

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: April 14, 2003

Cancellation No. 92030129

KINEDYNE CORPORATION

v.

TIE TECH, INC.

**David Mermelstein, Attorney:**

This proceeding was suspended on February 17, 2002, in light of a civil action between the parties. Now before the Board is petitioner's "status report and renewed and supplemental motion for summary judgment," filed August 7, 2002. Registrant filed a response to petitioner's paper on September 3, 2002.<sup>1</sup>

**Motion to Resume Proceedings**

Petitioner indicates that a final disposition of the civil action has been reached. Petitioner requests resumption of this proceeding and renews its motion for summary judgment. Registrant does not disagree with petitioner's report, but states that petitioner should have first requested resumption, prior to renewing its motion for summary judgment.

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<sup>1</sup> The Board regrets the delay in taking up this matter.

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Registrant's position makes little sense, since it does not disagree with petitioner's request to resume proceedings. The fact that petitioner's filing was made in one paper, rather than two is inconsequential, and serves only to expedite this matter.

Accordingly, proceedings herein are RESUMED to the extent set out below.

**Pending Motions**

In the Board's November 3, 2000, order suspending this matter, we noted that (in addition to the motion for suspension) petitioner had filed motions to permit submission of testimony from another proceeding and for summary judgment, and registrant had filed a motion to strike petitioner's motions. At the time of the Board's order, all motions except for the motion for summary judgment had been briefed. After granting registrant's motion to suspend, the Board added that "[a]ll other pending motions are DENIED without prejudice." Petitioner now seeks to renew its motion for summary judgment and to supplement the motion "to emphasize the finding by the United States Court of Appeals for the 9<sup>th</sup> Circuit that the subject matter of Registration No. 2,162,994 is wholly functional..."

Upon reflection, it appears that the Board's November 3, 2000, order was in error, to the extent that it "denied" the pending motions. The motions should have been deferred

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until resolution of the civil matter. Accordingly, that portion of the November 3, 2000, order denying the motion for summary judgment, the motion to admit testimony, and to strike is VACATED.

**Motion to Admit Testimony**

On May 1, 2000, petitioner submitted a motion requesting leave to submit testimony from another proceeding, pursuant to Trademark Rule 2.122(f). Registrant filed an opposition to the motion to admit, stating that

"[t]he depositions were taken before Tie Tech had notice or knowledge of Kinedyne's cancellation petition. Tie Tech will not agree or stipulate to the use of these depositions in the cancellation proceeding. Under the Federal Rules of Evidence, none of the depositions taken thus far by Kinedyne are admissible as evidence in the District Court proceedings. All of the deponents reside in the District Court's territory and are subject to subpoena for trial testimony. Their depositions will be used only in the event that their trial testimony is inconsistent with their deposition testimony in some way. Therefore, Registrants had no reason to cross-examine the deponents at the time their depositions were taken, due to their availability at trial.

Petitioner's motion is DENIED, because it was unnecessary. Trademark Rule 2.122(f) refers to matters in evidence at trial. Matters submitted in support of a motion for summary judgment are not governed by the same evidentiary and procedural rules as trial evidence. See Trademark Rule 2.127(e)(2); Fed. R. Civ. P. 56. Petitioner's proffered deposition transcripts will therefore be considered, for whatever probative value they may have.

**Motion for Summary Judgment**

By its current motion, petitioner renews its motion for summary judgment and supplements its motion with reference to the judgment and opinion of the Ninth Circuit. We construe petitioner's motion as one requesting summary judgment on the basis of the preclusive effect (if any) of the civil action.

Accordingly, registrant is allowed until THIRTY DAYS from the mailing date of this order in which to file a response to petitioner's motion for summary judgment, filed May 1, 2000, as supplemented August 7, 2002.

**Registrant's Motion to Strike**

In light of this order, registrant's motion to strike petitioner's motions for summary judgment and motion to admit testimony is DENIED.

**Proceedings Suspended**

Proceedings herein are SUSPENDED pending a decision on the motion for summary judgment. The parties should not file any paper which is not germane to the motion.

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