

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 11, 2016

Cancellation No. 92062974

*Aerospace Communications Holdings Co.,
Ltd.*

v.

*The Armor All/STP Products Company
(survivor of a merger with IDQ Operating,
Inc.)¹*

Andrew P. Baxley, Interlocutory Attorney:

On February 19, 2016, Respondent filed a motion to suspend this proceeding pending final determination of a civil action styled *Aerospace Communications Holdings Co., Ltd. v. IDQ Operating, Inc.*, Case No. 6:15-cv-00781-JRG-KNM, filed August 17, 2015 in the United States District Court for the Eastern District of Texas (sometimes referred to as “the civil action”). On February 29, 2016, Respondent also filed a motion to extend its time to answer to thirty days from either the denial of the motion to suspend or the resumption of proceedings following the requested suspension. Petitioner filed a brief in response to those

¹ In view of the recordation with the USPTO’s Assignment Division of documents reflecting (1) the merger of IDQ Operating, Inc. (“IDQ”) into The Armor All/STP Products Company (“Armor All/STP”), effective December 31, 2015, at Reel 5714/Frame 0538 on January 22, 2016, and (2) the confirmatory assignment of the involved registration nunc pro tunc to December 31, 2015, from IDQ to Armor All/STP at Reel 5735/Frame 0397 on February 18, 2016, the caption of this proceeding is hereby amended to identify Armor All/STP as the respondent and party defendant herein.

Cancellation No. 92062974

motions. Although Respondent's time in which to file a reply brief in support of the motions has not lapsed, the Board elects to resolve the pending motions at this time. *See* Trademark Rule 2.127(a).

Regarding the motion to extend time to answer, the Board, in exercising its inherent authority to control the scheduling of cases on its docket, deems the filing of the motion to suspend on February 19, 2016 to have tolled the running of dates herein.² *See* TBMP § 510.01 (2015). Thus, the motion to extend time to answer is moot.

Turning to the motion to suspend, Respondent contends that suspension of this proceeding pending final determination of the civil action is warranted because its mark ASK THE PRO is the subject of both the civil action and this proceeding, and because the parties are the same, and there are overlapping issues, in those proceedings.

In opposition to the motion to suspend, Petitioner contends that it has not been served with the complaint in the civil action, which was filed more than six months ago. Petitioner further contends that suspension is inappropriate because Petitioner has filed in the civil action (1) a motion to suspend the civil action pending final determination of both the above-captioned cancellation proceeding and a proceeding before the Patent Trial and Appeal Board (PTAB) involving review of the patent upon which Respondent relies in the civil action; (2) a motion to quash service of the

² Indeed, in the interests of both judicial economy and saving the parties' time, effort and expense, the motion to suspend should be resolved before the parties take any further action in this case.

Cancellation No. 92062974

complaint; (3) a motion to dismiss the civil action for improper service, lack of personal jurisdiction and incorrect venue or, in the alternative, to transfer venue, while Respondent has filed a motion to extend time to serve the complaint therein. Petitioner contends in addition that suspension is unwarranted because, pursuant to the Supreme Court's decision *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S.Ct. 1293, 113 USPQ 2045 (2015), a decision by the Board in this case may be binding upon the district court in the civil action. Moreover, Petitioner asserts that judicial economy will be served by allowing this proceeding to go forward.

“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). The civil action need not 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).

“A civil action is commenced by filing a complaint with the court.” Fed. R. Civ. P. 3. Thus, the civil action is pending for purposes of determining whether to suspend a Board proceeding under Rule 2.117(a) as of the filing date of the complaint in the civil action. Any failure to serve or delay in serving the complaint in the civil action is a matter to be addressed with the district court.

Cancellation No. 92062974

Petitioner correctly notes that, pursuant to the Supreme Court's decision *B & B Hardware, Inc., supra*, a Board decision may be entitled to preclusive effect under certain circumstances. However, that decision does not change the facts that (1) determinations of trademark registrability are not within the USPTO's exclusive jurisdiction (*see American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D. Minn. 1986)) and (2) the Board is empowered only to determine the right to register and may not grant broader relief, such as damages or injunctions.³ *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). In addition, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the decision of the Federal district court remains binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988). Thus, the *B & B Hardware, Inc.* decision has not significantly altered the Board's application of Rule 2.117(a) in suspending cases on its docket.

Petitioner's assertion that allowing this proceeding to go forward will somehow promote judicial economy is unpersuasive. Indeed, following Petitioner's proposed course of action for resolving the parties' dispute may have the parties moving forward at the same time in this proceeding before the Board and in another proceeding before the PTAB, after which the parties may resume the civil action

³ In the civil action, Respondent seeks to "[p]ermanently enjoin and restrain" Petitioner from using the involved mark ASK THE PRO.

Cancellation No. 92062974

before the district court. Although this course might narrow the issues ultimately decided by the district court, it would appear not to be judicially economical with regard to resolving the parties' entire dispute.

Rather, for the time being at least, the Board finds that suspension of this case under Rule 2.117(a) is appropriate. To prevail on the trademark infringement claim in the civil action, Respondent must establish its proprietary rights in the involved ASK THE PRO mark. If the district court determines that such rights exist, that determination may have a bearing upon Petitioner's claims herein and may be binding upon the Board. Further, any injunction preventing Petitioner's use of the involved ASK THE PRO mark may have a bearing upon Petitioner's standing to maintain this proceeding. If, however, the civil action is dismissed or stayed pending final determination disposition of this proceeding and the proceeding before the PTAB, the Board will entertain a motion to resume this proceeding.

Based on the foregoing, Respondent's motion to suspend is granted. Proceedings herein are suspended pending final determination, including any appeals or remands, of Case No. 6:15-cv-00781-JRG-KNM.

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 so that appropriate action can be taken in this case. While this case is suspended, the parties shall keep their correspondence addresses current.