

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

Mailed: November 14, 2013

Cancellation No. 92054629

Sheltered Wings, Inc.

v.

Wohali Outdoors, LLC

**George C. Pologeorgis,
Interlocutory Attorney:**

On November 13, 2013, petitioner filed a combined notification of a federal district court action in the United States District Court for the Western District of Wisconsin which involves the parties to this proceeding¹ and a response to respondent's motion (filed November 1, 2013) to suspend this case pending the final disposition between the parties in a state court action in Oklahoma. Petitioner included a copy of the federal district court pleading with its November 13, 2013, filing.

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).

¹ Case No.: 3-13-cv-00796, styled *Sheltered Wings, Inc. v. Wohali Outdoors, LLC*, filed on or about November 11, 2013.

The Board has carefully reviewed the civil action complaint filed by petitioner in the federal district court action. By way of its civil complaint, petitioner seeks, among other things, (1) a permanent injunction enjoining respondent, and all other persons participating or acting in concert with respondent, from use of any mark including the term “EAGLE,” and (2) the cancellation of respondent’s involved Registration No. 3904929 for the mark STEEL EAGLE.

Based upon the foregoing, we find that a decision by the federal district court would have a direct bearing on the issues in this cancellation proceeding.

The Board further notes that, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding (which the Board has found in this instance), the district court decision would be binding on the Board, whereas the Board decision is merely advisory to the district court. *See American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Further, Board decisions are appealable to the district court. *See* Section 21 of the Trademark Act, and *Goya Foods, Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1953 (2d Cir. 1988). Moreover, suspending this matter pending the final determination of the federal district court action will serve the interests of judicial economy.

In view of the foregoing, we find it appropriate to suspend this case. Accordingly, this cancellation proceeding is hereby **SUSPENDED** pending the final disposition of the federal district court action, including all appeals.

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.

In view of the suspension granted herein, respondent's motion (filed November 1, 2013) to suspend this case pending the final disposition of a state court action between the parties herein, as well as respondent's motion (filed November 12, 2013) to strike petitioner's notice of reliance and accompanying Trial Exhibits 17-18 and 25-29, are both **DENIED** without prejudice.

Upon the resumption of proceedings, if respondent believes its pending motions at the time of suspension and denied by this order without prejudice were not resolved or made moot, respondent may renew its motions by written request to the Board, citing the motion's title, date of filing, and docket entry in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the renewed motion was contested at the time of suspension and the non-moving party believes that its original response requires supplementation in view of events since suspension, the non-moving party

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has **FIFTEEN DAYS** from the date of service of the renewal of the motion to file a supplemental response.