

ESTTA Tracking number: **ESTTA595175**

Filing date: **03/27/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057116
Party	Plaintiff Westheimer Corporation
Correspondence Address	RONALD S BIENSTOCK BIENSTOCK & MICHAEL PC 411 HACKENSACK AVENUE, CONTINENTAL PLAZA 7TH FLOOR HACKENSACK, NJ 07601 UNITED STATES ip@musicesq.com
Submission	Other Motions/Papers
Filer's Name	Brent M. Davis, Esq.
Filer's e-mail	bdavis@musicesq.com, ip@musicesq.com
Signature	/Brent M. Davis/
Date	03/27/2014
Attachments	Opp_Mot_Suspend.pdf(22244 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

**In the Matter of Trademark Registration No. 3,986,754**  
**Registered on June 28, 2011**

_____	)	
<b>WESTHEIMER CORPORATION</b>	)	
	)	
<b>Petitioner,</b>	)	
	)	<b>Cancellation No. 92057116</b>
<b>v.</b>	)	
	)	<b>Registration No. 3,986,754</b>
<b>DARRYL D. AGLER</b>	)	
	)	
	)	
<b>Registrant.</b>	)	
_____	)	

**WESTHEIMER CORPORATION’S OPPOSITION TO**  
**REGISTRANT’S MOTION TO SUSPEND PROCEEDINGS**

Petitioner Westheimer Corporation (“Petitioner”) respectfully submits this Memorandum of Law in Opposition to Registrant Darryl D. Agler’s (“Registrant”) Motion to Suspend Proceedings (the “Motion”). The Motion should be denied in its entirety because the action pending in the United States District Court for the Northern District of Indiana will have *no* bearing on the outcome of the above-captioned cancellation proceeding (the “Proceeding”) and the Motion is being brought in bad faith.

**STATEMENT OF FACTS**

Petitioner initiated the Proceeding on April 25, 2013 for cancellation of Registrant’s registration for the mark STRATOTONE (the “Mark”). Declaration of Brent M. Davis, Esq. (“Davis Decl.”) at ¶ 5. Discovery closed on January 4, 2014. Id. at ¶ 6. On March 4, 2014, Petitioner served Registrant with Notice of Deposition, with the deposition to take place on

March 15, 2014. Id. at ¶ 7. Petitioner’s Testimony Period opened on March 5, 2014. Id. at ¶ 8. On Friday, March 7, 2014, Registrant’s counsel requested an adjournment of the deposition. Id. at ¶ 9. The deposition was rescheduled for March 31, 2014. Id. at ¶ 10.

On March 27, 2014, Registrant filed a complaint in the United States District Court for the Northern District of Indiana (the “District Court Action”). Motion at 1. That same day, Registrant filed the Motion. Id. Registrant’s counsel informed Petitioner’s counsel that Registrant will not attend his scheduled deposition. Davis Decl. at ¶ 11. Petitioner’s testimony period closes on April 4, 2014. Id. at ¶ 12.

### **ARGUMENT**

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board *may* be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a) (emphasis added).

Simply because the parties in a Board proceeding are engaged in a civil action, the suspension of the Board proceeding is not automatic. Id. The civil action must have a bearing on the proceeding. Id.

The District Court Action brought by Registrant alleges that Petitioner has committed trademark infringement for use of the Mark. “A central issue of the federal court case is whether Westheimer Corporation’s use of the mark STRATOTONE violates Registrant’s federal trademark rights under its registered STRATOTONE mark.” Memo at 1. Registrant then makes the bare assertion that “[t]he outcome of the federal court case is likely to have a bearing on the case before the Board.” Id. The instant Proceeding is for cancellation of the Mark. Even if the Proceeding was suspended until the final determination of the infringement claim, that ruling

would have *no* bearing on the cancellation. More importantly, Registrant has made no attempt to even establish that the District Court Action would have any bearing on the Proceeding.

Accordingly, Registrant has failed to meet his burden and the Motion should be denied on that basis alone.

Further, the Board has routinely denied motions based on undue delay and bad faith. See Sfw Licensing Corp. & Shoppers Food Warehouse Corp. v . Di Pardo Packing Ltd., 60 U.S.P.Q.2d 1372 (Trademark Tr. & App. Bd. July 3, 2001). The Proceeding is currently in its testimony phase. Discovery is completed and Petitioner’s testimony period ends in one week. “[A party] should not be allowed to delay the outcome of this proceeding when there would be little or nothing to resume upon conclusion of [said party’s] civil suit.” Boyds Collection Ltd, 65 U.S.P.Q.2d 2017 (Trademark Tr. & App. Bd. Jan. 16, 2003). Given the late stage of this Proceeding, it would unduly prejudice Petitioner to have to wait for the resolution of the District Court Action, a process that is likely to take *years*, to complete the final stages of the Proceeding.

The Board has the inherent power to impose sanctions. See Cent. Mfg. Inc., 61 U.S.P.Q.2d 1210 (Trademark Tr. & App. Bd. Dec. 7, 2001). Rule 11 of the Federal Rules of Civil Procedure states, in pertinent part, as follows:

(b) Representations to Court. By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, —

(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;

...(c) Sanctions. If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the ... parties that have violated subdivision (b) or are responsible for the violation.

