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

wbc

Mailed: June 23, 2014

Cancellation No. 92058861

Brian S. Gluckstein

v.

GlucksteinHome, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up on Petitioner's request for reconsideration (filed February 24, 2014) ("RFR") of the Board's April 28, 2014 order ("Prior Order") suspending these proceedings for a civil action filed in Ontario Superior Court of Justice, Case No. CV 13-10172-00CL and in the Federal Court of Canada, Court File No. T-651-14 (collectively the "Court Actions"). The motion is fully briefed.

A request for reconsideration requires that the Board consider whether "based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." TBMP § 518 (3d ed. rev.2 2013). A request for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in a brief on the original motion." *Id.*

"A foreign applicant seeking a U.S. registration under Trademark Act Sections 44(c) and (e) must own a mark 'duly registered' in its country of origin. That is, if, at any time prior to the issuance of the U.S. registration, the foreign registration is

shown not to be in full force and effect, the U.S. application loses its Section 44 basis." *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793 (TTAB 1993); *see Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, recon. denied, 1 USPQ2d 1308 (TTAB 1986); *Hudson Pharmaceutical Corp. v. Laboratories Hosbon, S.A.,* 177 USPQ 707 (Com'r Pats. 1973). The U.S. application is dependent upon the validity of the foreign registration up until the time the U.S. registration based thereon is issued. *Marie Claire Album*, 29 USPQ2d at 1793. Further, where the respective rights of foreign nationals in their own country are at issue, it is appropriate to suspend the Board proceeding thereby allowing the foreign tribunal to make a determination respecting the rights of the parties. *See Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 44 (TTAB 1986); *see also* TBMP § 510.02(a).

In the Court Actions, Petitioner seeks a court order that, *inter alia*, "any and all trade-marks, trade-mark registrations or applications to register trade-marks used by, held by or in the name of [Respondent] … be promptly assigned to [Petitioner]." *Ontario Superior Court Notice of Application*, p. 4. Additionally, Respondent has filed a counter-application in the Ontario Superior Court of Justice seeking, *inter alia*, an injunction prohibiting Petitioner from seeking to "challenge in any way or reverse any registered trade-mark or trade-mark application belonging, registered to or filed by [Respondent]" in Canada and the U.S. and prohibiting Petitioner from pursuing "applications to register any GlucksteinHome Trade-marks, Gluckstein Name Trade-Marks or other trade-marks that are similar to or may be confusing

with the Trade-Marks of [Respondent], anywhere in the world." *Counter-Application*, p. 5-6.

Although Respondent's mark is a U.S. registration and as argued by Petitioner, "its status is independent of the validity of its registration abroad" *see Petitioner's Reply Brief*, p. 1, Petitioner bases its pleaded claims of priority and likelihood of confusion, dilution and false suggestion of a connection, in part, on its pleaded U.S. applications, all of which claim a priority date currently based on its Canadian applications pursuant to Section 44.[1] Further, the Court Actions involve issues regarding ownership of Respondent's registration and Petitioner's pleaded marks and the name, GLUCKSTEIN. In view thereof, the Court Actions may have a bearing on this Board proceeding.

After carefully considering the parties' arguments the Board finds no error in its Prior Order suspending these proceedings pending final disposition of the Court Actions. Accordingly, Petitioner's request for reconsideration is **denied**.

Proceedings remain suspended. In view of this suspension, all pending motions are denied without prejudice.

Within twenty days after the final determination of the Court Actions, the parties shall so notify the Board in writing, including a copy of the court's final order(s).

If a party believes its motion pending at the time of suspension and denied by this order was not resolved or made moot by the Court Actions, the party may

[1] Petitioner's pleaded U.S. applications claim priority based on Canadian Application Nos. 1666955 and 1666621.

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 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 has 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.