

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

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Mailed: July 1, 2005

Cancellation No. 92044059

Paragon Solution Network,
Inc.

v.

InkQuik, Inc.

Elizabeth A. Dunn, Attorney:

On December 27, 2004, Paragon Solution Network, Inc. filed a petition to cancel Registration No. 2734105 for the mark INKQUIK, alleging the term is merely descriptive as applied to the goods. In lieu of an answer, on February 10, 2004 respondent filed a motion to suspend proceedings pending the outcome of a civil action between the parties herein.¹ The motion has been fully briefed.

In support of its motion, respondent submits the complaint filed September 1, 2004 against petitioner by respondent before the United States District Court for the

¹ In view of the Board's delay in taking up this motion, proceedings are considered to have been suspended as of the filing date of the motion to suspend.

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District of Oregon alleging, *inter alia*, trademark infringement of its INKQUIK mark by petitioner's use of the mark QUICK INKS. CV04-1234 JE. In opposing suspension, petitioner alleges that the Board is uniquely suited to decide the trademark issues involved herein, and that having the cancellation and civil action proceedings run concurrently will allow both parties to curtail discovery expenses.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117 (a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568, 570 (TTAB 1971).

In this case, the parties to the instant cancellation are the same as the parties to the civil action, and the decision in the civil case may include a determination of petitioner's rights to its asserted mark, a determination which will have a bearing on the issues before the Board.

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Moreover, 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 Federal district court is binding upon the parties before the Board, while the decision of the Board with respect thereto is not binding upon the court. *See, for example, Goya Foods Inc. 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).

In view of the foregoing, and in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, respondent's motion to suspend is hereby granted to the extent that proceedings herein are suspended pending final disposition of the civil action between the parties.

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.