

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

IN THE MATTER OF APPLICATION SERIAL NO. 78/421981  
PUBLISHED IN THE OFFICIAL GAZETTE ON APRIL 5, 2005

SNACKMASTERS, INC. ) Opposition No.: 91165467  
 )  
 ) Opposer, )  
 )  
 ) v. )  
 )  
 ) HICKORY FARMS, INC. )  
 )  
 ) Applicant. )

TTAB

**APPLICANT HICKORY FARM'S REPLY BRIEF ON MOTION  
TO SUSPEND OPPOSITION IN VIEW OF POTENTIALLY  
DISPOSITIVE DISTRICT COURT PROCEEDINGS**

Applicant, Hickory Farms, Inc. (hereinafter "Applicant" or "Hickory Farms") submits this Reply in support of its Motion to Suspend Proceedings In View of District Court Proceedings. The Opposer argues that Suspension should be denied because the Complaint filed in the District Court does not refer to the existing Opposition proceedings, or assertedly the factual basis for the Opposition. Further, Opposer apparently claims that it will contest in the Federal District Court for the Northern District of Illinois the personal jurisdiction over the Opposer corporation within that District.

The Complaint as filed by Applicant Hickory Farms was provided as an Exhibit to the Motion to Suspend. The Complaint



09-21-2005

did not usurp Snackmasters' own choice in pleading, or not, of any affirmative defenses or counter-claims which it might choose to assert in response to the trademark infringement Complaint filed by Applicant, so the Opposer has no real claim that the substance or asserted claims of the Opposition will somehow not be considered in the District court trademark infringement action. However, that hardly detracts from the fact that the District Court infringement action between the same parties over the same marks is potentially dispositive of all claims in this action, as well as resolving potentially other claims involving Opposer's use of the mark and issues about damages or other claims. Even should Snackmasters use its discretion to decide not to assert any affirmative defenses or counterclaims in the District Court case, in contrast to the grounds that it has pleaded in this Opposition, such an action would have potentially dispositive res judicata controlling effects in an Opposition or other proceedings between the parties.

Snackmasters' arguments that the Complaint is facially defective are addressed to the wrong forum - to the Board, not the affected District Court. The Complaint is a notice pleading which properly alleges jurisdiction and venue over the Defendant, and properly alleges acts and business conduct in the Northern District of Illinois. Complaint at ¶5. Should

Snackmasters follow through with its stated intention, Opposition at page 5, to file a Motion to Dismiss/Transfer<sup>1</sup>, the merits of any such Motion would be addressed to, and decided by, the affected District Court, rather than the Board. The purpose of the suspension sought is to avoid the Board and the parties the wasted effort and expense and duplication of ongoing dual track litigation, when the District Court action plainly is potentially dispositive of this action between the same parties over the same marks.

Despite the meritless protestations of Opposer to the contrary, the obvious purpose of suspension in avoiding dual track litigation amply applies to this Opposition. By suspension the attendant cost in time, effort, expense and duplication of filings, discovery, motions, testimony, hearings and proceedings, and all the potential for waste of this Board and the parties resources, are avoided. The District Court has more comprehensive jurisdiction to hear the infringement claims that the Board cannot entertain (i.e. involving the use of the mark and the entry of an injunction), and to make a final binding judgment on the parties over the ownership and validity of the subject marks, should that be disputed in the District Court case.

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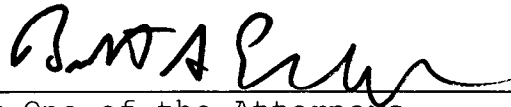
<sup>1</sup> Were the case transferred, for which there is no basis here, suspension pending the disposition of the case would still be in order.

The parties have admitted, in the Notice of Opposition (¶10) the Answer (¶10 & Exhibit A), that this dispute between the parties first began with Applicant's demands to Opposer to cease use of its BEEF STICK and TURKEY STICK marks. Applicant simply seeks to have its infringement claims determined in a forum that can do so, the District Court, while naturally avoiding the duplication of concurrent dual track litigation before both the District Court and this Board at the same time.

Avoidance of such duplication in the face of potentially dispositive District Court case amply justifies suspension in this Opposition. Applicant in its subject Motion for Suspension has requested the proceedings in this Opposition action be suspended pending the disposition of the pending District Court Action, and should the District Court case not fully resolve the dispositive issues in these proceedings, the opposition be resumed with the resetting of all relevant time periods. Additionally, the Applicant's responses to pending discovery would be resumed and subject to resetting in the unlikely even that the District Court case does not fully resolve the dispositive issues in these proceedings.

Based upon the foregoing it is respectfully requested that these proceedings be suspended under Trademark Rule 2.117(a) pending the disposition of the District Court Action.

Respectfully submitted,



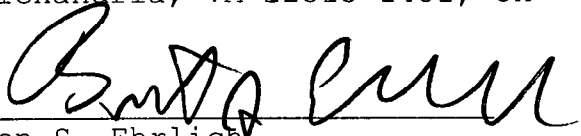
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By One of the Attorneys  
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**CERTIFICATE OF MAILING**

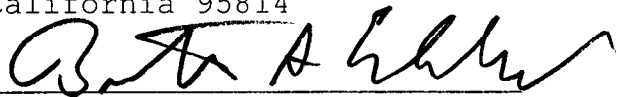
I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to ATTN: Box TTAB, Assistant Commissioner for Trademarks, U.S. Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on September 19, 2005.

  
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Burton S. Ehrlich

**CERTIFICATE OF SERVICE**

The undersigned, one of Applicant's attorneys, hereby certifies that on September 19, 2005, he caused true and correct copies of the foregoing APPLICANT HICKORY FARM'S REPLY BRIEF ON MOTION TO SUSPEND OPPOSITION IN VIEW OF POTENTIALLY DISPOSITIVE DISTRICT COURT PROCEEDINGS to be served upon Opposer's counsel by first class mail, postage prepaid, on this 19<sup>th</sup> day of September, 2005 To Opposer's Counsel at the following address:

Mr. R. Michael West  
Law Offices of R. Michael West  
455 Capitol Mall, Suite 405  
Sacramento, California 95814

  
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Burton S. Ehrlich