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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050388
Party	Defendant Adena Surabian
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Submission	Other Motions/Papers
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Date	01/05/2009
Attachments	Motion to Suspend.pdf ( 8 pages )(77280 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NATURE'S ONE, INC,

Petitioner,

v.

SURABIAN, ADENA,

Defendant.

Petition: 92050388  
Registration: 3118082  
Mark: NATURE'S BABY  
Registration date: July 18, 2006

**MOTION TO SUSPEND PETITION FOR CANCELLATION**

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, VA 22202-3514

Pursuant to 37 CFR § 2.117(a) and TBMP § 51O.02(a), Defendant Adena Surabian hereby requests that the Trademark Trial and Appeal Board (the "TTAB" or the "Board") suspend the present petition for cancellation and, with it, further consideration of the petition of Nature's One, Inc. ("NO") for cancellation until the final determination of *Nature's One, Inc. v.*

Nature's Baby Products, Inc., United States District Court, Southern District of Ohio, Case No. 08 CV 543 ("Civil Action"), because the Civil Action will have a direct bearing on the instant proceeding.

## INTRODUCTION

In the last year, NO has commenced no less than three actions, two before this Board and one in the United States District Court, all targeted at Adena Surabian and Nature's Baby Products for what it claims are similarities between names and products that injure its business. Those claims, in essence, are that consumers are incapable of discerning the differences between baby food, one the one hand, carrying the branding and label below;



and baby shampoos, conditioners, soaps, detergents, ointments, and oils, carrying the following branding and label to the right.

In NO's world, it owns exclusive rights to the words, "Baby," "Only," "Organic," and "Nature," no matter what the class of product or order of the words. The first problem is that NO never sought trademark protection for those words in isolation or in the specific combination granted to Defendant Surabian – Nature's Baby – and, in fact, would never have received such protection absent a prior application – that NO never submitted.

The second and more disturbing problem is that NO, having instigated the initial rounds of litigation and challenges, proceedings that were *suspended* by this Board pending the outcome

of the federal action, has seen fit to launch another round of challenges, intended to circumvent this Board's suspension and collaterally attack Defendant's rights, lawfully acquired and properly granted years ago.

This Board should not only suspend the present petition but view NO's challenges, including the latest challenge to Surabian, NBP, and the entire line of Nature's Baby products as an improper abuse of this Board's resources.<sup>1</sup>

### **FACTUAL BACKGROUND**

Adena Surabian is the owner and Nature's Baby Product (NBP) is the exclusive licensee of trademark registration No. 3,118,082 for the mark NATURE'S BABY for organic shampoos, conditioners, soaps for body care, laundry detergent, non-medicated diaper rash ointments and massage oils, all for use with babies and children, and baby product dishwashing soap in International Trademark Class 3.

On December 3, 2006 NBP filed an application, 77055971, for "Nature's Baby Organics," "IC 003. US 001 004 006 050 051 052. G & S: Organic shampoos, conditioners, soaps for body care, laundry detergent, non-medicated diaper rash ointments and massage oils, all for use with babies and children, and baby product dishwashing soap. FIRST USE: 20060511. FIRST USE IN COMMERCE: 20060511"

The publication date for the application was April 8, 2008.

### **CASE #1 - NO v. NBP**

**(US DISTRICT COURT, S.D. Ohio, Case No. 08-CV-543)**

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<sup>1</sup> While Surabian recognizes that a motion to suspend is not the proper place for a merits determination, this Board can consider the weakness of the claims in the petition in its consideration of the motion to suspend pending the federal litigation.

On June 5, 2008, NO filed a complaint in the United States District Court for the Southern District of Ohio (“S.D.Oh.”), alleging, inter alia, trademark infringement under 15 U.S.C. § 1114; false designation of origin under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); derivative claims under Ohio Revised Code §41; and parasitic claims relating to alleged injury to business reputation based on the claim that there is a likelihood of injury to NO based on confusion.

NBP answered the complaint. The case is presently in discovery phase.<sup>2</sup> The discovery cutoff date is June 30, 2009. Motions for summary judgment must be brought by July 31, 2009. A trial date has not yet been set.

**CASE #2 - NO v. NBP**  
**(TTAB, Opposition No. 91185583)**

NO filed its opposition to the application on August 4, 2008, specifying the nature and extent of its opposition to include the following:

Class 003. First Use: 2006/05/11 First Use In Commerce: 2006/05/11 All goods and services in the class are opposed, namely: Organic shampoos, conditioners, soaps for body care, laundry detergent, non-medicated diaper rash ointments and massage oils, all for use with babies and children, and baby product dishwashing soap.”

