

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: April 12, 2005

Opposition No. **91160201**

PlanCom, Inc

v.

Millenbah, Philip L.

Cheryl Goodman, Interlocutory Attorney:

On March 4, 2005, the Board requested that applicant submit a copy of its motion to suspend and a copy of the civil complaint so that it could consider applicant's request to suspend under Trademark Rule 2.117(a).¹

On March 18, 2005, applicant submitted an unsigned copy of the civil complaint.² On April 6, 2005 opposer filed a paper advising that it did not oppose applicant's motion to suspend for civil action.

The Board will now consider applicant's motion to suspend for civil action, filed March 19, 2005, and opposer's motion to suspend proceedings pending

¹ Applicant has also provided a copy of the certificate of mailing which accompanied the motion to suspend, dated January 24, 2005 but not proof of receipt by the Office. The original motion has never been associated with the proceeding file.

² Applicant submitted an unsigned copy of the complaints, both state court actions, advising that it could provide the Board with filed copies of the complaint. No case number has been provided.

consideration of applicant's motion to suspend for civil action and to extend its testimony period, filed February 2, 2005.

The Board turns first to opposer's motion to suspend and extend which applicant has opposed.

Opposer seeks suspension of proceedings due to the fact that applicant filed its motion to suspend for civil action during opposer's testimony period on or about January 24, 2005; that the filing of applicant's motion did not stay opposer's testimony period; that opposer's testimony period might run prior to decision on applicant's motion to suspend for civil action; and that opposer would be in the position of having to request a reopening of its testimony period if the dates had run. Opposer also seeks extension of its testimony period upon determination of applicant's motion to suspend in the event that applicant's suspension request is not granted so that it has an opportunity to renotice its testimonial depositions which it cancelled upon the Board's issuance of a suspension order on January 31, 2005 due to withdrawal of opposer's counsel.³

Applicant opposed opposer's motion to suspend and extend, arguing that opposer's motion should be denied

³ Opposer's testimony period opened on January 5, 2005. Opposer's counsel filed a notice of withdrawal on January 11, 2005. Notice of substitution of counsel was filed with the Board on January 25, 2005 but was not entered into the proceeding file until after the Board suspension order had issued.

because opposer waited until the end of its testimony period to schedule the depositions; that applicant received delayed notice of the depositions due to the notices being mailed to applicant's San Francisco address rather than applicant's New Mexico address⁴; and that applicant has sent correspondence to opposer requesting that the parties engage in settlement negotiations.

Upon consideration of the parties' arguments, the Board finds good cause for granting an extension of opposer's testimony period. See Fed. R. Civ. P. 6. Accordingly, opposer's motion to extend is granted and dates will be reset accordingly. With respect to opposer's request to suspend, inasmuch as the Board continued suspension in its March 4, 2005 order after substitution of counsel was filed, opposer's request to suspend is moot.

The Board now turns to applicant's request to suspend for civil action. It is applicant's position that the issues to be determined in the civil litigation include his "interests and rights in Plancom . . . which include the right to the trademark."

Suspension of a Board proceeding in view of a civil action is discretionary with the Board and generally is

⁴ The Board will update its records to reflect applicant's New Mexico address as its correspondence address. The Board had changed the correspondence address to applicant's San Francisco address based on correspondence filed by applicant on June 3, 2004.

based on an evaluation by the Board of the pleadings in the civil action. See TBMP Section 510.02(a). Whether or not a civil proceeding is actually dispositive requires a determination by the Board as to whether the court decision will have preclusive effect on the Board proceeding.

In the present case, the litigation between the parties is in state court. The complaint in one of the civil suits seeks damages for breach of fiduciary duty, legal malpractice, negligent misrepresentation, fraud and civil conspiracy against multiple parties, including opposer's sole shareholder Darryl Daugherty. The complaint in the second state court civil action against Plancom and Darryl Daugherty seeks damages based on breach of oral contract and an accounting. The Board finds that final disposition of either of these state civil actions will not directly affect or have a bearing on the issues in this proceeding.

In view thereof, applicant's motion to suspend for civil action is denied.⁵

Proceedings are resumed.

Trial dates are reset as follows:

⁵ If the parties are involved in settlement negotiations, a consented motion or stipulation to suspend for purposes of the parties' settlement negotiations may be appropriate. TBMP Section 510.03(a).

DISCOVERY PERIOD TO CLOSE:

CLOSED

30-day testimony period for party in position of plaintiff
to close:

June 13, 2005

30-day testimony period for party in position of defendant
to close:

August 12, 2005

15-day rebuttal testimony period for party in position of
plaintiff to close:

September 26, 2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.