

ORIGINAL

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

| | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>FORT JAMES OPERATING COMPANY and GEORGIA-PACIFIC CORPORATION,</p> <p>Opposers,</p> <p>v.</p> <p>SAMUEL LOUIS PAUL,</p> <p>Applicant.</p> | <p>Ser. No. 78340495</p> <p>Mark: BRAWNY</p> <p>Opposition No. 91167043</p> <p>RECEIVED 2005 NOV 22 AM 9: 51 BOARD OF PATENT APPEALS AND INTERFERENCES</p> |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

**MOTION TO SUSPEND; MEMORANDUM OF
POINTS AND AUTHORITIES IN SUPPORT THEREOF**

Applicant Samuel Louis Paul ("Mr. Paul") hereby moves to suspend this Opposition proceeding for two main reasons: (1) the action commenced in the District of Nevada on April 14, 2005, styled: NexTep, Inc. v. Fort James Operating Company, et. al., Case No. CV-N-05-0227-ECR-RAM (the "Nevada Action"); and (2) the Board's previous Orders suspending Opposition Nos. 91164081, 91165601, 91165736, and 91165737 and Cancellation No. 92044396. Because the outcome of the Nevada Action will have a bearing on the issues before the Board, and the Board has already suspended 5 proceedings involving the relevant parties and same issues, this Motion should be granted in full.

I. BACKGROUND

Mr. Paul is an owner and the secretary of NexTep, Inc. ("NexTep"). May 19, 2005 declaration of Sam Paul ("Paul Decl."), ¶ 1¹. NexTep is a Nevada corporation with its principal place of business located in Reno, Nevada. Id. NexTep is in the business of developing,

¹Applicant incorporates by reference his May 19, 2005 declaration in Opposition to Opposers' Motion to Dismiss filed in the Nevada Action. The Paul Decl. is attached hereto. Applicant also incorporates by reference all of the

manufacturing, marketing, and selling innovative household goods, which include polyethylene bags and trash cans. Paul Decl., ¶ 2. NexTep is the owner of incontestable United States Federal Trademark Registration No. 0940243 (“243 Reg.”) for the trademark “Brawny” in International Class 20 for polyethylene bags. Id. On December 13, 2003, Mr. Paul filed intent to use application Serial No. 78340495 (“495 App.”) for the mark “Brawny” in International Classes 16 for “disposable litter pan plastic liner bags”; 18 for “pet leashes, pet collars, nonmetal pet tie-out cables, non-metal pet trolley cables, and pet clothing”; 21 for “pet litter boxes”; and 28 for “pet toys.” November 17, 2005 declaration of Matthew D. Francis (“Francis Decl.”), ¶ 2, Exhibit A.

On April 14, 2005, Mr. Paul’s company, NexTep, filed a declaratory judgment action in the United States District Court for the District of Nevada. Francis Decl., ¶ 3, Exhibit B, pp. 1-6. In the Nevada Action, NexTep asked the Court to declare, among other things, that its rights in the “Brawny” mark are superior to Opposers’ alleged rights, and that NexTep’s use of that mark does not infringe any of Opposers’ alleged rights. Francis Decl., ¶ 3, Exhibit B, pp. 5-6.

On or about July 8, 2005, the PTO received an extension of time to oppose from Opposers, and on July 13, 2005, the PTO granted this extension. On October 21, 2005, this Opposition proceeding was instituted. The bases for this Opposition are: (1) Opposers’ rights in the Brawny mark are superior to the mark at issue; (2) registration of the ‘495 App. would cause confusion in the consuming public pursuant to 15 U.S.C. §§ 1052(d) and 1125(a); and (3) registration of the ‘495 App. will dilute Opposers’ alleged Brawny marks in violation of 15 U.S.C. §§ 1063(a) and 1125(c). Opposition, p. 5, ¶¶ 15-17.

Opposers have filed a plethora of proceedings against Mr. Paul individually, and the

arguments contained in his Motions to Suspend Opposition Nos. 91164081, 91165601, 91165736, and 91165737.

company that assigned NexTep all rights, title and interest in the '243 Reg. – Brawny Plastics, Inc. (“BPI”). To date, Opposers have filed and/or instituted 11 overlapping proceedings against Mr. Paul or BPI. Francis Decl., ¶ 4, Exhibit C. The first two Board proceedings – Opposition No. 91164081 and Cancellation No. 92044396 – were consolidated and suspended by the Board on July 19, 2005 in light of the Nevada Action. Francis Decl., ¶ 5, Exhibit D. Similarly, Opposition Nos. 91165601, 91165736, and 91165737 have all been suspended as well in light of the Nevada Action. Francis Decl., ¶¶ 6-8, Exhibit E-G.

The allegations set forth in paragraphs 17-19 of Opposers’ Notice of Opposition in Opposition No. 91164081, and paragraphs 14-16 in Opposers’ Notices of Opposition in Opposition Nos. 91165601, 91165736, and 91165737 are virtually identical to paragraphs 15-17 of Opposers’ Notice of Opposition in this proceeding. *Id.* It is important to note that Opposers cite the same Lanham Act statutes in all of their Notices of Opposition – 15 U.S.C. §§ 1125, 1052, and 1063. *See Id.*

No discovery has taken place in this proceeding to date. Francis Decl., ¶ 9.

II. ARGUMENT

TBMP Rule 510.02(a) provides that “[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.” *Id.*, citing The Other Telephone Co. v. Connecticut Nat’l Telephone Co., Inc., 181 U.S.P.Q. 125, 126 (TTAB1974), Tokaido v. Honda Assoc., Inc., 179 U.S.P.Q. 861, 862 (TTAB 1973), Whopper-Burger v. Burger King Corp., 171 U.S.P.Q. 805, 807 (TTAB 1971)(citations omitted). Professor McCarthy also notes that “[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.” 5 J.T. McCarthy, McCarthy on Trademarks

and Unfair Competition ("McCarthy") § 32:47, 32:97-99 (4th Ed. 2004), citing Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 130 U.S.P.Q. 412, 413 n. 1 (CCPA 1961), and Whopper-Burger, 171 U.S.P.Q. at 807. This is the case even when a court action is commenced after commencement of the Board proceeding. 5 McCarthy § 32:47, 32:98-99, citing Midland Cooperatives, Inc. v. Midland Int'l Corp., 164 U.S.P.Q. 579, 580 (CCPA 1970).

Moreover, this Board proceeding is non-binding, and can be the subject of district court litigation pursuant to 15 U.S.C. § 1071(b) if either party takes issue with the Board's decision. See E. & J. Gallo Winery v. F. & P. S.p.A., 899 F. Supp. 465, 468, 35 U.S.P.Q.2d 1857, 1859 (E.D. Cal. 1994), citing Goya Foods, Inc. v. Tropicana Products, Inc., 846 F.2d 848, 851, 6 U.S.P.Q.2d 1950, 1953 (2nd Cir. 1988); Sam S. Goldstein Indus., Inc. v. Botany Indus., Inc., 301 F. Supp. 728, 731, 163 U.S.P.Q. 442, 443 (D.C.N.Y. 1969); 5 McCarthy § 32:49, 32-102.1.

When this authority is considered in light of the facts discussed above, it is clear that this Opposition proceeding should be immediately suspended. Specifically, the relevant parties and the same issues are involved in this proceeding and the Nevada Action, and the final determination of the Nevada Action will have a bearing on the issues before the Board. See supra.

