

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

BUO

Mailed: August 26, 2014

Cancellation No. 92056574

Frank Clegg Leatherworks LLC

v.

El Group, LLC

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board is petitioner's motion, filed April 15, 2014, to suspend the proceeding pending final determination of a civil action between the parties. Petitioner asserts that the civil action filed in the Massachusetts Superior Court (case No. BRCV2014-0354C) ("the civil action") will have a bearing on the issues raised by this cancellation proceeding. Respondent contends this motion, asserting that, "this proceeding should not be suspended but, rather, it should be dismissed, and the parties should litigate their claims in state court." Respondent asserting a cross-motion to dismiss, argues that "the state court civil action will decide all of the issues in the instant proceeding," and that the proceeding should further be dismissed because petitioner "has fail[ed] to prosecute its claims [or] ... comply with its discovery obligations." These motions have been fully briefed.

Additionally, on June 25, 2014, respondent filed a motion to compel the appearance of petitioner's designated witnesses for a previously noticed deposition under Fed. R. Civ. P. 30(b)(6). That motion is noted.

Motion to Suspend

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 case before the Board. *See* Trademark Rule 2.117(a).

As grounds for cancellation petitioner asserts, *inter alia*, that: 1) petitioner has priority of use; 2) the continued registration of respondent's mark for International Class 18 goods would be inconsistent with petitioner's rights in its FRANK CLEGG marks; 3) petitioner is the exclusive owner in the United States of common law rights in the marks FRANK CLEGG, F. CLEGG and FRANK CLEGG LEATHERWORKS for briefcases; and 4) respondent failed to gain Frank Clegg's written consent to the registration of respondent's mark, and neither petitioner nor Frank Clegg consent to respondent's use or registration of respondent's mark or any other mark containing CLEGG for leather bags or related products or services.

In the civil action respondent (plaintiff in the civil action) has asserted eleven counts against petitioner, including counts involving federal trademark infringement of marks containing the term CLEGG and seeking to enjoin petitioner from use of the term CLEGG and marks containing the term. These counts appear to mirror several of the claims in this proceeding

and affect the subject mark and petitioner's pleaded property in this proceeding.

Respondent however, appears to misinterpret the rules governing suspension pending disposition of a civil action. Respondent's contention of this motion and the basis for its cross-motion to dismiss rests on the erroneous notion that disposition of the state court proceeding would "preclusively and finally" decide the instant proceeding. It is true that a state court proceeding may form the basis for a suspension of a Board proceeding pending its disposition. *See, e.g. Jet Inc. v. Sewage Aeration Sys.*, 55 USPQ2d 1854, 1859 (Fed. Cir. 2000); *Mother's Rest., Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1569, 221 USPQ 394, 397 (Fed. Cir. 1983); *see also Midland Coop., Inc. v. Midland Int'l Corp.*, 421 F.2d 754, 164 USPQ 579 (CCPA 1970). However, the state court does not have appellate review or authority to issue mandates to the Board as the federal courts are empowered to do. *Cf. TBMP* § 510.02(a) (2014); *The Other Tel. Co. v. Conn. Nat'l Tel. Co., Inc.*, 181 USPQ 779, 782 (Comm'r Pat. 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

Therefore, notwithstanding the determination of the state court, the Board is not bound to follow its determination, but may nonetheless utilize the court's findings in the determination of this cancellation proceeding. In fact, it is within the Board's sole discretion to decide the feasibility of moving

forward with a proceeding in light of issues set forth in complaint in civil action. *The Other Tel. Co.*, 181 USPQ at 782.

Furthermore, even where it is clear that the determination of a civil case would have a direct bearing or be ultimately dispositive of the Board's proceeding (even if tried before a federal court), this does not render our proceeding moot, or warrant a dismissal as proposed by respondent. Indeed, the court before which a civil action is pending may elect to suspend the civil action to await determination of the Board proceeding, and if the Board is so advised, the Board will go forward with its proceeding. Thus, a dismissal of our proceeding at this point would be inappropriate.

In any event, the requirement is not that the civil action be dispositive, or binding on the Board, but that the determination of issues in the civil action *may* have a bearing on the Board proceeding.

Inasmuch as the determination of the issues presented before the state court, particularly as it pertains to infringement and any injunction that may be imposed, may inform the Board's decision in this proceeding, suspension of this proceeding appears appropriate.

Accordingly, respondent's motion to dismiss is **DENIED**; and petitioner's motion to suspend is **GRANTED** and proceedings are suspended pending final disposition of the civil action between the parties.

Motion to Compel

In view of the suspension of this proceeding, respondent's motion to compel is **DENIED** without prejudice.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board in writing, including a copy of the court's final order.

If respondent believes its motion pending at the time of suspension and denied by this order was not resolved or made moot by the civil action, respondent may renew the motion by citing its 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 petitioner believes that its original response requires supplementation in view of events since suspension, petitioner is allowed **FIFTEEN DAYS** from the date of service of the renewal of the motion to file a supplemental response.

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.