The basis for NO’s claim was confusion based on its registration of two marks used exclusively in conjunction with baby food, “Nature’s One,” US Registration 2504996, “Class 005. First use: First Use: 1999/04/01 First Use In Commerce: 1999/04/01 Baby Food;” and “Baby’s Only Organic, US Registration 2563813, “Class 005. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 Organic baby food.”

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<sup>2</sup> To this point, there has been presented no evidence of actual confusion as between the asserted and proposed marks.

Based on the foregoing federal action, on August 21, 2008, NBP requested and on October 13, 2008 this Board agreed to stay the TTAB proceeding (Case #1) until conclusion of Case #2.

**CASE #3 - NO v. SURABIAN**  
**(TTAB, Cancellation Petition 92050388)**

Intent on further hindering the proceedings relating to NBP's defense of its application as well as its defense of its very corporate existence in the Federal Court, NO initiated another attack on NBP, this time against Adena Surabian and the underlying Trademark, Nature's Baby, Registration No. 3118082, issued on July 18, 2006.

Notwithstanding Defendant's uninterrupted use of the mark without objection by Petitioner, it was not until Petitioner realized that its own claims were undermined by years of actual use that it turned its attentions to collaterally attacking the proceedings in the District Court by the present petition.

Simply put, if it could eliminate NBP's claim to prior registration of Nature's Baby, it would presumably eliminate a defense to NO's claim in the District Court and to the opposition to the Nature's Baby Organics trademark application.

All of the foregoing, including the present petition is based on the assertion by NO that consumers, looking at entirely different product packaging, faced with two distinctly named products – one baby FOOD and the other SHAMPOO – will confuse the one for the other.<sup>3</sup> NBP answered the complaint in the Civil Suit accordingly.

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<sup>3</sup> For what it is worth, Petitioner has, in the federal action, not demonstrated a single instance of confusion. Perhaps consumers are not as naive as Petitioner asserts.

Notwithstanding the fact that Surabian believes both the challenge to her trademark rights as well as the parallel challenges to NBP's pending trademark application and the federal lawsuit to be frivolous, not warranted by reasonable reliance upon fact or law, Surabian also believes that it is in the best interest of the parties and of this Board to stay proceedings before this Board until resolution of the Civil Action.

## **ARGUMENT**

### **The Determinations in the Civil Suit Will Have a Direct Bearing on the Issues Before the Board**

Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on the TTAB matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR § 2.1 17(a); TBMP § 510.02(a). This is because "a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right to retain its registration would not be binding or *res judicata* in respect to the proceeding before the federal district court." *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805,807 (TTAB 1971). A court's decision regarding the right to registration is binding on the TTAB *The Seven-Up Co. v. Bubble Up Co.*, 136 U.S.P.Q. 210,214 (C.C.P.A. 1963); see also *In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501,503 (TTAB 1984); J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition § 32:94 (4th ed. 2006) (hereinafter "McCarthy").

Petitioner and Defendant are both involved in the Civil Action that is currently pending before the S.D. Oh., involving the designations and claims that are at issue in the instant proceeding. In that case, the District Court will determine the rights of NBP, of which Surabian is President and assignor of the rights to "Nature's Baby," and NO with respect to the "Nature's

Baby Organics” mark and designation. That determination and the evidence addressing NO’s claims will directly affect the issues surrounding the latest challenge brought by NO, this time to Defendant’s underlying trademark rights in “Nature’s Baby,” the very name of the entity by which the mark and associated products are produced, marketed, and distributed. This type of determination will directly affect the resolution of the issues before the Board. See *The Other Tel. Co. v. Conn. Nat’l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126-7 (TTAB 1974).

Based on the foregoing, Surabian respectfully requests that the Board stay this proceeding pending the final determination of the Civil Action.

DATED: January 5, 2009

DATED: January 5, 2009

Respectfully submitted,

FINK AND ABRAHAM LLP

Attorneys for Defendant Adena Surabian

By: \_\_\_\_\_



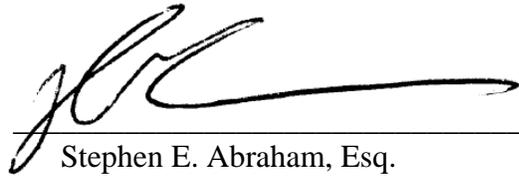
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing MOTION TO SUSPEND PETITION FOR CANCELLATION has been served upon counsel for Nature's One, Inc., on January 5, 2008, in the manner indicated.

Via First Class U.S. Mail

Carol Stovsky  
STANDLEY LAW GROUP LLP  
495 Metro Place South, Suite 210  
Dublin, Ohio 43017-5319

A handwritten signature in black ink, appearing to read 'S. Abraham', written over a horizontal line.

Stephen E. Abraham, Esq.  
Attorney for Defendant Adena Surabian