Like the pending Opposition, the Nevada Action seeks to determine priority and ownership of the "Brawny" mark as well as the alleged infringement and injury to Opposers. Id. As a result, there is no need to duplicate efforts in both the District of Nevada and this Board and force the parties to incur unnecessary legal expenses in both venues. Further, it would be wasteful to take up this Board's time with issues that are ripe for determination by the District Court. Finally, the Board has already considered and granted NexTep's and BPI's Motions to Suspend Oppositions Nos. 91164081, 91165601, 91165736, and 91165737 and Cancellation No.

92044396, and the same determination should be made here. Francis Decl., ¶¶ 5-8, Exhibits D-G.

Finally, it is important to note that while Mr. Paul is not named as a Plaintiff in the Nevada Action, the Board has found this fact inconsequential in its respective Orders suspending Opposition Nos. 91165601, 91165736, and 91165737. Francis Decl., ¶¶ 6-8, Exhibits E-G. Specifically, in each of these Orders, the Board has stated: “[a]lthough the parties in the civil action are not identical to those in the opposition, the decision in the civil action is likely to have a direct bearing on the outcome of this opposition.” Id.

III. CONCLUSION

In light of the foregoing, Mr. Paul’s Motion to Suspend should be granted in full.

Dated: November 17, 2005

Respectfully Submitted,

By: 

Michael D. Rounds
Matthew D. Francis
WATSON ROUNDS
5371 Kietzke Lane
Reno, Nevada 89511
(775) 324-4100

Attorneys for Applicant
Samuel Louis Paul

CERTIFICATE OF MAILING

I certify that I am an employee of the Law Offices of Watson Rounds, a Professional Corporation, and that on this date the document entitled **MOTION TO SUSPEND;**
MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addresses" service with Express Mail Label No. ED027952420US for delivery to:

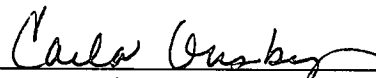
Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

CERTIFICATE OF SERVICE

I certify that I am an employee of the Law Offices of Watson Rounds, a Professional Corporation, and on this date the document entitled **MOTION TO SUSPEND;**
MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF is being deposited with the U.S. Postal Service, first class postage prepaid, for delivery to:

Judith A. Powell
James H. Sullivan
Carrie A. Johnson
Kilpatrick Stockton LLP
Suite 2800
1100 Peachtree Street
Atlanta, Georgia 30309

Dated: November 17, 2005



Carla Ousby

1
2 DECLARATION OF SAM PAUL

3 I, Sam Paul, do hereby declare and state:

4 1. I am an owner and the secretary of NexTep, Inc.
5 ("NexTep"). NexTep is a Nevada corporation with its principal
6 place of business located in Reno, Nevada. This declaration is
7 based upon my personal knowledge and is made in support of
8 NexTep's Opposition to Defendants' Georgia-Pacific Corporation's
9 and Fort James Operating Company's Motion to Dismiss for lack of
10 subject matter jurisdiction pursuant to Fed. R. Civ. P.
11 12(b)(1).
12

13 2. NexTep is in the business of developing,
14 manufacturing, marketing, and selling innovative household
15 goods, which include polyethylene bags and trash cans. NexTep is
16 the owner of all rights, title and interest to incontestable
17 U.S. Registration No. 940243 ("243 Reg.") for the "Brawny"
18 mark, and U.S. Application Serial No. 78268015 for the same
19 mark.
20

21 3. On October 8, 2003, I met with Robert M. Lorys, the
22 Executive Vice President of Consumer Marketing for Georgia-
23 Pacific, and Gino F. Biondi, Director of Marketing for Georgia
24 Pacific's paper towel division. Also present at this meeting
25 was Joe Farinella of NexTep. Mr. Farinella is a member of the
26 board of directors for NexTep, and is also a shareholder in the
27 company. This meeting was held at Georgia-Pacific's offices
28 located in Atlanta, Georgia.

1
2 4. During that meeting, I discussed NexTep's potential
3 license of the "Brawny" lumberjack logo, including trademark
4 issues surrounding such use with Messrs. Lorys, Biondi, and
5 Farinella. Also during that meeting, Mr. Lorys told me and Mr.
6 Farinella that if NexTep did not enter into a license agreement
7 for the "Brawny" lumberjack logo with Georgia-Pacific, Georgia-
8 Pacific's lawyers would be "carefully watching" NexTep's use of
9 the "Brawny" logo.
10

11 5. The October 8, 2003 meeting discussed above did
12 not result in a license agreement between NexTep and Georgia-
13 Pacific.
14

15 6. I have read the May 19, 2005 declaration of Joe
16 Farinella, and agree with all of the facts set forth in that
17 declaration.
18

19 I declare under penalty of perjury that the foregoing
20 is true and correct to the best of my knowledge.
21

22 Dated: 5-19-05

23 By: 

24 SAM PAUL
25
26
27
28

DECLARATION OF MATTHEW D. FRANCIS

I, Matthew D. Francis, do hereby declare and state:

1. I am counsel of record for Samuel Louis Paul ("Mr. Paul") in this Opposition proceeding. This declaration is based upon my personal knowledge and is made in Support of Mr. Paul's Motion to Suspend; Memorandum of Points and Authorities in Support Thereof.

2. Attached hereto as Exhibit A is a true and correct copy of a computer printout from the www.uspto.gov web site showing Serial No. 78/340,495 for the mark "Brawny."

3. Attached hereto as Exhibit B is a true and correct copy of the Complaint filed in the District of Nevada on April 14, 2005, styled: NexTep, Inc. v. Fort James Operating Company, et. al., Case No. CV-N-05-0227-ECR-RAM.

4. Attached hereto as Exhibit C is a true and correct copy of a computer printout from the www.uspto.gov web site showing all of the proceedings filed and/or instituted by Opposers in the TTAB against Mr. Paul and Brawny Plastics, Inc. ("BPI").

5. Attached hereto as Exhibit D is a true and correct copy of a July 19, 2005 Order issued by the Board in Opposition No. 91164081 and Cancellation No. 92044396 granting BPI's and NexTep, Inc.'s respective Motions to Suspend those proceedings.

6. Attached hereto as Exhibit E is a true and correct copy of a October 26, 2005 Order issued by the Board in Opposition No. 91165601 granting Mr. Paul's Motion to Suspend that proceeding.

7. Attached hereto as Exhibit F is a true and correct copy of a November 16, 2005 Order issued by the Board in Opposition No. 91165736 granting Mr. Paul's Motion to Suspend that proceeding.

8. Attached hereto as Exhibit G is a true and correct copy of a October 16, 2005 Order issued by the Board in Opposition No. 91165737 granting Mr. Paul's Motion to Suspend that proceeding.

