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

Proceeding	92059733
Party	Defendant METH LAB CLEANUP LLC
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Submission	Motion to Suspend for Civil Action
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Attachments	Meth Lab Cleanup Request for TTAB Suspension of Cancellation Proceeding 92059733.pdf(91043 bytes)

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BIO CLEAN, INC.)	Cancellation No. 92059733
3316 OLD HARTFORD ROAD, #A2)	Registration No. 3662396
LAKE STEVENS, WA 98223)	
)	
Petitioner,)	
)	
v.)	
)	
)	
METH LAB CLEANUP, LLC)	
2994 E. SABLE COURT)	
ATHOL, ID 83801)	
)	
Registrant-Respondent.)	

REGISTRANT, METH LAB CLEANUP, LLC'S
MOTION TO SUSPEND CANCELLATION PENDING OUTCOME OF CIVIL ACTION

Registrant, METH LAB CLEANUP, LLC (“Registrant” or “MLCC”), through its undersigned counsel, hereby moves the Trademark Trial and Appeal Board (“Board”) to suspend the instant cancellation proceeding pending the outcome of the Friday, August 16, 2014 filed Lanham suit filed by Registrant under 15 USC § 1114 against Petitioner BIO CLEAN INC. (“Petitioner”) as well as Petitioner’s sole owner Theresa Borst (“Borst”) in the United States District Court for the Western District of Washington.

In support of this unopposed motion, Registrant shows the Board the following:

I. Background

Registrant is a nationally recognized and licensed vendor that offers affordable and effective testing and decontamination services for homes and facilities that were previously used as illegal drug laboratories. As a pioneer in the field of clandestine drug lab decontamination, Registrant has created and developed certain advanced clean up technologies to help rehabilitate

homes, apartments, condos and other dwellings that were unfortunately used to prepare and then later sell illegal drugs.

Registrant offers these decontamination services nationwide through a series of independent contractors – all of which have been trained and licensed by Registrant for purposes of ensuring high quality and effective decontamination solutions to customers affected by these illegal acts. By ensuring uniform training and then later effective service through its network of trained technicians, Registrant helps ensure that a dwelling once contaminated by toxic chemicals and illegal drugs will be safe and secure for later occupancy and domicile.

As the purveyor of the information provided on the **METH LAB CLEANUP** Website, as well as the owner of the rights in the training materials, Registrant has expended a considerable level of time, effort, resources and money to create one of the country's only nationally accredited drug decontamination training programs. To protect the reputation and notoriety of this program – as well as the related decontamination services – Registrant has sought the protections of the Lanham Act to protect the name **METH LAB CLEANUP**.

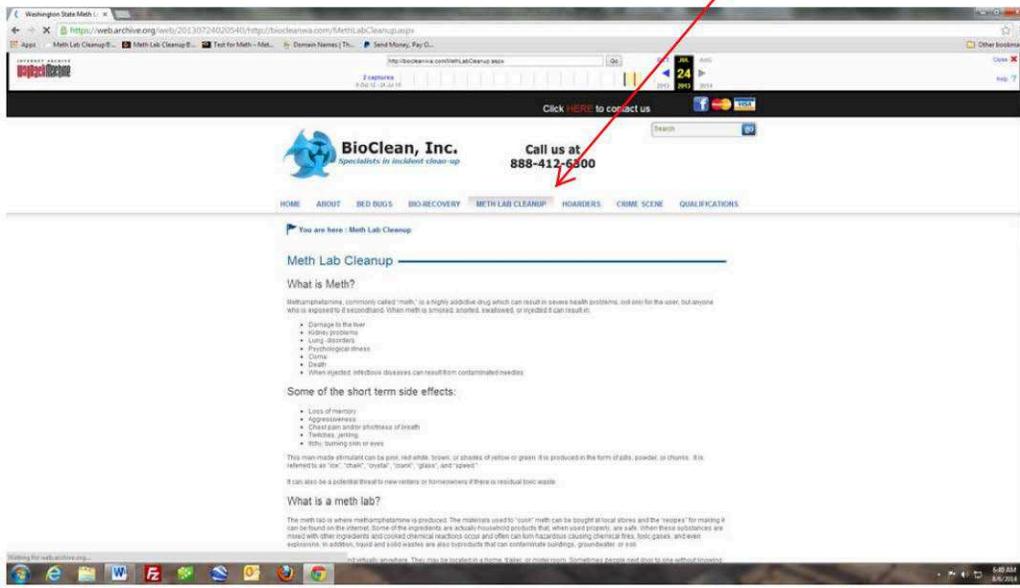
With regard to specific protection under Lanham Act, Registrant maintains six trademark registrations before the United States Patent and Trademark Office (“USPTO”) regarding its corporate name “Meth Lab Cleanup LLC” as well as its related service mark **METH LAB CLEANUP** (collectively the “**METH LAB CLEANUP** Marks”). These **METH LAB CLEANUP** Marks include, but are not limited to, Trademark Registration No. 3,662,396 registered by Registrant in International Class 41 for “Training services in the field of clandestine drug lab decontamination and cleanup.”

