

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: July 10, 2018

Opposition No. 91239608
Cancellation No. 92067945

Unique Motorsports Inc.

v.

Neal Technologies, Inc.


Elizabeth A. Dunn, Attorney (571-272-4267):

On May 9, 2018 in each of the proceedings listed above, Neal Technologies, Inc. (hereafter, Respondent) moved to suspend proceedings pending the final determination of the bankruptcy case involving Unique Motorsports Inc. (hereafter, Petitioner).¹

Because in the absence of a counterclaim, the automatic stay provisions of Section 362 of the United States Bankruptcy Code do not mandate the suspension of a Board proceeding in which the plaintiff filed a petition for bankruptcy, the Board addresses whether Respondent's motion to suspend, in combination with the other filings in these proceedings, show good cause for suspension. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) 510.03(a) (2018).

¹ Because Respondent provides no legal support for finding that either an invalid domain name or a search engine reference to a business being closed is probative evidence that an entity no longer exists, the Board does not agree that Respondent previously established that "Opposer is no longer a viable entity."

As necessary background, the Board notes that Respondent owns the following registrations and pending application:

<p>Reg. No. 4235578 issued 11/6/12</p>	<p>BULLETPROOFDIESEL.COM (standard characters)</p>	<p>Automotive components, namely, oil coolers and exhaust gas re-circulation coolers for diesel engines; oil filtration systems comprised of filters for motors and engines and light bars for sport utility vehicles</p> <p>Vehicle engine parts, namely, engine oil thermostats</p> <p>Vehicle services, namely, repair and maintenance of diesel engines; repair and re-manufacture of diesel engine components, namely, engine oil coolers and exhaust gas re-circulation coolers</p>
<p>Reg. No. 4262825 issued 12/25/12</p>	 <p>(.COM disclaimed)</p>	<p>same as Reg. No. 4235578</p>
<p>Reg. No. 5130772 issued 1/31/17</p>	<p>BULLET PROOF (standard characters)</p>	<p>Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts</p>
<p>Reg. No. 5220129 issued 6/13/17</p>	<p>BULLET PROOF (standard characters)</p>	<p>Automotive repair and maintenance services, namely, repair and maintenance of diesel engines, and repair and installation of diesel engine components</p>
<p>App. No. 87610052 filed 9/15/17</p>	<p>DARN-NEAR BULLET PROOF (standard characters)</p>	<p>Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts</p>

THE DISTRICT COURT ACTION

On April 30, 2018, in response to the Board's order in Cancellation No. 92067945, Respondent filed excerpts from the record in *Neal Technologies, Inc. v. Unique Motorsports Inc. et. al.*, Civil Action No. 4:15-cv-385-RC-CMC, in the United States District Court for the Eastern District of Texas, Sherman Division. The amended complaint filed December 10, 2015 pleads, among other claims, trademark infringement of Respondent's marks BULLETPROOF, BULLET PROOF, and BULLET PROOF DIESEL for aftermarket diesel truck parts and related services, and seeks, among other remedies, to permanently enjoin Petitioner's use of "the BulletProof Marks (or any derivation of colorable imitation thereof)." 7 TTABVUE 6-21.² On February 4, 2016, Petitioner filed an amended answer and counterclaim to cancel Registration Nos. 4235578 and 4262825 for the marks BULLETPROOFDIESEL.COM in standard characters and with a design as abandoned. 7 TTABVUE 23-53,

On August 5, 2016, the jury issued a verdict finding the terms BULLETPROOF, BULLET PROOF, and BULLET PROOF DIESEL descriptive, and the registered marks BULLETPROOFDIESEL.COM in standard characters and with a design suggestive. The jury also found that Respondent did not show by a preponderance of the evidence that the terms BULLETPROOF, BULLET PROOF, and BULLET PROOF DIESEL had been used by Respondent and acquired secondary meaning in Texas prior to Petitioner's first use of those terms, or that Petitioner infringed Respondent's registered marks BULLETPROOFDIESEL.COM in standard characters and with a

² The TTABVUE references pertain to the electronic file for Cancellation No 92067945.

design. The jury also found that Respondent proved by a preponderance of the evidence that Petitioner committed unfair competition, that the conduct was willful, and not a fair use, and awarded \$100,000 to Respondent. 8 TTABVUE 1-10. On January 20, 2017, the court issued a final judgment and mandate awarding Respondent \$253,000 on its unfair competition claim, and entering a permanent injunction against Petitioner's use of the terms BULLETPROOF, BULLET PROOF, and BULLET PROOF DIESEL in connection with goods or services of the same type offered by Respondent. 7 TTABVUE 136-139.

CONSOLIDATION OF BOARD PROCEEDINGS

On February 15, 2018, Petitioner, acting pro se, filed the petition to cancel Registration Nos. 5130772 and 5220129 for the marks BULLETPROOF and BULLET PROOF. As noted above, Respondent has not filed its answer.

On February 21, 2018, Petitioner, acting pro se, filed the notice of opposition against application Serial No. 87610052 for the mark DARN-NEAR BULLET PROOF.

Respondent seeks to suspend its time to file an answer, as well as all other dates, in each proceeding.

Because consolidation avoids the risk of inconsistent or duplicative action by the Board as well as the parties, the Board exercises its discretion and sua sponte orders the consolidation of the above-captioned proceedings.³ In view thereof, Opposition No. 91239608 and Cancellation No. 92067945 are hereby consolidated.

³ When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also, Regatta*

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993). The Board file for these consolidated cases will be maintained in Opposition No. 91239608 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding numbers in its caption.⁴ The parties are further advised that despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file.

PETITIONER'S BANKRUPTCY PROCEEDING

On February 26, 2018, the district court, which retained jurisdiction to enforce the permanent injunction, issued a show cause order on Respondent's motion for contempt, noting that shortly after the court entered its final judgment and permanent injunction, Petitioner filed for bankruptcy, which resulted in a stay of the district court action. The court also noted that the bankruptcy proceeding concluded October 12, 2017. 7 TTABVUE 141-143.

On April 6, 2018, the court held a show cause hearing regarding alleged contempt of the court's order. An excerpt from the transcript shows that counsel for Petitioner

Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

⁴ One exception is the need for separate pleadings in each consolidated case. Should Respondent's time to file an answer be reset, separate answers will be required.

informed the court that Petitioner has ceased doing business, that Petitioner was unable to continue making payments under the Chapter 11 plan and is awaiting further action from the bankruptcy court. 7 TTABVUE 145-147.

RESPONDENT'S MOTION TO SUSPEND

In support of its motion to suspend this proceeding, Respondent submits its motion to the bankruptcy court alleging that the bankruptcy reorganization plan for Petitioner provides for conversion or dismissal in the event of debtor default; that Petitioner has defaulted under the reorganization plan; and Respondent seeks conversion of the bankruptcy proceeding to a liquidation under Bankruptcy Act Chapter 7 or dismissal of the reorganization proceeding with prejudice to filing further bankruptcy petitions. Petitioner filed no opposition to the motion to suspend, and has taken no action before the Board in either proceeding since filing its petition to cancel and notice of opposition.

In these circumstances where a court order may affect Petitioner's ability to bring its claims against Respondent, the Board finds that Respondent has shown good cause to suspend this consolidated proceeding pending final determination of the bankruptcy case involving Petitioner. Respondent's motion to suspend is GRANTED.

PROCEEDINGS ARE SUSPENDED FOR GOOD CAUSE

Within twenty days after the final determination of the bankruptcy case, Respondent 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 or email address changes for the parties or their attorneys.