9. No discovery has taken place in this proceeding to date.

///

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Dated: 11/17/05

By: 
MATTHEW D. FRANCIS



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BRAWNY

| | |
|-----------------------------|----------------------------------------------------------------------------------------------------------------------------------------------|
| Word Mark | BRAWNY |
| Goods and Services | IC 028. US 022 023 038 050. G & S: Pet toys |
| | IC 018. US 001 002 003 022 041. G & S: Pet leashes, pet collars, nonmetal pet tie-out cables, non-metal pet trolley cables, and pet clothing |
| | IC 016. US 002 005 022 023 029 037 038 050. G & S: Disposable litter pan plastic liner bags |
| | IC 021. US 002 013 023 029 030 033 040 050. G & S: Pet litter boxes |
| Standard Characters Claimed | |
| Mark Drawing Code | (4) STANDARD CHARACTER MARK |
| Design Search Code | |
| Serial Number | 78340495 |
| Filing Date | December 13, 2003 |
| Current Filing Basis | 1B |
| Original Filing Basis | 1B |
| Published for Opposition | June 7, 2005 |
| Owner | (APPLICANT) Paul, Samuel Louis INDIVIDUAL UNITED STATES PO Box 11188 Reno NEVADA 89510 |
| Attorney of Record | Andrew D. Gathy |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Live/Dead Indicator | LIVE |

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FILED
05 APR 14 PM 2:04
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CLERK
BY _____
DEPUTY _____

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEVADA

CV-N-05-0227-ECR-RAM

Plaintiff,) COMPLAINT
)
) JURY DEMAND
)
 RATING)
 ynia)
 GEORGIA PACIFIC)
 Georgia)
)
)
)
 Defendants.)

Plaintiff NexTep, Inc. ("Plaintiff"), for its Complaint against Defendants Fort James Operating Company ("Fort James") and Georgia-Pacific Corporation ("Georgia-Pacific") (collectively "Defendants") alleges the following:

JURISDICTION AND VENUE

1. This is an action for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202 from claims of trademark infringement made by Defendants under 15 U.S.C. §§ 1125, 1052 and 1063.

1 Jurisdiction is based on federal question pursuant to 28 U.S.C.
2 § 1338(a) and (b).

3 2. Venue is proper pursuant to 28 U.S.C. §§ 1391(b) and
4 in the Reno Division of the District of Nevada.

5 THE PARTIES

6 3. Plaintiff is a Nevada corporation with its principal
7 place of business located at 1575 Delucchi Lane, Suite 218,
8 Reno, Nevada 89502.

9 4. Upon information and belief, Fort James is a Virginia
10 corporation with a principal place of business located at 133
11 Peachtree Street, N.E., Atlanta, Georgia 30303.

12 5. Upon information and belief, Georgia-Pacific is a
13 Georgia corporation with a principal place of business located
14 at 133 Peachtree Street, N.E., Atlanta, Georgia 30303.

15 6. Upon information and belief, Fort James is a wholly
16 owned subsidiary of Georgia-Pacific.

17 FACTS

18 7. Plaintiff is a Nevada-based company that is in the
19 business of developing, manufacturing, marketing, and selling
20 innovative household goods. Such goods include, but are not
21 limited to, polyethylene bags and trash cans.

22 8. Plaintiff is the owner of United States Federal
23 Trademark Registration No. 0940243 (" '243 Reg.") for the
24 trademark "Brawny" in International Class 20 for polyethylene
25 bags. A copy of the '243 Reg. is attached hereto as Exhibit A.
26 Plaintiff and its predecessors have used this mark in commerce
27
28

1 since July 6, 1971 on polyethylene bags. Id. Plaintiff was
2 assigned all rights, title, and interest in the '243 Reg. by
3 Brawny Plastics, Inc. ("BPI") on August 6, 2003. This
4 assignment was subsequently recorded in the United States Patent
5 and Trademark Office ("PTO"). A copy of this assignment is
6 attached as Exhibit B.

7 9. Plaintiff is also the owner of United States Federal
8 Trademark Application Serial No. 78/268,015 ("015 App.") for
9 the trademark "Brawny" in International Class 6 for "metal trash
10 receptacles for commercial, household and domestic use," and
11 International Class 21 for "plastic trash receptacles for
12 household use." Plaintiff was assigned all rights, title, and
13 interest in the '015 App. by BPI on March 17, 2005, and this
14 assignment was subsequently recorded in the PTO. A copy of this
15 assignment is attached hereto as Exhibit C. Plaintiff commenced
16 using the "Brawny" mark in conjunction with the sale of plastic
17 trash receptacles on at least June 21, 2004.

19 10. While Plaintiffs awaited a Notice of Allowance from
20 the PTO, Defendants filed a Notice of Opposition (the
21 "Opposition") in the Trademark Trial and Appeal Board regarding
22 the '015 App. on or about January 20, 2005. A copy of this
23 Notice of Opposition is attached hereto as Exhibit D.

24 11. In the Opposition, Defendants allege that Plaintiff's
25 use of the "Brawny" trademark for paper goods and cleaning
26 products provide it with superior rights in the "Brawny" mark.
27 Id. Defendants further allege that Plaintiff's use of the
28

1 "Brawny" mark is likely to cause confusion in the minds of the
2 consuming public, is likely to injure their business
3 reputations, and is likely to dilute the distinctive quality of
4 their "Brawny" mark. Id., citing 15 U.S.C. §§ 1052(a), 1063(a),
5 and 1125 (a, c). As a result, Defendants request that
6 Plaintiff's registration for the '015 App. be refused. Id.

7 12. In addition to the foregoing, on or about March 28,
8 2005, Defendants filed a Petition for Cancellation to cancel the
9 '243 Reg., which Plaintiff owns all rights, title and interest
10 in. A copy of this Petition for Cancellation is attached hereto
11 as Exhibit E.

12 13. The basis for Defendants' Petition is that NexTep's
13 predecessor BPI allegedly made fraudulent statements to the PTO
14 regarding its use of the Brawny mark, and that the assignment to
15 NexTep of the '243 Reg. was a sham transaction "in contravention
16 of the Lanham Act." Exhibit E.

17
18 CLAIM I
19 DECLARATORY RELIEF
20 (28 U.S.C. §§ 2201-2202)

21 14. Plaintiff repeats, realleges and reiterates each and
22 every paragraph set forth above as if fully set forth herein.

23 15. By reason of the foregoing allegations, an actual case
24 or controversy has arisen and exists between Plaintiff and
25 Defendants as to the ownership, infringement, enforceability,
26 and validity of the "Brawny" mark and Defendant's federal
27 trademark application(s) and registration.
28

1 16. On information and belief, Defendants' use of the
2 "Brawny" mark is junior to Plaintiff's use, and their claims are
3 baseless and injurious.

4 17. Given the nature of Defendants' charges, Plaintiff
5 will continue to suffer harm and damage unless this Court
6 declares that Plaintiff's rights are superior to Defendants' for
7 at least the goods described in the '243 Reg., the '015 App.,
8 and all related goods.

9 18. Further, given the nature of Defendants' charges,
10 Plaintiff will continue to suffer harm and damage unless this
11 Court declares that Plaintiff's registration and use of the
12 "Brawny" mark in conjunction with the sale of "plastic trash
13 receptacles for household use," "polyethylene bags," and related
14 goods does not infringe any of Defendants' alleged rights in the
15 "Brawny" mark.
16

17 PRAYER FOR RELIEF

18 WHEREFORE, Plaintiff respectfully requests this Court for
19 the following relief:

20 1. That this Court declare that Plaintiff's rights in the
21 "Brawny" trademark are superior to Defendants;

22 2. That Plaintiff's use of the "Brawny" trademark does
23 not violate 15 U.S.C. § 1052(a) as alleged by Defendants;


24 3. That Plaintiff's use of the "Brawny" trademark does
25 not violate 15 U.S.C. § 1063(a) as alleged by Defendants;

26 4. That Plaintiff's use of the "Brawny" trademark does
27 not violate 15 U.S.C. §§ 1125(a, c) as alleged by Defendants;
28

- 1 5. That the assignment of the '243 Reg. was valid;
2 6. That all of Defendants' trademark registrations and
3 applications be canceled;
4 7. For attorney's fees and costs pursuant to 15 U.S.C.
5 § 1117; and
6 8. For such other and further relief as this Court
7 deems just and proper.
8

9 DATED this 14 day of April, 2005.

10 WATSON ROUNDS

11 By: 
12 Michael D. Rounds
13 Matthew D. Francis
14 5371 Kietzke Lane
15 Reno, Nevada 89511
16 (775) 324-4100


17 Attorneys for Plaintiff
18 NexTep, Inc.
19
20
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22
23
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26
27
28

JURY DEMAND

Pursuant to Fed. R. Civ. P. 38(b), NexTep, Inc. hereby
demands a jury trial on all issues triable by jury.

