

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

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Mailed: August 3, 2011

Cancellation No. **92053114**

Lawrence A. Fulton

v.

Wally Marshall

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

On December 9, 2010, respondent filed a notice of appearance of counsel and a change of correspondence. Respondent also filed a motion to suspend this proceeding pending disposition of a civil action between the parties<sup>1</sup> with a copy of the complaint in the civil action attached thereto. On December 14, 2010, respondent filed a motion to amend its Registration No. 2240622.<sup>2</sup> Both the motion to suspend and the motion to amend are contested.

Turning first to the notice of appearance and change of correspondence, the Board's records have been updated to reflect Kelly J. Kubasta, Esq. of Klemchuk Kubasta LLP as respondent's attorney of record. Respondent's correspondence address has also been updated.

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<sup>1</sup> *Wally Marshall d/b/a Mr. Crappie v. Lawrence A. Fulton*, Case No. 3:08-cv-01921-L in the United States District Court for the Northern District of Texas, Dallas Division.

<sup>2</sup> For the mark MR. CRAPPIE in typed form for "fishing lures, fishing tackle and other fishing accessories, namely, rods, reels, hooks, jigs, floats, and line" in International Class 28. The underlying application was filed February 23, 1998, and registered on the Principal Register on April 20, 1999, with a date of first use anywhere and in commerce of November 1, 1997. A Section 8 affidavit was accepted by the Office on June 16, 2004, and the registration was renewed on September 10, 2008.

Turning next to the motion to suspend, respondent argues that suspension in favor of the civil action is appropriate because petitioner, in both the civil action and Board proceeding, "raises the issue of ownership (i.e., whether the owner of [respondent's] trademark registration is an individual or corporation) and its effect on the validity of the trademark registration." *Motion to Suspend*, p. 3. Petitioner counters that the civil action will not have a bearing on the Board proceeding because the "sole basis for this action before the Board is due to a [non-correctable] mistake in the listing of the owner of the registration-in-suit" whereas "[r]espondent did not plead the issue of mistake" in the civil action. *Response to Motion to Suspend*, p. 1.

The Board's well-settled policy is 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). This is so insofar as a decision of the Federal district court is often binding upon the Board while the decision of the Board is not binding upon the Federal district court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988).

Although petitioner argues that "there is no commonality of issues" between the Board proceeding and the civil action, this is simply not true. In petitioner's answer to respondent's third amended complaint in the civil action under

Paragraph E, petitioner "raises the failure to include a proper party to this action as an affirmative defense, in that the listed owner of the Trademark-in-Suit, U.S. Trademark Registration No. 2,240,622, is a Texas Corporation under the name 'Wally Marshall' but that the Plaintiff in this matter is an individual named Wally Marshall." As this issue forms the basis of the Board proceeding, and since the parties in the civil action are identical or, at the very least, related to the parties herein, and the marks at issue are the same, suspension is appropriate and respondent's motion to suspend is hereby **GRANTED**. See Trademark Rule 2.117(a). Accordingly, proceedings herein are **SUSPENDED** pending final disposition of the civil action and consideration of respondent's motion to amend is **DEFERRED** and will be taken up upon resumption of proceedings.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

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