Registrant is one of only two training programs recognized by the Washington Department of Health with regard to professionals seeking to be certified in clandestine drug lab

decontamination. Since June of 2009, Registrant has been a certified trainer in this field for the Washington Department of Health. Registrant is one of only eight companies certified by the Washington Department of Health to provide such services. As such, Registrant represents not only one of the few companies which can provide remediation services regarding former clandestine drug labs, but it is also one of the two groups which the state fees is competent enough to provide underlying training.

Petitioner is a Washington state based provider of bio recovery services, including the cleaning of crime scenes, assistance with helping hoarders, as well as addressing bed bug problems. Petitioner advertises these services on its Website www.BioCleanWa.com (the “BioClean Website”). While not a primary focus of its service offerings, Petitioner advertises locally that it provides certain remediation services within Washington state regarding former methamphetamine laboratories. Petitioner is one of the eight companies (along with Registrant) certified by the Washington Department of Health to provide such services. Petitioner sought to become certified by attending Registrant’s certification courses (as one of only two trainers recognized by the State of Washington).

Soon after the USPTO issued Trademark Registration 4,278,724 to Registrant – one of the **METH LAB CLEANUP** Marks (which happens to be the subject of yet another TTAB cancellation proceeding by Petitioner), Petitioner changed its BioClean Website advertising in June 2013 and began – for the very first time – to use the **METH LAB CLEANUP** Marks to advertise and promote Defendants’ clandestine laboratory remediation services. This is illustrated by a June 2013 dated archive of the BioClean Website:



This advertising and promotion by Petitioner through use of the **METH LAB CLEANUP** Marks was without authorization or permission by Registrant.

Registrant was particularly concerned over Petitioner's June 2013 changes to the BioClean Website (and related advertising). Such use of the **METH LAB CLEANUP** Marks was particularly alarming based upon (a) Registrant's close geographic proximity with Petitioner (Washington State v. Western Idaho), (b) the fact that both Registrant and Petitioner are only two of the eight licensed groups providing remediation services in the State of Washington, and (c) the fact that Registrant is a principal training group (one of only two) tasked by the State of Washington with training individuals seeking to conduct remediation services.

Based upon these concerns, Registrant prepared and served a formal cease and desist letter on or about June 24, 2013 to stop Petitioner's infringing on-line advertising (which at the time had only been going on for about one month). Petitioner's attorneys responded on August 2, 2013 that they had been "recently retained by BioClean" to address Respondent's allegations of trademark infringement and that the firm was "evaluating [Registrant's] claims and will respond in due course." Registrant served a second cease and desist letter on February 20, 2014

due to continued acts of infringement under 15 USC § 1114 and 15 USC § 1125(a). In apparent retaliation, Petitioner some three months later, on June 6, 2014, filed a cancellation proceeding before the Board regarding Trademark Registration No. 4,278,724. Several weeks later, Petitioner filed, on August 3, 2014 (a Sunday), a second (yet related) cancellation proceeding before the Board regarding Trademark Registration No. 3,662,396 for the mark **METH LAB CLEANUP LLC**. In seeking cancellation on August 3rd, Petitioner has alleged that the underlying mark **METH LAB CLEANUP LLC** should be cancelled based upon being either generic, merely descriptive, or invalid based upon other similar grounds.

