

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

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Mailed: November 20, 2006

Opposition No. 91172424
Opposition No. 91172619
Opposition No. 91173052
Opposition No. 91173531
Opposition No. 91173532
Opposition No. 91173533
Opposition No. 91173534
Opposition No. 91173535
Opposition No. 91173882
Opposition No. 91173883
Opposition No. 91173884
Opposition No. 91173885
Opposition No. 91173886

MONSTER CABLE PRODUCTS, INC.

v.

MONSTER DADDY, LLC

Elizabeth A. Dunn, Attorney:

This case comes before the Board on applicant's motion to suspend proceedings pending the disposition of the civil action between these parties. Opposer filed a response opposing the motion.

As a preliminary matter the Board notes that in each of the above captioned proceedings, the same opposer has filed a notice of opposition to registration of the same

Opposition Nos. 91172424, 91172619, 91173052, 91173531, 91173532, 91173533, 91173534, 91173535, 91173882, 91173883, 91173884, 91173885, and 91173886

applicant's thirteen MONSTER marks on the grounds of likelihood of confusion with opposer's common law and registered MOSNTER marks. Because the parties are the same, and the thirteen proceedings involve common issues of law and fact, the Board believes that the interest of judicial economy will be served by consolidation of Opposition Nos. 91172424, 91172619, 91173052, 91173531, 91173532, 91173533, 91173534, 91173535, 91173882, 91173883, 91173884, 91173885, and 91173886. See Fed. R. Civ. P. 42(a) and TBMP §511. Accordingly, Opposition Nos. 91172424, 91172619, 91173052, 91173531, 91173532, 91173533, 91173534, 91173535, 91173882, 91173883, 91173884, 91173885, and 91173886 are consolidated, and may be presented on the same record and briefs.¹

The parties are hereby ordered to advise the Board of any other pending related cases on an ongoing basis throughout the pendency of this consolidated case.

Turning to applicant's motion to suspend, the Board has reviewed the amended complaint (attached to applicant's motion to suspend) filed August 17, 2006 in the United States District Court for the District of South Carolina, Greenville Division in the case of *Monster Daddy, LLC v. Monster Cable Products, Inc.*, Case No. 6:06 - CV - 000293.

¹ The Board file will be maintained in Opposition No. 91172424 as the "parent" case, but all papers filed herein must include the proceeding numbers of both cases in ascending order.

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Because the complaint makes clear that the district court will decide whether to enjoin opposer from challenging applicant's use and registration of its marks, the district court's decision will directly affect this proceeding. It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Judicial economy lies in the suspension of Board proceedings because, *inter alia*, the Board has limited jurisdiction involving the issue of registrability only; the Board decision is advisory to the Court, while a Court decision may bind a party in an administrative Board proceeding [see Vol. 5, J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §32:49 (4th ed.)]; and the Board decision is appealable to the U.S. District Court. See *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988); *E. & J. Gallo Winery v. F. & P. S.p.A.*, 899 F. Supp 465, 35 USPQ2d 1857 (ED CA 1994) and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (DC MN 1986). See also Sections 17 and 37 of the Trademark Act.

In arguing that the district court lacks jurisdiction over applicant's applications based on intent to use the

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marks, opposer seems to argue that applicant lacks standing to bring the civil action. This is not a matter for the Board to decide.² Based on the allegations of the amended complaint and the impact the district court's decision will have on this consolidated proceeding, the Board believes that this proceeding should be suspended pending the final outcome of the civil action between the parties. See Trademark Rule 2.117(a); and TBMP §510.02(a). Accordingly, applicant's motion to suspend proceedings is granted, and proceedings are suspended pending final disposition of the civil action between the parties.

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.

² Of course, if opposer succeeds in having the civil action dismissed on such a basis, and the dismissal order becomes final, proceedings hereon will be resumed.