

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

Mailed: June 5, 2015

Cancellation No. 92061135

Mattoon Rural King Supply, Inc.

v.

Weems Industries, Inc.

Andrew P. Baxley, Interlocutory Attorney:

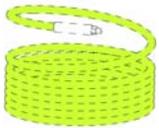
Concurrently with its answer, Respondent, on May 1, 2015, filed a motion to suspend the above-captioned proceeding under Trademark Rule 2.117(a) pending final determination of a civil action styled *Weems Industries, Inc. v. Mattoon Rural King Supply, Inc.*, Case No. 1:15-cv-00036-LRR, filed in the United States District Court for the Northern District of Iowa. The motion has been fully briefed.

“Whenever it shall come to the attention of the ... Board that a party or 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 or the other Board proceeding.” Trademark Rule 2.117(a). See TBMP § 510.02(a) (2014). The civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board. See *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). Although the USPTO has expertise in determining trademark registrability, such determinations are not within the USPTO's exclusive

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jurisdiction. *See American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Moreover, the Board is empowered only to determine the right to register and has no injunctive authority. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

In the above-captioned proceeding, Petitioner seeks cancellation Respondent's Registration No. 3765628 on the Supplemental Register for the following mark,



, for “[c]ompressed air hoses” in International Class 17¹ on the ground that the involved mark is “highly functional.”² In the civil action, Respondent

¹ The registration was issued on March 23, 2010. The registration includes the following description: “The color(s) chartreuse (pantone 389C) is/are claimed as a feature of the mark. The mark consists of the color chartreuse (pantone 389C) as applied to the entire hose body of the goods. The color white in the mark is not part of the mark but is used merely to indicate a functional part of the hose that is not claimed as part of the mark. The dotted outline of the goods is intended to show the position of the mark on the goods and is not part of the mark.”

² Although not stated expressly in the petition to cancel, a claim for cancellation of a registration of a mark registered on the Supplemental Register based on functionality and incapability is raised under Trademark Act Section 23(c), 15 U.S.C. § 1191(c). *See Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1914 n.2 (TTAB 2011).

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alleges, among other things, infringement of the mark in its and seeks, among other remedies, to “[t]emporarily and permanently enjoin” Petitioner “from using chartreuse colored compressed air hose products.” To prevail on its infringement claim, Respondent will need to establish its rights in the involved mark. If the district court determines that such rights exist, that determination may have a bearing upon this proceeding. Further, a decision by the district court to enjoin Petitioner’s use of chartreuse colored compressed air hose products may have a bearing upon Petitioner’s standing herein. *Cf. Nobelle.Com, LLC v. Qwest Communications Int’l, Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003) (standing to assert descriptiveness or abandonment requires only that plaintiff has right to use term descriptively in its business).

Based on the foregoing, the Board finds that suspension of this proceeding pending final determination of the civil action is warranted. Proceedings herein are suspended pending final determination, including any appeals or remands, of Case No. 1:15-cv-00036-LRR.

Petitioner’s motion to suspend the civil action pending final determination of this proceeding is noted. If such motion is granted, the Board will entertain a motion to resume proceedings herein.

Petitioner also alleges in the petition to cancel that Respondent’s involved mark “lacks acquired distinctiveness.” However, registration of a mark on the Supplemental Register constitutes an implied admission that the mark is not distinctive, at least at the time of registration. *Cf. Perma Ceram Enterprises Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137 n. 11 (TTAB 1992) (registration on the Supplemental Register constitutes an implied admission that term is descriptive, at least at the time of registration). Accordingly, lack of distinctiveness is not a basis for cancellation of a registration on the Supplemental Register.

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The Board will make annual inquiry as to the status of the civil action. Within twenty days of the final determination of the civil action, Respondent shall notify the Board in writing so that the Board may take appropriate action in this case. While the case is suspended, the parties must keep their correspondence addresses current.