DATED this 14 day of April, 2005.

WATSON ROUNDS

By: 
Michael D. Rounds
Matthew D. Francis
5371 Kietzke Lane
Reno, Nevada 89511
(775) 324-4100

Attorneys for Plaintiff
NexTep, Inc.

EXHIBIT A



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Typed Drawing

Word Mark BRAUNY

Goods and Services IC 020. US 002. G & S: POLYETHYLENE BAGS. FIRST USE: 19710706. FIRST USE IN COMMERCE: 19710706

Mark Drawing Code (1) TYPED DRAWING

Serial Number 72399973

Filing Date August 12, 1971

Current Filing Basis 1A

Original Filing Basis 1A

Registration Number 0940243

Registration Date August 8, 1972

Owner (REGISTRANT) CHICAGO TRANSPARENT, INC. CORPORATION ILLINOIS 2700 N. PAULINE CHICAGO ILLINOIS 60614

(LAST LISTED OWNER) NEXTEP, INC. CORPORATION NEVADA P.O. BOX 11188 RENO NEVADA 89510

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record BURTON S. EHRlich

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20030501.

Renewal 1ST RENEWAL 20030501

Live/Dead Indicator LIVE

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EXHIBIT B



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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 6

Serial #: 72399973

Filing Dt: 08/12/1971

Reg #: 0940243

Reg. Dt: 08/08/1972

Registrant: CHICAGO TRANSPARENT, INC.

Mark: BRAWNY

Assignment: 1

Reel/Frame: 0257/0277

Received:

Recorded: 09/09/1974

Pages: 2

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Assignor: CHICAGO TRANSPARENT INC.

Exec Dt: 08/28/1974

Entity Type: CORPORATION

Citizenship: ILLINOIS

Assignee: CONSOLIDATED FOODS CORPORATION

135 SOUTH LASALLE STREET

CHICAGO, ILLINOIS 60603

Entity Type: CORPORATION

Citizenship: MARYLAND

Correspondent: BREZINA & BUCKINGHAM

3747 GRAND BLVD.

BROOKFIELD, IL 60513

Assignment: 2

Reel/Frame: 0385/0946

Received:

Recorded: 02/23/1981

Pages: 1

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOOD WILL AS OF MAY 8, 1978

Assignor: CONSOLIDATED FOODS CORPORATION

Exec Dt: 01/22/1981

Entity Type: UNKNOWN

Citizenship: NONE

Assignee: CHICAGO TRANSPARENT PRODUCTS, INC.

2700 NORTH PAULINA ST.

CHICAGO, ILLINOIS 60614

Entity Type: CORPORATION

Citizenship: RHODE ISLAND

Correspondent: BREZINA AND BUCKINGHAM

8733 ROCKEFELLER AVE.

8733 ROCKEFELLER AVE.

BROOKFIELD, IL 60513

Assignment: 3

Reel/Frame: 0549/0090

Received:

Recorded: 01/12/1987

Pages: 10

Conveyance: ASSIGNS SECURITY INTEREST SUBJECT TO LICENSE RECITED

Assignor: CHICAGO TP INC.

Exec Dt: 12/29/1986

Entity Type: CORPORATION

Citizenship: ILLINOIS

Assignee: BT COMMERCIAL CORPORATION

Entity Type: UNKNOWN

Citizenship: NONE

Correspondent: SIDLEY & AUSTIN

ONE FIRST NATIONAL PLAZA

CHICAGO, IL 60603

Assignment: 4

Reel/Frame: 2613/0290 **Received:** 11/08/2002**Recorded:** 11/04/2002**Pages:** 6**Conveyance:** CHANGE OF NAME**Assignor:** CHICAGO TRANSPARENT PRODUCTS, INC.**Exec Dt:** 05/15/1995**Entity Type:** CORPORATION**Citizenship:** ILLINOIS**Entity Type:** CORPORATION**Citizenship:** ILLINOIS**Assignee:** BRAWNY PLASTICS, INC.2700 NORTH PAULINA STREET
CHICAGO, ILLINOIS 60614**Correspondent:** ARNSTEIN & LEHR

BURTON S. EHRLICH

1200 S. RIVERSIDE PLAZA

SUITE 1200

CHICAGO, IL 60606

Assignment: 5**Reel/Frame:** 3052/0694 **Received:** 03/24/2005**Recorded:** 03/24/2005**Pages:** 5**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** BRAWNY PLASTICS, INC.**Exec Dt:** 08/06/2003**Entity Type:** CORPORATION**Citizenship:** ILLINOIS**Entity Type:** CORPORATION**Citizenship:** NEVADA**Assignee:** NEXTEP, INC.

P.O. BOX 11188

RENO, NEVADA 89510

Correspondent: MATTHEW D. FRANCIS

5371 KIETZKE LANE

RENO, NV 89511

Assignment: 6**Reel/Frame:** 3059/0580 **Received:** 10/05/2004**Recorded:** 10/01/2004**Pages:** 4**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** BRAWNY PLASTICS, INC.**Exec Dt:** 08/06/2003**Entity Type:** CORPORATION**Citizenship:** NONE**Entity Type:** CORPORATION**Citizenship:** NONE**Assignee:** NEXTEP, INC.

P.O. BOX 11188

RENO, NEVADA 89510

Correspondent: SIERRA PATENT GROUP, LTD.

NANCY J. THOMPSON

P.O. BOX 6149

STATELINE, NV 89449

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 78268015

Filing Dt: 06/27/2003

Reg #: NONE

Reg. Dt:

Applicant: Brawny Plastics, Inc.

Mark: BRAUNY

Assignment: 1

Reel/Frame: 3050/0540

Received: 03/22/2005

Recorded: 03/22/2005

Pages: 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BRAWNY PLASTICS, INC.

Exec Dt: 03/17/2005

Entity Type: CORPORATION

Citizenship: ILLINOIS

Entity Type: CORPORATION

Citizenship: NEVADA

Assignee: NEXTEP, INC.

