

Exhibits

TTAB



04-03-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #73

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 31, 2003.

Brian P. O'Donnell

Name of applicant, assignee, or Registered Rep.

Brian O'Donnell

Signature

03/31/03

Date

Docket No.: 41196-10691

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

MILTON SALES, INC.

Opposer,

v.

UNIVERSAL MANUFACTURING
COMPANY, INC.

Applicant.

)
) Opposition No.: 91154650

)
) Serial No.: 76/334,453

)
) Mark: RACING FOR CASH

03 APR 18 PM 9:30

TTAB-11111111

MOTION TO SUSPEND

Pursuant to 37 C.F.R. § 2.117(a), TBMP § 510.02(a), Universal Manufacturing Company, Inc. ("Applicant") hereby moves to suspend all proceedings in Opposition No. 91154650 pending resolution of a civil action between the parties herein. In support of its motion, Applicant states as follows:

1. On October 16, 2002, Milton Sales, Inc. ("Opposer") filed a Notice of Opposition to registration of Applicant's mark RACING FOR CASH, Serial No. 76/334,453. On October 30, 2002, Opposer filed a Motion to Amend Notice of Opposition and an Amended Notice of Opposition. *See* Ex. 1.

2. On November 16, 2001, Opposer filed a complaint against Applicant in the Southern District of West Virginia, Civil Action No. 2:01-01046, Hon John T. Copenhaver, Jr. presiding (“the West Virginia action”), alleging: (1) that Applicant “was never and is not the owner” of Applicant’s federal registration for the mark CASH RACE, Reg. No. 2,049,212 , (2) that Applicant unlawfully registered that mark “in violation of The Lanham Act,” and (3) requesting cancellation of Applicant’s CASH RACE registration. *See* Ex. 2, Complaint at ¶ 24, and Ex. C to Complaint; *see also* Prayer for Relief at p. 10 (last paragraph) (“That the U.S. Patent and Trademark Office cancel Defendant’s Registrations identified in Exhibit C.”).

3. On December 18, 2001, Applicant filed an answer in the West Virginia action denying Opposer’s allegations. Applicant also filed counterclaims for declaratory relief alleging, *inter alia*, that Opposer: (1) through its complaint has asserted ownership of Applicant’s federal registration for the mark CASH RACE (Reg. No. 2,049,212), and (2) through its own filing of a U.S. trademark application for the identical mark RACING FOR CASH, Ser. No. 76/335,819, has asserted ownership of Applicant’s U.S. trademark application for the mark RACING FOR CASH, Ser. No. 76/334,453, the application that is the subject of the instant Opposition. *See* Ex. 3 , Answer, Affirmative Defenses and Counterclaims p. 3 at ¶ 24, pp. 11-12, ¶¶ 24-27, pp. 13-14, ¶¶ 35-37, and p. 16, ¶¶ 50-51.

4. In its Reply to Counterclaims filed in the West Virginia action on January 7, 2002, Opposer denied Applicant’s allegations. *See* Ex. 4, Plaintiff’s Reply to Counterclaims p. 4 at ¶¶ 24-27, pp. 5, ¶¶ 35-37, and pp. 7-8, ¶¶ 50-51. Opposer further asserted in its Affirmative Defenses that it “is the owner of the marks [including CASH RACE and RACING FOR CASH] . . . alleged in the Counterclaims.” *See* Ex. 4, ¶ 81

5. “Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.” 37 C.F.R. § 2.117(a), TBMP § 510.02(a).

6. The parties to this Opposition are the same as the parties to the West Virginia action filed by Opposer. As the claims in the West Virginia action include ownership, trademark infringement and false designation of origin with regard to, *inter alia*, the CASH RACE and RACING FOR CASH marks, the decision in the West Virginia action may include a determination of Opposer's purported rights in those marks. Accordingly, any determination of Opposer's rights to the CASH RACE and RACING FOR CASH marks in the West Virginia action will directly bear on the issues before the Board. It is generally the Board's policy to suspend when the parties are engaged in such a civil action. *See, e.g., Boyds Collection, Ltd. v. Herrington & Co.*, 2003 TTAB LEXIS 11 (TTAB January 16, 2003).

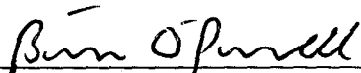
7. Moreover, to the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, which is the case here, the decision of the West Virginia federal court is binding upon the parties before the Board, while the decision of the Board with respect thereto is not binding upon the West Virginia federal court. *See, e.g., Society of Mexican American Engineers and Scientists, Inc. v. GVR Public Relations Agency, Inc.*, 2002 TTAB LEXIS 697 (TTAB November 6, 2002); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold*, 650 F. Supp. 563 (D. Minn. 1986).

In the interest of judicial economy and consistent with the Board's discretionary authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, Applicant respectfully requests that its Motion to Suspend be GRANTED and that Opposition No. 91154650 be suspended until final disposition of the civil action between the parties.

Date: March 31, 2003

Respectfully submitted,

UNIVERSAL MANUFACTURING COMPANY

By: 
Brian P. O'Donnell,
One of Its Attorneys

Terrence J. Truax
Brian P. O'Donnell
JENNER & BLOCK
One IBM Plaza
Chicago, Illinois 60611
Tel: (312) 222-9350
Fax: (312) 527-0484
E-mail: bodonnell@jenner.com

CERTIFICATE OF SERVICE

I, Brian P. O'Donnell, attorney for Applicant, hereby certify that a copy of this MOTION TO SUSPEND, which was filed with the TTAB on March 31, 2003, a copy of which is attached, was duly served upon Bruce A. Tassan, Tassan Law Firm, 4143 North 27th Street, Arlington, VA 22207-5211, attorney for Opposer, by First Class Mail, postage prepaid, on March 31, 2003.