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

Proceeding	92059949
Party	Plaintiff Diversey, Inc.
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Attachments	Opposition to Motion to Suspend Cancellation No. 92059949.pdf(32673 bytes )

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

DIVERSEY, INC.,	)	
	)	
Petitioner,	)	Cancellation No. 92059949
	)	Registration No. 939,378
v.	)	
	)	Mark: HYDROX OPTIMATES CHEMICALS &
HYDROX CHEMICAL CO.,	)	DESIGN
	)	
Registrant.	)	

**DIVERSEY, INC.'S OPPOSITION TO REGISTRANT'S MOTION  
TO SUSPEND PROCEEDINGS**

Petitioner Diversey, Inc. ("Petitioner") respectfully submits this opposition (this "Opposition") to Registrant Hydrox Chemical Co.'s Motion To Suspend Proceedings In View Of Pending Civil Action Pursuant To Trademark Rule 510(a) (the "Motion"). In support, Diversey states:

**Background**

Hydrox Chemical Company ("Registrant") owns U.S. Registration No. 939,378 (the "'378 Registration") for the mark HYDROX OPTIMATES CHEMICALS & design (the "Mark"). Motion at Exhibit A. On September 30, 2013, Registrant sued Petitioner in the United States District for the Northern District of Illinois (the "District Court Action"), alleging (among other things) that Petitioner is infringing Hydrox's rights in the Mark. Id.

Petitioner filed its answer in the District Court Action on November 25, 2013 (the "Answer"), but raised no affirmative defense or counterclaims or otherwise requested any relief from the District Court with respect to the Mark or the '378 Registration. Motion at Exhibit B. Discovery in the District Court Action has been completed, and the time to amend the pleadings in the District Court Action has long since passed.

On September 17, 2014, Petitioner initiated this proceeding and requested that the Board partially cancel the '378 Registration in its entirety on the basis of abandonment.

### **Argument**

Suspension of a Board proceeding is solely within the discretion of the Board. The Other Telephone Company v. Connecticut National Telephone Company, Inc., 181 USPQ 779, 782 (Comm'r Pat. 1974). "All motions to suspend, regardless of circumstances, . . . are subject to the 'good cause' standard." National Football League v. DNH Management LLC, 85 USPQ2d 1852, 1855, n.8 (TTAB 2008) citing Trademark Rule 2.117(c). "[B]oth the permissive language of Trademark Rule 2.117(a) . . . and the explicit provisions of Trademark Rule 2.117(b) make clear that suspension is not the necessary result in all cases." Boyd's Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017, 2018 (TTAB 2003). The suspension of this proceeding, then, is not automatic simply because the parties are engaged in the District Court Action. The District Court Action must have a bearing on this proceeding for such a suspension to be appropriate. 37 C.F.R. § 2.117(a) (when "parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board *may* be suspended until termination of the civil action . . ." (emphasis added)).

The purpose of suspension is to avoid the undesirable result of the parties litigating the same issue in two forums, with potentially inconsistent results. Here—though the Mark might be involved in both the District Court Action and this proceeding—the same issues are not being litigated (as further discussed below), and there will be no duplication of effort on the part of the Board and the District Court.

To support its contention that this proceeding should be suspended, Registrant (i) makes a bare assertion that the District Court Action "will have a bearing on the issues before the Board

because it involves the same parties and the precise mark at issue here" (Motion, ¶ 7) and (ii) cites to Petitioner's supposed denial<sup>1</sup> that the '378 Registration is valid in the Answer. (Motion, ¶ 2). But the question of whether '378 Registration should be cancelled is not before the District Court; abandonment was not pled and cancellation was not requested in the District Court Action. Instead, the District Court Action involves claims of infringement of the Mark. Motion, ¶ 2. The instant proceeding is for cancellation of the Mark on the grounds of abandonment. Even if this proceeding was suspended until final determination of the infringement claim, that ruling would have no bearing or impact on the Board's examination of this issue.

Registrant has made no attempt beyond a mischaracterization of Petitioner's answer to Paragraph 13 of the Complaint to establish that the District Court Action would have any bearing on this proceeding. And even that mischaracterization is not enough to overcome the simple fact that the District Court Action and this proceeding involve entirely distinct and independent legal issues, and that the relief sought here – cancellation on grounds of abandonment – was not pled and is not part of the District Court Action. As a result of this failure to meet its burden, the Motion should be denied.

### **Conclusion**

For the reasons stated above, the Motion should be denied in its entirety.

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<sup>1</sup> Petitioner never makes such a denial in the Answer. Rather, in response to the allegation in paragraph 13 of the Complaint in the District Court Action that the '378 Registration is "valid, subsisting and in full force and effect", Petitioner responded that it was "without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 13." Motion at Exhibit B, ¶ 13.

Dated: October 16, 2014

Respectfully submitted,  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing was served on Registrant on October 16, 2014, via first class mail to:

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