royal Oak Enterprises, LLC

v.

Nature's Grilling Products
LLC dba NRG International
LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

This case now comes up on respondent's motion, filed April 4, 2011 to suspend this cancellation pending the disposition of the civil action between the parties. The motion is contested, and the Board held a phone conference on June 13, 2011. The participants were Andrew Crain, attorney for petitioner, David Pardue, attorney for respondent, and Elizabeth Dunn, attorney for the Board.¹

In its petition to cancel filed March 1, 2011, petitioner alleges priority of use and likelihood of confusion between subject Registration Nos. 3925901

¹ Attorney for respondent Barton Black also attended the conference.

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(NATURE'S GRILLING and design for charcoal briquettes) and 3221991 (NATURE'S MESQUITE for charcoal; wood chips for smoking and grilling) and its pleaded Registration No. 1450298 (NATURE-GLO for charcoal briquets, wood chips, grill wood and fire starting fiberboard).²

On August 10, 2010, petitioner filed a complaint against respondent with the United States District Court for the Northern District of Georgia, Atlanta Division (Royal Oak Enterprises, LLC v. Nature's Grilling Products LLC, Case No. 1:10-CV-0294-HTW). The complaint alleges, among other claims, trademark infringement of petitioner's registered NATURE-GLO mark by respondent's use of the mark NATURE'S GRILLING on related goods, and seeks, among other remedies, to enjoin respondent's use of the term NATURE'S GRILLING.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may

² During the conference the Board learned that on or about the time of the conference, respondent filed a paper notifying the Board of its efforts to obtain petitioner's consent to respondent's surrender of Registration No. 3221991 (NATURE'S MESQUITE) so as to give the Board "full information" about the current status of the case. The Board informed the parties that petitioner is under no obligation to consent to respondent's surrender and thus there is no need to apprise the Board of respondent's efforts to obtain such consent; that no further action will be taken with respect to this paper; and that Registration No. 3221991 remains part of this proceeding. The Board takes a dim view of such surprise filings, particularly when related to a pending motion in which briefing has closed.

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be dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). A Board proceeding conducted concurrently with a district court proceeding would require a duplication of effort by the parties and risk inconsistent results in two fora. Moreover, the Board's final decision would be merely advisory, and not binding in respect to the proceeding pending before the federal district court. *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971). In contrast, the federal court determination of a trademark issue normally has a binding effect in subsequent proceedings before the Board involving the same parties and issue. *Id.*; *In re Alfred Dunhill*, 224 USPQ 501, 503 (TTAB 1984); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §510.02 (3rd ed. 2011).

Because the complaint indicates that in the course of deciding the pleaded infringement claim the district court will address (i) the strength of petitioner's pleaded mark, a matter relevant to both registrations involved in this cancellation, and (ii) whether respondent may continue to use one of its registered marks, a matter which could be dispositive with respect to one registration involved in this cancellation, petitioner's motion to suspend

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proceedings pending the district court's resolution of the civil action is granted.

Within twenty days after the final determination of the civil action, plaintiff should notify the Board so that this case may be called up for appropriate action. During the suspension period, the parties promptly shall notify the Board in writing of any address changes for the parties or their attorneys, or if the parties become parties in another Board proceed or another civil action involving related marks or other issues of law or fact which overlap with this case.

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