



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

United States Department of the Interior, National Park Service

v.

DNC Parks & Resorts at Yosemite, Inc.

Cancellation No. 92063225
On Petition to the Director
Filed: June 10, 2016

Decision

On June 10, 2016, the United States Department of the Interior, National Park Service (“Petitioner”) petitioned the Director of the United States Patent and Trademark Office (“Director”) to reverse an interlocutory order issued by the Trademark Trial and Appeal Board (“TTAB” or “Board”). The Director has the authority to review Petitioner’s request.¹ See 37 C.F.R. §§ 2.146(a)(3) and (e)(2). The petition is denied.

FACTS²

Petitioner seeks to cancel DNC Parks & Resorts at Yosemite, Inc.’s (“Respondent”) Registrations Nos. 2715307 for the mark YOSEMITE NATIONAL PARK); 2772512 and 1529066 each for the mark THE AHWAHNEE; 2685968 for the mark CURRY VILLAGE; 2739708 for the mark WAWONA; and 2720778 and 3731325 each for the mark BADGER PASS. As grounds for cancellation, Petitioner alleges that

¹ Authority to decide any trademark petitions to the Director under 37 C.F.R. § 2.146 was delegated to the Commissioner for Trademarks. Subsequently, authority to decide petitions to the Director under 37 C.F.R. §§ 2.146(e)(1) and (e)(2), involving review of the grant or denial of an extension of time to file a notice of opposition, review of interlocutory orders issued by the TTAB, and review of requests to waive the Trademark Rules of Practice relating to TTAB cases was delegated to the Chief Administrative Trademark Judge. Under such delegation, the authority to decide this petition was further delegated.

² This decision recites only the facts relevant to the issue on petition.

Respondent's use of the marks creates a false association with the National Park Service, that Respondent has abandoned use of the registered marks, and dilution of the National Park Service's famous YOSEMITE NATIONAL PARK mark. In the alternative, Petitioner requests that the involved registrations be transferred to it under Trademark Act § 18, 15 U.S.C. § 1068. In an order dated May 18, 2016 ("Order"), the TTAB granted Respondent's contested motion to suspend proceedings pending final disposition of a civil action between the parties, styled *DNC Parks & Resorts at Yosemite, Inc. v. The United States of America*, Case No. 15-cv-1034-PEC (Fed. Cl.), filed January 25, 2016. Petitioner claims that TTAB should not have exercised its discretion to suspend proceedings "without considering the subject matter expertise of the Board, the jurisdictional limitations of the United States Court of Federal Claims, and the statutory legal presumptions provided to incontestable registrations." More specifically, Petitioner asserts that the TTAB abused its discretion because the United States Court of Federal Claims does not have jurisdiction over "a trademark infringement suit" and further lacks jurisdiction to consider a plaintiff's claim to cancel a trademark registration against the United States.

DISCUSSION

Standard of Review

The Director may exercise supervisory authority in appropriate circumstances. 35 U.S.C. § 2; 37 C.F.R. § 2.146(a)(3); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1707. In an inter partes proceeding before the Board, a party may petition the Director to review an order or decision of the Board that concerns a matter of procedure and does not put an end to the litigation before the Board. TTAB MANUAL OF PROCEDURE (TBMP) §§ 901.02(a), 905; TMEP § 1704. However, the Director will reverse an interlocutory order issued by the Board in an inter partes proceeding only upon a showing of clear error or abuse of discretion. *Kimberly Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r Pats. 1991); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r Pats. 1991); *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977). For the reasons set forth below, the circumstances presented in this case do not demonstrate that the Board committed clear error or abused its discretion.

The TTAB Did Not Commit Clear Error or Abuse Its Discretion

Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), provides as follows:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action

or another Board proceeding 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.

The TTAB has the inherent power to schedule the disposition of cases on its docket, including the power to stay proceedings. *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021, 2029 (D.N.J. 1990); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000).

Ordinarily a suspension in Board proceedings is occasioned by a civil action between the parties in a federal district court. A party to a TTAB proceeding who is dissatisfied with the decision of the TTAB has a remedy by civil action in a United States District Court. This would include the same district court in which the parties are involved in a separate civil action. The court “may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear.” Trademark Act § 21(b), 15 U.S.C. § 1071(b). Thus, judicial economy, at least, is served by such a suspension.

The Board, in its discretion, may also suspend a proceeding pending the final determination of proceedings between the parties in other circumstances. Examples include: another Board proceeding, civil action in state court, and a foreign proceeding. Further, in its discretion, the Board may suspend a proceeding pending determination of another proceeding where only one of the parties is involved. See TBMP § 510.02(a). It is not necessary that the civil action or other proceeding be conclusively determinative of the Board proceeding or that it moot out the Board proceeding. Rather, it only need to have a bearing on issues before the Board. See, e.g., *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

In its Order, the TTAB reviewed the pleadings in the civil action and determined that the outcome therein may have a bearing on the TTAB proceeding. The TTAB recognized that the complaint (“Complaint”) asks the United States Court of Federal Claims to find NPS to be in breach of contract regarding a concession contract and to establish the fair market value of certain property, including the registered trademarks at issue in the TTAB proceeding.³

While the Court is not considering the trademark registration claims asserted in the Board proceeding, the Court may interpret the contract in a manner that may have

³ NPS asserts that the Court of Federal Claims is not empowered to determine a claim of trademark infringement, a claim to cancel registrations, or to review a decision of either the TTAB or the USPTO Director. However, such matters are not asserted in the court Complaint. Nor do they form the bases for the suspension ordered by the Board.

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a bearing on the issues present in the cancellation proceeding. Pointing to specific provisions in the contract at issue before the Court of Federal Claims, the Board determined that the Court “may consider and even reach a determination of ownership rights in the marks at issue.” Thus, the ownership status of the registrations that Petitioner is asking TTAB to cancel may be adjudged by the Court. So recognizing, the TTAB granted Respondent’s motion to suspend.

The Director finds that the TTAB did not commit clear error or abuse its discretion in granting Respondent’s motion to suspend the cancellation.

DECISION

The petition is denied. This TTAB proceeding will be docketed appropriately in view of the suspension pending final determination of the case between the parties pending in the Court of Federal Claims.

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Date: August 5, 2016

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