

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

Baxley

Mailed: October 25, 2006

Opposition No. 91171049

John Spiegelberg

v.

Chrome Clothing Company

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of: (1) opposer's motion (filed August 18, 2006) to suspend proceedings herein pending final determination of a civil action between the parties;¹ and (2) applicant's motion (filed September 27, 2006) to compel discovery and to have its requests for admission deemed admitted. Brief in response to both motions have been filed.

The Board turns first to opposer's motion to suspend. After reviewing the complaint in the civil action, the Board finds that suspension of this proceeding is appropriate. To prevail in the district court on his claims of trademark infringement and unfair competition, opposer must prove that he possesses trademark rights in his pleaded CHROME mark. If the district court finds that he has such rights, the

¹ The civil action is styled *John Spiegelberg d/b/a Chrome v. Chrome Clothing Company, LLC*, Case No. 5-06CV0117-C, filed in the United States District Court for the Northern District of Texas.

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court's findings will have a bearing on opposer's claims in this proceeding. More importantly, those findings would be binding upon the Board. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn 1986); *Other Telephone Co. v. National Telephone Co.*, 181 USPQ 79 (Comm'r Pats. 1974); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971). In short, the Board finds that these considerations outweigh the facts that opposer did not seek suspension of this case until after he received written discovery requests from applicant.²

Therefore, in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the district court and the possibility of reaching an inconsistent conclusion, opposer's motion to suspend this proceeding pending final determination, (i.e., following the termination of any and all appeals and remands), of Case No. 5-06CV0117-C is granted. See Trademark Rule 2.117(a).

This proceeding is **suspended** indefinitely, retroactive to August 18, 2006, pending final determination of Case No. 5-06CV0117-C. In view of the fact that such suspension is retroactive to August 18, 2006, applicant's motion to compel

² The better practice, however, would have been to move to suspend this proceeding upon commencement of the civil action, i.e., upon filing the complaint with the district court. See Fed. R. Civ. P. 3; TBMP Section 510.02(a) (2d ed. rev. 2004).

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discovery and to have its requests for admission deemed admitted is denied. If necessary, opposer's time to serve discovery responses will be reset when proceedings herein are resumed.

Annual inquiry may be made as to the status of the civil action. Within twenty days after the final determination of the civil action, the interested party 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.