P.O. BOX 11188

RENO, NEVADA 89510

Correspondent: MATTHEW D. FRANCIS

5371 KIETZKE LANE

RENO, NV 89511

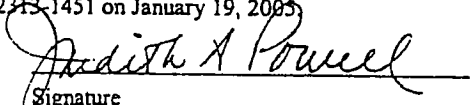
Search Results as of: 04/14/2005 12:34 PM

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EXHIBIT D

T-7 A13

| | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------|
| CERTIFICATE OF MAILING (37 CFR 1.10) | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on January 19, 2005 | |
| Judith A. Powell |  |
| Name of Person Mailing Paper | Signature |

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

| | | |
|-----------------------------|---|----------------------------|
| FORT JAMES OPERATING |) | |
| COMPANY and GEORGIA-PACIFIC |) | |
| CORPORATION, |) | |
| |) | |
| Opposers, |) | Application No. 78/268,015 |
| |) | |
| v. |) | Mark: BRAWNY |
| |) | |
| BRAWNY PLASTICS, INC. |) | |
| |) | |
| |) | Opposition No. _____ |
| Applicant. |) | |

NOTICE OF OPPOSITION

Opposers Fort James Operating Company and Georgia-Pacific Corporation ("Opposers"), file this Notice of Opposition against Application Serial No. 78/268,015 for the mark BRAWNY filed by Brawny Plastics, Inc. ("Applicant"), because Opposers believe that they will be damaged by registration of the mark which is the subject matter of Application No. 78/268,015. As grounds for opposition, Opposers allege as follows:

1. Opposer Fort James Operating Company ("Fort James") is a Virginia corporation with a principal place of business located at 133 Peachtree Street, N.E., Atlanta, Georgia 30303. Opposer Fort James is a wholly-owned subsidiary of Georgia-Pacific Corporation ("Georgia-Pacific"), a related company.

01/25/2005 KGBIBBONS 00000050 78268015

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600.00 DP



01-20-2005

U.S. Patent & TMO/TM Mail Rpt Dt #64

2. Opposer Georgia-Pacific is a Georgia corporation with a principal place of business located at 133 Peachtree Street, N.E. Atlanta, Georgia 30303.

3. A proper extension of time to oppose the instant application through and including January 19, 2005, has been obtained.

4. Opposer Fort James is the owner of the following marks, and corresponding trademark registrations, hereinafter referred to collectively as the "BRAWNY Marks":

| Mark | Registration or Serial No. | Goods | Date of First Use |
|---------------------|----------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------|
| BRAWNY | 78/443,780 | Household cleaning implements, namely, scrub brush, broom, dust pan, grout brush, squeegee and plunger | 12/29/2004 |
| BRAWNY | 78/402,314 | Household gloves made of rubber and cotton knit for general use, and disposable latex gloves, cleaning pads, scrubber sponges | 07/19/2004 |
| BRAWNY | 78/356,377 | Scrub Sponges for cleaning, namely copper fiber Scrubbers, Stainless steel scrubbers, Plastic scrubbers, Nylon Scrubbers, Foam for General use, Disposable Latex Gloves | 07/19/2004 |
| BRAWNY | 78/307,184 | Household cleaning Cloths | 07/30/2004 |
| BRAWNY | 78/307,171 | Pre-Moistened Hand and Facial Wipes | 03/10/2003 |
| BRAWNY MAN | 2875601 | Paper Goods Namely, Calendars | 04/18/2003 |
| BRAWNY PROFESSIONAL | 2849299 | Paper Towels | 09/30/1999 |
| BRAWNY | 2635343 | Paper Products Namely, Paper Napkins | 01/21/2002 |
| DO YOU KNOW | 2766328 | Paper Towels and Paper | 06/10/2002 |

| | | | |
|----------------------|---------|--------------|-----------|
| A BRAWNY MAN? | | Napkins | |
| BRAWNY and Design | 2165829 | Paper Towels | 1975 |
| BRAWNY | 1062207 | Paper Towels | 10/2/1974 |

5. Opposer Georgia-Pacific acts as the sales agent for the BRAWNY branded products.

6. Opposers market household cleaning goods in retail channels throughout the United States.

7. Opposers manufacture, market and distribute the number 2 selling branded paper towel under the well-known BRAWNY name and mark. Opposers' napkin sold under the BRAWNY name and mark is also among the top-selling branded napkins. Opposers also manufacture, market, and distribute moistened wipes under the BRAWNY name and mark.

8. In addition, through a license agreement, Opposers market and sell a wide variety of household cleaning and related goods under the BRAWNY Mark, including brushes, brooms, sponges, cleaning cloths, scrubbers, and gloves.

9. Opposers, together with their predecessors in interest have used the BRAWNY mark for almost 30 years.

10. Opposers have continuously and exclusively used the BRAWNY Marks in connection with the respective goods identified in Paragraph 4 in United States commerce since each of the indicated dates of first use.

11. Opposers have sold billions of dollars of products under the BRAWNY Marks and have spent millions of dollars in marketing of goods under the BRAWNY Marks.

12. By virtue of the widespread sales and extensive advertising and promotion of the Opposers' products bearing the BRAWNY Marks, the BRAWNY Marks are well known by the

general public and in the relevant industries, are recognized and relied upon as identifying the Opposers' goods and as distinguishing them from the goods and services of others, and have come to represent and symbolize extremely valuable goodwill belonging exclusively to the Opposers.

13. By virtue of Opposers' extensive use and promotion, Opposers' BRAUNY marks have acquired a high degree of distinctiveness.

14. By virtue of Opposers' extensive use and promotion, Opposers' BRAUNY Marks had become famous before Applicant filed its application to register Applicant's Mark.

15. Applicant is the owner of Application No. 78/268,015 for the mark BRAUNY ("Applicant's Mark").

16. Applicant filed the instant application on an intent-to-use basis on June 27, 2003, for "metal trash receptacles for commercial, household and domestic use," in International Class 6 and "plastic trash receptacles for household use" in International Class 21.

17. Opposers' rights in the BRAUNY Marks are superior to Applicant's filing date for Applicant's Mark.

18. The use and registration of Applicant's Mark is likely to cause confusion in the minds of the purchasing public and to cause the purchasing public to assume that the goods identified by Applicant's Mark are sold by Opposers or that such goods originate with or are in some way connected to Opposers, which they are not, in violation of 15 U.S.C. §§ 1052(a) and 1125(a).

19. The use and registration of Applicant's Mark is likely to injure Opposers' business reputations and dilute the distinctive quality of the BRAUNY Marks in violation of Section 13(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §§ 1063(a) and 1125(c).

20. Use and registration of the Applicant's Mark will be injurious to Opposers.
21. A duplicate copy of this Notice and the requisite filing fees are enclosed herewith.

WHEREFORE, Opposers believe that they will be damaged by the registration of the Applicant's Mark and pray that said Application No. 78/268,015 be refused, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposers.

Dated: January 17, 2005

Respectfully submitted,

By: Judith A. Powell

Judith A. Powell
Kilpatrick Stockton LLP
Suite 2800
1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6500

Attorneys for Opposers

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

Registrant.

CANCELLATION NO.:


U.S. Patent & TMO/c/TM Mail Rpt Dt: 1/3/9


leading global producer of tissue products and one of the world's leading manufacturers and marketers of other consumer products, including but not limited to packaging and paper, as well as building products.

3. Petitioners manufacture, market, and distribute the Number 2 best-selling brand of paper towels in the United States under the well-known mark, BRAWNY®. Additionally, Petitioners manufacture, market, and distribute a top-selling napkin under the BRAWNY® Mark. Petitioners also manufacture, market, and distribute moistened wipes under the BRAWNY brand name and mark.

4. In addition, through a license agreement, Petitioners market and sell a wide variety of household cleaning tools and related goods under the BRAWNY brand name and mark, including brushes, brooms, sponges, cleaning cloths, scrubbers, and gloves.