Due to its inability to effectuate any true response based upon its June 24, 2013 and February 20, 2014 formal demand letters, Registrant filed a trademark infringement and unfair competition action on August 15, 2014 in the Western District of Washington (Case No. 2:14-CV-01259)(the “Seattle Action”) seeking a finding that Trademark Registration 3,662,396 is both valid and infringed by Petitioner’s website (and related advertisements) which include use of the mark **METH LAB CLEANUP** – which is a colorable imitation of the mark **METH LAB CLEANUP LLC**.

To succeed on its claim of trademark infringement under 15 USC § 1114 under Ninth Circuit precedent, Registrant must first prove in its Seattle Action that it owns a valid trademark registration for Trademark Registration 3,662,396. *See Experience Hendrix, LLC v. Elec. Hendrix, LLC*, 2008 U.S. Dist. LEXIS 60737 (W.D. Wa. Aug. 7, 2008) (citing *Tie Tech Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002)).

Based on the fact that the allegations raised in the Seattle Action have a direct bearing on the matters before the Board, Registrant met and conferred with Petitioner’s counsel on August

26, 2014 to address a suspension of this cancellation proceeding based upon 37 C.F.R. §2.117(a). In response, Petitioner's counsel did not consent to the suspension request.

II. Request for Suspension

The Board has the discretion to suspend a cancellation proceeding pending the outcome of another proceeding in another jurisdiction, and it is appropriate to do so in this case. 37 C.F.R. §2.117(a); *see Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975); *Tokaido v. Honda Associates, Inc.*, 179 USPQ 861 (TTAB 1973). *See also Careerxchange Inc. v. Corpnet InfoHub, Ltd*, 80 U.S.P.Q.2D (BNA) 1046 (TTAB 2005) (suspending of cancellation proceeding even after prior entry of default before Board due to infringement action filed in Florida). The parties named in the cancellation proceeding pending before the Board mirror those in the Seattle Action (the only difference being that Registrant has named Petitioner's sole owner as a co-defendant in raising allegations of trademark infringement and unfair competition).

Also, the Seattle Action involves issues in common with those in the cancellation proceeding; specifically, the Seattle Action contains a claim for trademark infringement involving Petitioner's use in commerce of the mark **METH LAB CLEANUP**, which is the mark protected by Trademark Registration No. 3,662,396. As such, the Seattle action puts forth the question of validity and/or enforceability of Trademark Registration No. 3,662,396, as such validity would be a prerequisite in addressing Registrant's 15 USC § 1114 claim against Petitioner (and Borst). *See Tie Tech*, 296 F.3d at 783. The outcome of the Seattle Action will therefore directly impact and resolve the issues involved in this cancellation proceeding, as well as many others affecting the parties.

Equitable considerations also favor suspension of the cancellation proceeding because conducting two trials involving the same parties and the same issues is likely to result in

unnecessary duplication of effort and expense. There is also the potential that simultaneous proceedings on these issues could effectuate inconsistent results.

Lastly, this underlying TTAB Cancellation proceeding is in its infancy. Neither party has served their initial disclosures, served written discovery, or conducted any form of deposition practice. Rather, the only substantive conduct between the parties has been limited to Registrant filing its Answer and Affirmative Defenses (filed on September 15, 2014).

For the reasons set forth above, Registrant respectfully requests that the Board suspend the instant opposition proceeding until final disposition of the Seattle Action between the parties.

Respectfully submitted,

s/ Robert H. Thornburg

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served by

Electronic Mail and U. S. Mail on September 15, 2014, to:

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