

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

Baxley

Mailed: May 27, 2003

Opposition No. 91/153,705
Opposition No. 91/154,237
Opposition No. 91/154,459
Opposition No. 91/154,650
Opposition No. 91/155,391
Cancellation No. 92/041,733

MILTON SALES, INC. ("Milton")

v.

UNIVERSAL MANUFACTURING
COMPANY, INC. ("Universal")

Opposition No. 91/155,450

UNIVERSAL

v.

MILTON

(as consolidated)

By the Trademark Trial and Appeal Board:

It has come to the Board's attention of the Board that, due to a clerical error by the Patent and Trademark Office, Trademark Registration No. 2,712,884 (application Serial No. 76/335,301, the involved application in Opposition No. 155,391), for the mark DOUBLE PECKERS, was inadvertently issued on May 6, 2003. The registration issued inadvertently after a Notice of Opposition had been timely

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

filed with the Trademark Trial and Appeal Board and Opposition No. 155,391 had been instituted.

Accordingly, the above-identified application will be forwarded to the Office of the Commissioner for Trademarks for appropriate action.

The Board's order instituting Opposition No. 154,237 and a copy of the notice of opposition were forwarded to Universal but were returned by the United States Postal Service as undeliverable. In view of Universal's non-receipt thereof and in view of the Board's policy of deciding cases on the merits where possible, Milton's motion (filed March 5, 2003) for default judgment in that proceeding is hereby denied.¹ See TBMP Section 317.02.

The Board, by its own initiative, hereby orders the consolidation of the above-referenced proceedings inasmuch as the parties are the same and the seven proceedings involve common questions of law or fact.² See *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975). In view thereof, Opposition Nos. 153,705, 154,237,

¹ It is noted, however, that Universal's new attorneys subsequently entered an appearance herein and that the Board's records have been updated to reflect Universal's correspondence address.

² 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 Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

154,459, 154,650, 155,391, 155,450 and Cancellation No. 41,773 are hereby consolidated.³

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 will be maintained in Opposition No. 153,705 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 include all seven proceeding numbers in its caption.⁴ Exceptions to the general rule involve stipulated extensions of the trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

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 pleading; a copy of the decision shall be placed in each proceeding file.

³ Accordingly, Universal's motions (filed April 21, 2003) to consolidate the above-referenced proceedings are moot.

⁴ However, because the above-captioned proceedings were consolidated prior to joinder of the issues in Opposition Nos. 154,237 and 155,450 and Cancellation No. 41,773, the defendant in each proceeding should file a separate answer in each of those proceedings upon resumption of this case.

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

This case now comes up for consideration of Universal's motions (filed March 31, 2003) to suspend proceedings in Opposition Nos. 153,705 and 154,237 pending disposition of a civil action in the United States District Court for the Southern District of West Virginia between the parties.⁵ Milton filed briefs in response thereto.

In support of its motions, Universal contends that the parties' civil action will have a bearing on these consolidated proceedings and thus asks that this proceeding be suspended pending final disposition of the civil action.⁶

In response, Milton states that it agrees with Universal that proceedings herein should be suspended. However, it states that it served discovery requests in Opposition Nos. 153,705 and 154,237 and contends that, inasmuch as Universal waited until after the discovery requests were served to file its motions to suspend, Universal should be required to serve responses to those discovery requests after the issuance of the Board's

⁵ The Board notes that it granted as conceded Universal's motion (filed March 26, 2003) to suspend in Opposition Nos. 154,459 on May 16, 2003; granted as conceded Universal's motion (filed March 31, 2003) to suspend in Opposition Nos. 154,650 on May 14, 2003; and granted as well-taken Universal's motion (filed March 28, 2003) to suspend in Cancellation No. 41,773. In view of the Board's decision in this order, Universal's motions to suspend (filed April 21, 2003) in Opposition Nos. 155,391 and 155,450 are moot.

⁶ The civil action is styled *Milton Sales, Inc. v. Universal Manufacturing Company, Inc.*, Case No. 2:01-1046, filed November 16, 2001.

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

suspension order. To the extent that Milton wishes its response to be construed as a motion to compel, Milton contends that it made a good faith effort to resolve the parties' discovery dispute before filing its response.

Whenever it shall come to the Board's attention that parties to a pending case are engaged in a civil action that may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action. See Trademark Rule 2.117(a). The Board does so because the court's findings with regard to the parties' claims and counterclaims in the civil action have a bearing on the Board proceedings, and, more importantly, those findings will be binding upon the Board. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn 1986); *Other Telephone Co. v. National Telephone Co.*, 181 USPQ 79 (Comm'r Pats. 1974); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

In view thereof, Universal's motions to suspend Opposition Nos. 153,705 and 154,237 are hereby granted. Accordingly, all of the above-captioned proceedings are hereby suspended, retroactive to March 26, 2003 (the filing date of Universal's motions to suspend in Opposition Nos. 154,237 and 154,459 and the earliest filing date of Universal's motions to suspend), pending final disposition, including any appeals and/or remands, of Case No. 2:01-1046.

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

See *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

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.

The Board turns next to Milton's contention that Universal should be required to serve responses to discovery requests that Milton served on March 19, 2003 in connection with Opposition Nos. 153,705 and 154,237 following the issuance of this suspension order because Universal waited until after the discovery requests were served to file its motions to suspend. It is noted that, other than when a case is suspended pending disposition of a motion to compel, the Board generally treats a suspension order as tolling all dates, including the time for the parties to respond to discovery requests or to appear for any duly noticed depositions. See Trademark Rules 2.117 and 2.127(d), but see Trademark Rule 2.120(e)(2). The Board finds that the circumstances herein do not warrant deviation from Board

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

practice.⁷ As such, Universal is not required to serve responses to Milton's discovery requests while this case is suspended.

Further, to the extent that Milton seeks to have its response to Universal's motion to suspend construed as a motion to compel, it is noted that Milton did not include a copy of the discovery requests at issue, as is required by Trademark Rule 2.120(e)(1), with its response. Accordingly, Milton's motion to compel is hereby denied without prejudice.

Inasmuch as the Board deems proceedings herein suspended as of March 26, 2003, the notice of default that was issued in Opposition No. 155,450 on May 9, 2003 is hereby vacated.

In the event that Case No. 2:01-1046 is not dispositive of the above-captioned proceedings, Milton's time to file an answer in Opposition No. 155,450, Universal's time to file answers in Opposition No. 154,237 and Cancellation No. 41,773, and the parties' time to respond to any outstanding

⁷ It is noted that Case No. 2:01-1046 commenced on November 16, 2001, i.e., eleven months before the commencement of Opposition Nos. 153,705 and 154,650, the oldest of the above-captioned proceedings. The parties knew, or should have known, that the civil action has a bearing on the above-captioned proceedings and indeed may be dispositive thereof. Accordingly, they could have brought that case to the Board's attention as early as the filing date of the notice of opposition or petition to cancel in each of the proceedings so that the Board could have considered whether suspension of the above-captioned proceedings before the proceedings moved forward and, in so doing, saved both the Board and the parties considerable time and effort.

Opposition Nos. 153,705, 154,237, 154,459, 154,650, and 155,450; Cancellation No. 41,773

discovery requests in any of the above-captioned proceedings will be reset when the above-captioned proceedings are resumed.