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

Mailed: May 12, 2011

Opposition No. 91197767

The Coca-Cola Company

v.

Robert J. Corr

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of applicant's motion (filed February 22, 2011) to suspend this proceeding pending the final disposition of a civil action and opposition proceedings before the Board. The motion has been fully briefed.[1]

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. *See* Trademark Rule 2.120(i)(1); TBMP

[1] Inasmuch as it is not double-spaced, applicant's main brief fails to comply with Trademark Rule 2.126(a).
Inasmuch as applicant's reply brief does not bear a Certificate of Mailing, the date of filing of said brief is April 7, 2011, the date of receipt by the USPTO. Thus, the filing is untimely pursuant to the Board's March 15, 2011 order. *See* Trademark Rule 2.197; TBMP § 110 (3d ed. 2011). While the filing bears a Certificate of Service, a Certificate of Service cannot be used to prove the timeliness of the filing of correspondence with the Board. TBMP § 110.08 (3d ed. 2011). For all future filings, applicant is encouraged to use the Board's online electronic filing system, ESTTA, access to which is at the Board's web page at www.uspto.gov.
In its discretion, the Board has given consideration to applicant's brief; however, compliance with applicable rules of procedure is expected of applicant in all future filings.

§ 502.06(a) (3d ed. 2011). On May 11, 2011, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's counsel Bruce W. Baber, Esq., applicant Robert J. Corr, pro se, and the assigned Interlocutory Attorney.

For efficiency, the Board does not restate all of the arguments. Rather, this order provides a summary of the Board's analysis and findings.

It is the policy of the Board to consider suspension of proceedings before it when a party or both parties are involved in a civil action which may be dispositive of or have a bearing on the Board case, until the termination of such civil action. The applicable rule is Trademark Rule 2.117(a), which reads as follows:

> (a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the court. *See, e.g., Goya Foods Inv. v. Tropicana Products Inc.,* 846 F.2d 848, 6 USPQ2d 1950 (2d

Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn 1986). *See also* TBMP § 510.02(a)(3d ed. 2011). Suspension of a Board proceeding pending the final determination of another proceeding or proceedings is solely within the discretion of the Board. *Id.*

At issue herein is applicant's mark NATURALLY ZERO (standard characters) for "essences for making flavoured mineral water; essences for making non-alcoholic beverages; essences for the preparation of mineral waters; essences for use in making soft drinks." Opposer asserts the grounds of 1) false suggestion of a connection under Section 2(a), and 2) priority and likelihood of confusion under Section 2(d), and asserts ownership of "a number of marks for beverages that include the word ZERO" (see notice of opposition, para. 6).

A review of the second amended complaint filed in the civil action[2] indicates that the entities Mirza N. Baig and Blue Springs Water Company (plaintiffs therein), in asserting rights in the mark NATURALLY ZERO, seek judgment against opposer (defendant therein) for, inter alia, trademark infringement with respect to the mark ZERO in connection with beverage products. During the conference,

[2] The referenced civil action is *MIRZA N. BAIG and BLUE SPRINGS WATER CO. v. THE COCA-COLA COMPANY,* Case No. 08-CV-04206, pending

counsel for opposer indicated that a counterclaim has been filed seeking declaratory relief. In its reply brief, applicant asserts that he entered into an agreement with Mirza Baig and Blue Springs Water Company "to market and produce 'Naturally Zero' brand Cola and bottled water products" (see applicant's reply brief, p. 3).

At a minimum, the determination of the district court may have a bearing on the validity of one or more of the marks of which opposer asserts common law ownership, and on which opposer intends to rely, in the opposition proceeding. Moreover, on the present record, given the commonality of the properties involved in both proceedings, the Board has an interest in avoiding the duplication of efforts, and the possibility of outcomes that are or that incorporate inconsistent conclusions.

Furthermore, consolidated Opposition No. 91178953 and consolidated Opposition No. 91178927, to which opposer is a party defendant, may each have a bearing on opposer's rights in one or more of the marks on which it relies herein.

In view of these circumstances, the Board finds that suspension is appropriate pursuant to Trademark Rule 2.117(a). Accordingly, applicant's motion is hereby granted.

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in the United States District Court for the Northern District of Illinois, Eastern Division.

Proceedings in this opposition are suspended pending final disposition of the referenced civil action.[3]

Within twenty (20) days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action.[4]

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

INFORMATION FOR PRO SE PARTY

While Patent and Trademark Rule 11.l4 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

Strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. Throughout all stages of an inter partes proceeding, the Board expects of all parties their compliance with the Trademark Rules of

[3] In the event of resumption, the Board will set applicant's time to answer the notice of opposition.

[4] A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e. a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. *See* TBMP § 510.02(b)(3d ed. 2011).

Practice and, where applicable, the Federal Rules of Civil Procedure, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent,* 81 USPQ2d 1212, n.2 (TTAB 2006).