Fed. R. Civ. P. 11.

When sanctionable conduct is found, although the Board does not impose monetary sanctions or award attorneys' fees or other expenses, the Board has authority to enter other appropriate sanctions, up to and including the entry of judgment. See Trademark Rule §2.116(a) and authorities cited in TBMP §529.01. If the Board finds that a party has violated Rule 11, the Board may impose an appropriate sanction. See Fed. R. Civ. P. 11, and Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986). Further, it is clear that Rule 11 does not displace the Board's inherent authority to sanction bad-faith conduct. See Chambers v. NASCO, Inc., 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991). See also, United States v. International Brotherhood of Teamsters, 948 F.2d 1338, 1345 (2d Cir. 1991), citing Chambers, 501 U.S. at 49 (A court's inherent power to sanction those before it “stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases.”).

Cent. Mfg. Inc., 61 U.S.P.Q.2d 1210 (Trademark Tr. & App. Bd. Dec. 7, 2001).

The Board has sanctioned motions filed for “improper purposes, i.e., to obtain additional time to harass applicant, to obtain unwarranted extensions of the opposition period, and to waste resources of applicant and the Board.” Id. That is exactly the situation here. Registrant requested an adjournment of his properly noticed testimony deposition. During the two-week adjournment, Registrant retained counsel to draft the complaint the District Court Action and, at the end of business only two business-days prior to his rescheduled deposition, initiate the District Court Action and file the Motion. It is clear that the request for adjournment and the filing of both the Motion and the District Court Action was to harass Petitioner and waste the resources of both Petitioner and the Board. Registrant had no intention of ever attending his deposition. If this is not true, both Registrant and his counsel should have no problem *immediately* producing their travel and hotel arrangements.

As a result of Registrant's bad faith, Petitioner respectfully requests that the Board impose on Registrant and his counsel, any and all sanctions it deems appropriate.

**CONCLUSION**

For the reasons stated above, Registrant's Motion should be denied in its entirety. Further, the Board should invoke its inherent authority to sanction Registrant for his conduct.

Dated: March 27, 2014  
Hackensack, New Jersey

Respectfully submitted,

BIENSTOCK & MICHAEL, P.C.

By: /s Brent M. Davis, Esq.  
Brent M. Davis, Esq.  
Continental Plaza  
411 Hackensack Avenue, 7<sup>th</sup> Floor  
Hackensack, New Jersey 07601  
Phone: (201) 525-0300  
Fax: (201) 525-0133

*COUNSEL FOR PETITIONER*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

**In the Matter of Trademark Registration No. 3,986,754**  
**Registered on June 28, 2011**

_____	)	
<b>WESTHEIMER CORPORATION</b>	)	
	)	
<b>Petitioner,</b>	)	
	)	<b>Cancellation No. 92057116</b>
<b>v.</b>	)	
	)	<b>Registration No. 3,986,754</b>
<b>DARRYL D. AGLER</b>	)	
	)	
	)	
<b>Registrant.</b>	)	
_____	)	

**DECLARATION OF BRENT M. DAVIS, ESQ.**

I, Brent M. Davis, Esq., declare that:

1. I am an attorney licensed to practice in the States of New York and New Jersey. I am in good standing with the State Bars of New York and New Jersey. I am in all respects competent to testify to the facts stated in this Declaration.
2. I am the Senior Associate in the law firm of Bienstock & Michael, P.C. (the "Firm"), counsel to the above-captioned Petitioner ("Petitioner").
3. The Firm represents the above-captioned Petitioner in various trademark matters, including the above-captioned proceeding pending in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board ("TTAB") against Registrant, Darryl D. Agler ("Registrant").
4. The facts stated in this Declaration are based on my personal knowledge, and are true and correct. I understand that this Declaration will be submitted to the

Trademark Trial and Appeal Board of the United States Patent and Trademark Office in connection with Petitioner's Opposition to Registrant's Motion To Suspend Proceedings in the above-captioned opposition proceeding.

5. Petitioner initiated the Proceeding on April 25, 2013 for cancellation of Registrant's registration for the mark STRATOTONE.
6. Discovery closed on January 4, 2014
7. On March 4, 2014, Petitioner served Registrant with Notice of Deposition, with the deposition to take place on March 15, 2014
8. Petitioner's Testimony Period opened on March 5, 2014.
9. On Friday, March 7, 2014, Registrant's counsel requested an adjournment of the deposition.
10. The deposition was rescheduled for March 31, 2014.
11. Registrant's counsel informed Petitioner's counsel that Registrant will not attend his scheduled deposition.
12. Petitioner's testimony period closes on April 4, 2014.

The undersigned, being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Dated: May 19, 2010

s/ Brent M. Davis, Esq.  
Brent M. Davis, Esq.

**CERTIFICATE OF MAILING**

I, Brent M. Davis, Esq., hereby certify that the foregoing Westheimer Corporation's Opposition to Registrant's Motion to Suspend Proceedings has today been deposited with the United States Postal Service on the date below as first class mail, postage prepaid, in an envelope addressed as follows:

Leticia Guerra  
600 Superior Avenue, E.,  
Suite 2100  
Cleveland, OH 44114

March 27, 2014  
Date

s/ Brent M. Davis, Esq.  
Brent M. Davis, Esq.