5. Petitioner Fort James is the owner of, inter alia, the following trademark applications and registrations (hereinafter collectively referred to as the "BRAWNY Marks"):

| Mark | Registration or Serial No. | Goods | Date of First Use |
|----------------------------------------------------------------------------------------------------------|----------------------------|--------------------------------------|-------------------|
| BRAWNY | 1,062,207 | Paper Towels | 10/2/1974 |
|  BRAWNY and Design | 2,165,829 | Paper Towels | 1975 |
| DO YOU KNOW A BRAWNY MAN? | 2,766,328 | Paper Towels and Paper Napkins | 06/10/2002 |
| BRAWNY | 2,635,343 | Paper Products Namely, Paper Napkins | 01/21/2002 |

| | | | |
|-----------------------------------------------------------------------------------|------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------|
| BRAWNY PROFESSIONAL | 2,849,299 | Paper Towels | 09/30/1999 |
| BRAWNY MAN | 2,875,601 | Paper Goods Namely, Calendars | 04/18/2003 |
| BRAWNY | 2,929,823 | Paper towels and napkins | 10/15/2003 |
|  | 78/278,384 | Paper towels and napkins | 10/01/2003 |
| BRAWNY | 78/307,170 | Paper towel dispenser | 12/29/2004 |
| BRAWNY | 78/307,171 | Pre-Moistened Hand and Facial Wipes | 03/10/2003 |
| BRAWNY | 78/307,174 | Toilet bowl brush | 07/19/2004 |
| BRAWNY | 78/307,184 | Household cleaning Cloths | 07/30/2004 |
| BRAWNY | 78/356,377 | Scrub Sponges for cleaning, namely copper fiber Scrubbers, Stainless steel scrubbers, Plastic scrubbers, Nylon Scrubbers, Foam for General use, Disposable Latex Gloves | 07/19/2004 |
| BRAWNY | 78/402,314 | Household gloves made of rubber and cotton knit for general use, and disposable latex gloves, cleaning pads, scrubber sponges | 07/19/2004 |
| BRAWNY | 78/404,561 | Dust cloths | 07/19/2004 |
| BRAWNY | 78/443,780 | Household cleaning implements, namely, scrub brush, broom, dust pan, grout brush, squeegee and plunger | 12/29/2004 |

6. Petitioners, together with their predecessors in interest, have continuously and exclusively used the BRAWNY Marks in connection with the above-identified goods since each

of the indicated dates of first use; cumulatively, the BRAWNY Marks have been in continuous use for more than thirty (30) years.

7. Petitioners have sold billions of dollars worth of the above-identified products bearing the BRAWNY Marks. In the last five years alone, Petitioners have distributed more than 70 million cases of BRAWNY® paper towels in the United States alone, with gross sales exceeding \$1 billion.

8. Moreover, Petitioners have spent millions of dollars advertising and marketing its goods sold in connection with the BRAWNY Marks. In the last five years alone, Petitioners have expended over \$70 million in advertising and promoting BRAWNY® paper towels.

9. By virtue of the widespread sales and extensive advertising and promotion of Petitioners' products bearing the BRAWNY Marks, the BRAWNY Marks are well known by the general public and in the relevant industries, are recognized and relied upon as identifying Petitioners' goods and as distinguishing them from the goods and services of others, and have come to represent and symbolize extremely valuable goodwill belonging exclusively to the Petitioners.

10. By virtue of Petitioners' extensive use and promotion, Petitioners' BRAWNY Marks have acquired a high degree of distinctiveness.

11. By virtue of Petitioners' extensive use and promotion, Petitioners' BRAWNY Marks have become famous.

12. Upon information and belief, Registrant is an Illinois corporation, with an address of record of 2700 North Paulina Street, Chicago, Illinois 60614, and is the last listed owner (by assignment and change of corporate name) of U.S. Registration No. 940,243 for the designation

BRAWNY in International Class 20 for "polyethylene bags." Registrant claims a first use date of July 6, 1971 for this designation.

13. Upon information and belief, Registrant has abandoned any rights it may have claimed in its BRAWNY designation by failing to continuously use the mark in commerce.

14. Upon information and belief, in its May 1, 2003 Declaration of Use in Commerce for Renewal of Registration No. 940,243, Registrant made false and fraudulent statements knowingly intended to mislead the United States Patent and Trademark Office ("U.S.P.T.O.") regarding Registrant's continued use of the BRAWNY designation in commerce.

15. Upon information and belief, in the summer of 2003, Registrant attempted to transfer any rights it had to Registration No. 940,243 to a third party, Nextep, Inc. ("Nextep"). Upon information and belief, said conveyance of the registration, devoid of any goodwill of the business connected to Registrant's alleged use of the BRAWNY designation, was a sham transaction in contravention of the Lanham Act. Neither Registrant nor Nextep recorded this transfer with the U.S.P.T.O.

16. Registration No. 940,243 is now being used by, or with the permission of, Registrant so as to misrepresent the source of the plastic bags on or in connection with which Registrant's BRAWNY designation is being used.

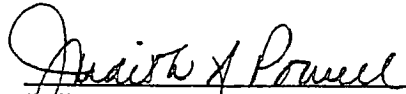
17. For all of the foregoing reasons, U.S. Registration No. 940,243 should therefore be canceled pursuant to 15 U.S.C. §1064(3).

18. Pursuant to 37 C.F.R. §§ 2.6(a)(16) and 2.112(a), please find enclosed herewith the required fee of \$600.00 and a duplicate copy of this Petition. The clerk is authorized to charge the Kilpatrick Stockton LLP Trademark Deposit Account No. 11-0860 for any additional fees.

WHEREFORE, Petitioner prays that Registrant's Registration No. 940,243 be canceled.

Dated: March 24, 2005

Respectfully Submitted:

A handwritten signature in cursive script, appearing to read "Judith A. Powell", is written over a horizontal line.

Judith A. Powell

James H. Sullivan

Kilpatrick Stockton LLP

1100 Peachtree Street

Atlanta, Georgia 30309

(404) 815-6500

Attorneys for Petitioners

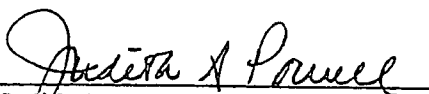
CERTIFICATE OF EXPRESS MAIL

"EXPRESS MAIL" mailing number: EV607732125US

DATE OF DEPOSIT: March 24, 2005

DOCUMENT: PETITION FOR CANCELLATION AGAINST
U.S. REGISTRATION NO. 940,243

I hereby certify that this paper and fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on date indicated above and is addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.


