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

Mailed: April 4, 2014

Cancellation No. **92057116**

Westheimer Corporation

v.

Darryl D. Agler

Yong Oh (Richard) Kim, Interlocutory Attorney:

On March 28, 2014, the Board held a telephone conference to hear argument and rule on respondent's motion (filed March 27, 2014) to suspend this Board proceeding pending final disposition of a civil action between the parties (*Agler v. Westheimer Corp.*, Case No. 1:14-cv-00099 in the U.S. District Court for the Northern District of Indiana).¹ Petitioner has opposed the motion. Brent M. Davis, Esq., and Ira M. Hoffman, Esq., of Bienstock & Michael, P.C., appeared as counsel for petitioner and Leticia Guerra, Esq., of McDonald Hopkins LLC appeared as counsel for respondent.²

¹ Due to the uncertain status of the testimonial deposition scheduled to occur two business days away on March 31, 2014, petitioner telephonically requested on March 27, 2014, and the Board agreed to, a hearing to dispose of the motion.

² The notice of appearance of counsel for respondent (filed April 1, 2014), is noted and the Board's records have been accordingly updated. As the Board will not undertake double correspondence, all correspondence to respondent will henceforth be sent to Louis T. Perry of Faegre Baker Daniels LLP.

Background

As confirmed by the parties' counsels during the conference, petitioner served respondent with a notice of testimonial deposition on March 4, 2014, with the deposition to take place on March 17, 2014. Due to both respondent and his counsel's stated unavailability, the deposition was rescheduled to March 31, 2014. Pursuant to the Board's institution order of April 29, 2013, petitioner's initial testimony period was scheduled to close on April 4, 2014. On March 27, 2014, respondent filed the aforementioned civil action in the U.S. District Court for the Northern District of Indiana followed by the filing of the instant motion with the Board seeking suspension of this proceeding pending disposition of the district court action.

Decision

It is the Board's well-settled policy 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. Trademark Rule 2.117(a); *see, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). This is so insofar as a decision of the Federal district court is often binding upon the Board while the decision of the Board is not binding upon the Federal district court. *See Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988). It is also well-settled that suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board.

The petition for cancellation asserts fraud and abandonment as grounds for cancellation.³ On the other hand, in the civil action wherein respondent is the plaintiff, the complaint asserts against petitioner claims of unfair competition and false designation of origin under federal and state law, infringement, counterfeiting, unjust enrichment, conversion, deception, and pecuniary loss under Indiana's Crime Victim's Relief Act. In support of suspension, respondent simply states in his motion that the civil action "is likely to have a bearing on the case before the Board" but fails to explain how that is so in the face of such disparate claims. While the civil action may ultimately be shown to have a bearing on this proceeding once the issues therein, including any counterclaims, have been joined, the Board does not find at this very early stage of the district court action that it has a bearing on this proceeding so as to warrant a suspension of this case.

In view thereof, respondent's motion to suspend is hereby **DENIED**. As petitioner has represented that it will be available every day from March 31 to April 4, 2014, to take respondent's deposition, it is incumbent upon respondent to agree to a deposition date up to and including April 4, 2014. Dates remain as set in the Board's institution order.

* * *

³ In his answer, respondent has denied the salient allegations of the petition and alleges as affirmative defenses, *inter alia*, laches, acquiescence and estoppel. Although respondent has also included lack of standing, it is not an affirmative defense as petitioner bears the burden of affirmatively proving its standing. See *Lipton Industries v. Ralston Purina*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).