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

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|------------------------|---|
| Proceeding | 91194504 |
| Party | Defendant Cimarron Lumber and Supply Company |
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| Submission | Reply in Support of Motion |
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| Signature | /Scott R. Brown/ |
| Date | 07/10/2012 |
| Attachments | Reply In Support of Motion to Suspend.pdf (3 pages)(44121 bytes) |

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

In the matter of Trademark Application No.77784368
For the Mark: SUTHERLAND LUMBER COMPANY

| | | |
|---|---|-------------------------|
| Sutherland Centennial Lumber Co. LLC, |) | |
| Sutherland Building Materials Centers LP, and |) | |
| Sutherlands West Texas, Inc. |) | |
| |) | |
| Opposers, |) | |
| |) | |
| vs. |) | Opposition No. 91194504 |
| |) | |
| Cimarron Lumber and Supply Company |) | |
| |) | |
| Applicant. |) | |

**APPLICANT’S REPLY BRIEF IN SUPPORT OF ITS MOTION
TO SUSPEND PENDING THE OUTCOME OF CIVIL ACTION**

The Board should suspend this opposition because the civil action currently pending before the United States District Court for the District of Kansas (hereinafter the “Civil Action”) presents the most comprehensive and binding mechanism to resolve all trademark claims between the parties. Ownership and infringement of a number of SUTHERLAND-formative trademarks is at issue in the Civil Action, including SUTHERLAND LUMBER COMPANY, whereas only the single application for registration for the mark SUTHERLAND LUMBER COMPANY is at issue here. Thus, this matter represents but a sliver of the entire Civil Action.

Indeed, while Opposer argues that “no count in the Civil Action ... is made for relief pertaining to this proceeding,” (Opposition, p. 2), the Civil Action involves claims *identical* to those at issue here. In both the Civil Action and this proceeding, Opposer claims to be a co-owner of the

SUTHERLAND LUMBER COMPANY mark (Opposition, ¶ 11; Applicant's Opening Brief, Ex. B. pp. 21-22). Similarly, in both the Civil Action and this proceeding, Opposer alleges Applicant knowingly failed to disclose ownership information regarding SUTHERLAND-formative marks. (Opposition, ¶ 13; Applicant's Opening Brief, Ex. B, p. 13, ¶ 8; p. 25, ¶¶ 56-57). Likewise, in both the Civil Action and this proceeding, Opposer asserts Applicant does not control the nature and quality of services associated with SUTHERLAND-formative marks, nor control the use of SUTHERLAND-formative marks. (Opposition, ¶ 17; Applicant's Opening Brief, Ex. B. p. 14, ¶ 17). In order to prevail in the Civil Action, Applicant bears the burden of proof of ownership of a number of SUTHERLAND-formative marks, including the mark in this proceeding. The Civil Action has more than a mere bearing on this proceeding, it involves identical claims. Thus, a decision in the Civil Action will likely conclude this proceeding. *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971).

Moreover, Opposer's argument that the opposition should move forward because it was filed two years ago and is procedurally advanced is based on the fallacy that this proceeding has been actively prosecuted by Opposer. To the contrary, although this proceeding was instituted in April 2010, the parties have jointly moved for multiple time extensions based upon settlement discussions. In the interim, very little discovery has occurred and settlement discussions for this proceeding have proven fruitless, likely because this opposition is but one piece to a larger puzzle that the Civil Action will conclusively resolve. Thus, this proceeding is effectively still at its beginning stages and will require extensive additional discovery efforts, the expense of which should be incurred in the Civil Action, which can effectively resolve *all* remaining trademark claims between the parties and bind the Board herein.

Finally, even assuming that this opposition could conclude more quickly than the Civil Action, the decision herein will not bind the Court in the Civil Action. *See id.* Thus, the Civil Action is the most economical mode for the parties to resolve their dispute and bind the Board in this proceeding. Applicant respectfully requests that the Board suspend this proceeding pending disposition of the Civil Action.

Dated: July 10, 2012

Respectfully submitted,

HOVEY WILLIAMS LLP

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing, which was filed electronically with the Trademark Trial and Appeal Board, was served upon the attorney for the Opposer this 10th day of July, 2012, via U.S. Mail, postage prepaid, addressed to:

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