Judith A. Powell



United States Patent and Trademark Office

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TTABVUE. Trademark Trial and Appeal Board Inquiry System

Summary

Query: Mark Name contains all words: BRAWNY**Number of results:** 12

| Proceeding Filing Date | Defendant(s), Property(ies) | Plaintiff(s), Property(ies) |
|----------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 91167043 10/07/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78340495 | FORT JAMES OPERATING COMPANY AND GEORGIA-PACIFIC CORPORATION |
| 78340495 07/08/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78340495 | GEORGIA-PACIFIC CORPORATION |
| 91165737 06/24/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78301844 | FORT JAMES OPERATING COMPANY AND GEROGIA-PACIFIC CORPORATION |
| 91165736 06/24/2005 | Paul, Samuel Luis Mark: BRAWNY S#: 78301840 | Fort James Operating Company and Georgia- Pacific Corporation Mark: BRAWNY S#: 73054752 R#: 1062207 |
| 91165601 06/08/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78301863 | FORT JAMES OPERATION COMPANY AND GEORGIA-PACIFIC CORPORATION |
| 92044396 03/28/2005 | BRAWNY AND NEXTEP, INC. Mark: BRAWNY S#: 72399973 R#: 940243 | FORT JAMES OPERATING COMPANY AND GEORGIA-PACIFIC CORPORATION |
| 78301840 03/07/2005 | Paul, Samuel Luis Mark: BRAWNY S#: 78301840 | Georgia-Pacific Corporation Mark: BRAWNY S#: 73054752 R#: 1062207 |
| 78301863 03/07/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78301863 | GEORGIA-PACIFIC CORPORATION |
| 78301844 03/07/2005 | Paul, Samuel Louis Mark: BRAWNY S#: 78301844 | GEORGIA-PACIFIC CORPORATION FORT JAMES OPERATING COMPANY AND GEROGIA-PACIFIC CORPORATION |
| 91164081 01/20/2005 | BRAWNY AND NEXTEP, INC. Mark: BRAWNY S#: 78268015 | Fort James Operating Company and Georgi |
| 78268015 10/26/2004 | Brawny Plastics, Inc. Mark: BRAWNY S#: 78268015 | Fort James Operating Company |
| 92041489 12/04/2002 | BRAWN OF CALIFORNIA Mark: BRAWN S#: 73063247 R#: 1043613 | Fort James Operating Company Mark: BRAWNY S#: 78105770 |

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FSW

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

Mailed: July 19, 2005

Opposition No. 91164081
Cancellation No. 92044396

FORT JAMES OPERATING COMPANY
AND GEORGIA-PACIFIC
CORPORATION

v.

BRAWNY PLASTICS, INC. and
NEXTEP, INC., joined as party
defendants

Before Seeherman, Hohein and Hairston, Administrative
Trademark Judges.

By the Board:

On January 20, 2005, plaintiffs, Fort James Operating
Company and Georgia-Pacific Corporation, commenced
opposition proceeding No. 91164081 against defendant Brawny
Plastics, Inc.'s (BPI) application for the mark BRAWNY.¹ On
March 25, 2005, plaintiffs commenced cancellation proceeding

¹ Application Ser. No. 78268015, filed June 27, 2003, for the
mark BRAWNY for "metal trash receptacles for commercial,
household and domestic use and plastic trash receptacles for
household use"; filed on the basis of applicant's intent to use
the mark in commerce.

Opposition No. 91164081; Cancellation No. 92044396

No. 92044096 against BPI's registration for the mark
BRAUNNY.²

The application involved in the opposition proceeding was assigned to NexTep, Inc. (NexTep) on March 17, 2005. The registration involved in the cancellation proceeding was assigned to NexTep on August 6, 2003. The assignments were subsequently recorded with the Assignment Division of the Office.³

These cases now come up on the following motions:

1. Defendants' motion (filed May 16, 2005) to dismiss the cancellation action;
2. Defendants' motion (filed April 17, 2005) to substitute NexTep, Inc. as party defendant in the opposition proceeding;
3. Defendants' motions (filed April 15, 2005) to suspend the opposition and cancellation proceedings; and
4. Plaintiffs' motions (filed May 9, 2005) for an oral hearing on both motions to suspend.

Plaintiffs have filed responses to defendants' motions, and defendants have filed responses to plaintiffs' motions. Reply briefs were filed in support of defendants' motions to dismiss and to suspend. The Board has also *sua sponte*

² Registration No. 940243, issued August 8, 1972, for the mark BRAUNNY for "polyethylene bags"; section 8 affidavit accepted and first renewal granted on May 1, 2003.

³ The assignment of the application was recorded at Reel and Frame Nos. 3050/0540 on March 22, 2005, and the assignment of the registration was recorded at Reel and Frame Nos. 3052/0694 on March 24, 2005.

considered the question of consolidation of the cases, as further discussed below.

Defendants' Motion to Dismiss the Cancellation Proceeding

Defendants claim that plaintiffs, by naming BPI as respondent in the cancellation, have failed to state a claim upon which relief can be granted, because NexTep, not BPI, was the owner of the mark at the time the petition to cancel was filed. Moreover, defendants contend, NexTep is an indispensable party that cannot be joined to the action because "joinder would leave BPI as a named party, and BPI has no remaining ownership in the '243 Reg." *Applicant's Motion to Dismiss*, p. 5.

Plaintiffs argue that they did not improperly name BPI as respondent in the petition, because Office records showed BPI as record owner of the registration at the time the petition was filed. Plaintiffs argue that, while they "do not concede that joinder of Nextep is necessary in this case, BPI and Nextep have clearly requested overly broad, drastic relief by requesting that the Board dismiss these proceedings, in lieu of simply requesting that Nextep be joined as a party." *Petitioners' Brief in Opposition to Motion to Dismiss*, p. 8.

It is the policy of the Office to institute a cancellation proceeding against the party shown by the

Opposition No. 91164081; Cancellation No. 92044396

records of the Office to be the current owner of the registration sought to be cancelled. See Trademark Rule 2.113(c); and TBMP § 310.01 (2d ed. rev. 2004). To such end, the Board conducts a title search of the USPTO assignment records to determine whether an assignment has been recorded against a registration. If an assignment has been recorded, the Board institutes the cancellation proceeding against the new owner of the registration.

Here, while there is no dispute that the registration was assigned to NexTep on August 6, 2003 (as shown by the "Trademark Sale, Assignment and License" agreement between BPI and NexTep), the assignment was not recorded until March 24, 2005, the same day the petition to cancel was filed. Moreover, even at the time the cancellation proceeding file was set up, the Board's title search of the assignment records of the Office did not reveal the identity of the assignee due to the lag time between filing and recordation of the assignment. See TBMP § 310.01 (2d ed. rev. 2004). Under the circumstances, plaintiffs cannot be faulted for naming BPI as the defendant in the petition to cancel.

Accordingly, defendants' motion to dismiss the cancellation action is hereby denied.

However, because NexTep is the current owner of the registration, NexTep should be joined or substituted as a party defendant. Whether an assignee should be joined or

substituted generally depends on when the registration was assigned and when the assignment was recorded with the USPTO.

Typically, an assignee may be substituted if the assignment and recordation thereof occurred prior to the commencement of the proceeding; if the assignment or recordation thereof occurred subsequent to the commencement of the proceeding, the assignee will be joined. See TBMP § 512.02 (2d ed. rev. 2004). In this case, the assignment from BPI to NexTep was recorded on the same date that the petition for cancellation was filed. Under these circumstances, we think it appropriate to join, rather than substitute, NexTep as a party to the cancellation in order to facilitate discovery.

Defendants' Motion to Substitute in the Opposition Proceeding

Defendants' motion to substitute is based on their August 6, 2003 agreement, wherein BPI agreed to assign its trademark application to NexTep "upon the filing of a verified statement of use" in the application. No statement of use has been filed in the application, but on March 17, 2005, an assignment of the mark "together with the goodwill of the entire business in connection with which the trademark is used and which is symbolized by the trademark" was executed by BPI as assignor of the application.

