

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

wbc

Mailed: July 22, 2014

Cancellation No. 92058956

SoCal Maico

v.

578539 B.C. Ltd.

Wendy Boldt Cohen, Interlocutory Attorney:

Respondent filed a motion (filed June 6, 2014) to suspend the proceeding pending final determination of a civil action¹ between the parties. The motion has been fully briefed. On July 22, 2014 the Board held a telephone conference with J. Gary Kortz, Petitioner's owner, Paul W. Reidl, Respondent's counsel, and Wendy Boldt Cohen, Board Interlocutory Attorney.

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board. *See* Trademark Rule 2.117; *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); TBMP § 510.01 (2014). Whenever it comes to the attention of the Board that

¹ *578539 B.C. Ltd, t/a CANADIAN MAICO v. Kortz, d/b/a SOCAL MAICO*, Civ. Act. No. 2:14-cv-04375 in the United States District Court for the Central District of California, Western Division filed June 6, 2014.

a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. *See* TBMP § 510.02(a) and cases cited therein. 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). To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); TBMP § 510.02(a). The Board does not usually require that an issue be joined (that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126027 (TTAB 1974).

The issues in the civil action and the Board proceeding appear to involve matters regarding the mark at issue in the Board proceeding as discussed in the call. Respondent's motion is therefore **GRANTED** as well taken. *See* Trademark Rules 2.127(a) and 2.117(a).

Accordingly, proceedings are suspended pending final disposition of the civil action between the parties, and in view of this suspension, **all other pending motions are 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 a party believes its motion pending at the time of suspension and denied by this order was not resolved or made moot by the civil action, the party 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 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.