

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

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Mailed: June 30, 2011

Cancellation No. 92051986

Versatile Housewares &
Gardening Systems, Inc.

v.

Jordan Drew Corporation

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

This case comes up on respondent's motion, filed June 8, 2011, to suspend proceedings pending the district court's disposition of the civil action between the parties.¹ The motion is contested, and the Board held a phone conference with the parties on June 29, 2011. The participants were John Rosenthal, attorney for petitioner, Michael Griggs, attorney for petitioner, and Elizabeth Dunn, attorney for the Board.

On June 6, 2011, based on the parties' failure to respond to the Board's April 4, 2011 status inquiry regarding the district court action which had been the basis

¹ Respondent filed the identical motion by mail, which was received June 10, 2011 and entered into the proceeding file on June 14, 2011. There is no need for duplicative filings, which only confuse the record.

for suspension, the Board resumed proceedings. With its current motion, respondent explains that its failure to respond to the Board's status inquiry was inadvertent, and that the civil action remains pending. Respondent attached a copy of the court's June 3, 2011 scheduling order.

Petitioner's opposition to suspension contends that all discovery relevant to this cancellation has been taken during the district court litigation involving similar claims, and thus the issues raised in this cancellation are ripe for summary judgment.

As background, the Board notes that the petition to cancel filed January 22, 2010 alleges priority and likelihood of confusion between the parties' respective AWESOME AUGER marks, and fraud based on respondent's claim of an exclusive right to use the mark, made to procure subject Registration No. 35466843. Respondent's February 17, 2011 motion to suspend, which was granted as conceded, was accompanied by the September 3, 2010 complaint in the civil action seeking, among other remedies, cancellation of Registration No. 35466843. During the conference the parties clarified that, while the district court pleadings have been amended, the district court will still address whether Registration No. 35466843 should be cancelled.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be

dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). A Board proceeding conducted concurrently with a district court proceeding would require a duplication of effort by the parties and risk inconsistent results in two fora. Moreover, the Board's final decision would be merely advisory, and not binding in respect to the proceeding pending before the federal district court. *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971). In contrast, the federal court determination of a trademark issue normally has a binding effect in subsequent proceedings before the Board involving the same parties and issue. *Id.*; *In re Alfred Dunhill*, 224 USPQ 501, 503 (TTAB 1984); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §510.02 (3rd ed. 2011).

Because the district court's determination could be dispositive of this proceeding, petitioner's motion to suspend proceedings pending the district court's resolution of the civil action is granted.

Within twenty days after the final determination of *Versatile Housewares & Gardening Systems, Inc. v. Thill Logistics, Inc., SAS Group, inc., NAT, LLC, and Jordan Drew Corporation*, Civil Action 09:cv-10182(KMK), plaintiff should notify the Board so that this case may be called up for

appropriate action. During the suspension period, the parties promptly shall notify the Board in writing of any address changes for the parties or their attorneys, or if the parties become parties in another Board proceed or another civil action involving related marks or other issues of law or fact which overlap with this case.

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