Defendants contend that the "original assignment occurred prior to the commencement of this proceeding," and

Opposition No. 91164081; Cancellation No. 92044396

that the March 17, 2005 assignment was merely a "supplemental assignment called for in the [August 6, 2003] agreement." *Defendants' Reply In Support of Motion To Substitute Parties*, pp. 2, 3. Since the assignment occurred before the proceeding commenced, defendants argue, NexTep should be substituted for, rather than joined with, BPI.

We disagree. The original agreement did not effect an assignment of the application. The assignment of the application occurred on March 17, 2005, after the opposition proceeding commenced. Thus, the proper course of action is for NexTep to be joined as a party defendant in the opposition, rather than substituted for BPI. See TBMP § 512.02 (2d ed. rev. 2004).

Accordingly, defendants' motion to substitute NexTep for BPI in the opposition is denied, and NexTep is hereby joined as a party defendant in the opposition proceeding.

Consolidation of the Cases

The Board may order consolidation of the cases on its own initiative. See Fed. R. Civ. P. 42(a); and TBMP § 511 (2d ed. rev. 2004).

Both the opposition and the cancellation proceeding involve NexTep's rights to the mark BRAWNY. The parties are the same in both cases, and the issues presented by the pleadings involve common questions of law and fact.

Accordingly, these cases are hereby consolidated and the captioning of this proceeding is amended to reflect their consolidation (and joinder of NexTep as party defendant).⁴

Defendants' Motions to Suspend; Plaintiffs' Motions for Oral Hearing

Defendants contend that proceedings herein should be suspended pending the final disposition of a civil action between NexTep and plaintiffs.⁵ Plaintiffs request an oral hearing on defendants' motions to suspend.

The parties' arguments on the motions to suspend have been adequately presented in their briefs, and oral hearings thereon are unnecessary. Accordingly, plaintiffs' motions for an oral hearing on defendants' motions to suspend are hereby denied. See TBMP § 502.03 (2d ed. rev. 2004).

Trademark Rule 2.117(a) permits a Board proceeding to be suspended whenever parties to a case pending before it are involved in a civil action "which may have a bearing on"

⁴ The cases may now be presented on the same records and briefs. Papers should bear the number of each of the consolidated cases, although Opposition No. 91164081 is treated as the "parent" case, and most of the papers filed by the parties, or issued by the Board, will be placed only in the file of the parent case. The parties need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

the rights of the parties in the Board case. Where, as here, the civil action is in a federal district court and involves issues in common with those in the Board proceeding, suspension is further warranted because the decision of the federal district court is binding upon the parties thereto, while the decision of the Board is advisory only to the court. See TBMP § 510.02(a) (2d ed. rev. 2004) and authorities cited in that section.

NexTep, as plaintiff in the civil action, seeks a declaratory judgment that its rights in the BRAUNNY mark are superior to those of plaintiffs; that its use of the BRAUNNY mark does not infringe any of plaintiffs' rights; and that the assignment of the registration for the mark from BPI to NexTep was valid. Disposition of these issues by the district court will have a direct bearing on the issues raised in this consolidated proceeding.

Accordingly, defendants' motions to suspend are hereby granted. Proceedings are suspended pending final disposition of the civil action between the parties.

The Board may make biannual inquiry as to the status of the civil action. If the case is resolved, the parties should promptly notify the Board so that this case may be called up for appropriate action. During the suspension

⁵ *NexTep, Inc. v. Fort James Operating Co. and Georgia-Pacific Corp.*, Case No. CV-N-05-0227-ECR-RAM, United States District Court for the District of Nevada, filed April 14, 2005.

Opposition No. 91164081; Cancellation No. 92044396

period the Board should be notified of any address changes
for the parties or their attorneys.

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

Mailed: October 26, 2005

Opposition No. 91165601

FORT JAMES OPERATION COMPANY
AND GEORGIA-PACIFIC
CORPORATION

v.

SAMUEL LOUIS PAUL

Frances S. Wolfson, Interlocutory Attorney:

On July 28, 2005, applicant filed a motion to suspend this proceeding pending the outcome of a civil action pending between opposer and NexTep, Inc.¹ The motion has been fully briefed.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties

¹ *NexTep, Inc. v. Fort James Operating Company and Georgia-Pacific Corporation*, Case No. CV-N-05-0227-ECR-RAM in the District of Nevada.

in the Board case. See Martin Beverage Co. v. Colita Beverage Corp., 169 USPQ 568, 570 (TTAB 1971).

Applicant has alleged that he is the owner and secretary of the plaintiff in the civil action. Opposers are defendants therein. Although the parties in the civil action are not identical to those in the opposition, the decision in the civil action is likely to have a direct bearing on the outcome of this opposition.

Accordingly, applicant's motion to suspend is hereby granted. Proceedings are suspended pending final disposition of the civil action between the parties. The Board may make biannual inquiry as to the status of the civil action. If, however, the case is resolved, the parties should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

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

Mailed: November 16, 2005

Opposition No. 91165736

Fort James Operating Company
and Georgia-Pacific
Corporation

v.

Paul, Samuel Luis

Frances S. Wolfson, Interlocutory Attorney:

On August 1, 2005, applicant filed its answer to the notice of opposition together with a motion to suspend this proceeding pending the outcome of a civil action pending between opposers and NexTep, Inc.¹ The motion has been fully briefed.² We have considered applicant's reply brief as it clarifies the issues before us. See Trademark Rule 2.127(a).

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v.*

¹ *NexTep, Inc. v. Fort James Operating Company and Georgia-Pacific Corporation*, Case No. CV-N-05-0227-ECR-RAM in the District of Nevada.

Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992).

Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

Applicant has alleged that he is owner and secretary of the plaintiff in the civil action. Opposers are defendants therein. Although the parties in the civil action are not identical to those in the opposition, the decision in the civil action is likely to have a direct bearing on the outcome of this opposition.

Accordingly, applicant's motion to suspend is hereby granted. Proceedings are suspended pending final disposition of the civil action between the parties.

The Board may make biannual inquiry as to the status of the civil action. If, however, the case is resolved, the parties should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

² Opposer's motion (filed August 24, 2005) to reopen its time to file a response to applicant's motion to suspend is hereby granted.

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

Mailed: November 16, 2005

Opposition No. 91165737

FORT JAMES OPERATING COMPANY
AND GEORGIA-PACIFIC
CORPORATION

v.

Paul, Samuel Louis

Frances S. Wolfson, Interlocutory Attorney:

On August 1, 2005, applicant filed its answer to the notice of opposition, together with a motion to suspend this proceeding pending the outcome of a civil action pending between opposers and NexTep, Inc.¹ The motion has been fully briefed.² We have considered applicant's reply brief as it clarifies the issues before us. See Trademark Rule 2.127(a).

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a); and *General Motors Corp. v.*

¹ *NexTep, Inc. v. Fort James Operating Company and Georgia-Pacific Corporation*, Case No. CV-N-05-0227-ECR-RAM in the District of Nevada.

Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992).

Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

Applicant has alleged that he is owner and secretary of the plaintiff in the civil action. Opposers are defendants therein. Although the parties in the civil action are not identical to those in the opposition, the decision in the civil action is likely to have a direct bearing on the outcome of this opposition.

Accordingly, applicant's motion to suspend is hereby granted. Proceedings are suspended pending final disposition of the civil action between the parties.

The Board may make biannual inquiry as to the status of the civil action. If, however, the case is resolved, the parties should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

² Opposer's motion (filed August 24, 2005) to reopen its time to file a response to applicant's motion to suspend is hereby granted.