

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

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Mailed: October 21, 2011

Cancellation No. 92053735

Water Tec of Tucson, Inc.

v.

Richard Joseph DeGrave

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

This case comes up on respondent's contested motion to suspend proceedings.¹ The Board held a phone conference with the parties on October 19, 2011. The participants were Nikia Gray, attorney for petitioner, Michael Lindsey, attorney for respondent, and Elizabeth Dunn, attorney for the Board.

This cancellation involves petitioner's claim of priority of use and likelihood of confusion between its common law mark and respondent's registered mark, as used on the goods and services listed below. In lieu of an answer, respondent filed the instant motion to suspend

¹ The Board agrees that the redacted version of the attachments to the motion are sufficient.

proceedings pending the disposition of the district court and state court trademark infringement proceedings between the parties.

Respondent's Registration No. 3719837	Petitioner's common law mark
	
<p>Aquarium filtration apparatus; Aquarium heaters; Electric bath-water purifying apparatus for household purposes; Filters for drinking water; Filters made of fiber for water filtration; Filters, heaters and pumps sold in combination for use in swimming pools; Flow restrictors for reverse osmosis water purification units; Industrial-water purifying apparatus; Ozone sanitizers for air and water; Swimming pool chlorinating units; Swimming pool water cleaning and filtering units; Water filtering apparatus; Water filtering units for aquariums; Water purifying apparatus; Water treatment equipment, namely, reverse osmosis filtration units</p>	<p>includes, but are not limited to, the sale of water conditioning units, water filtering units for residential and commercial use; water softening units; water treatment equipment namely, cartridge filtration units, reverse osmosis filtration units and ultraviolet sterilization units, installation of the same, and maintenance of the same</p>

Respondent's motion to suspend is accompanied by the complaints filed March 31, 2008 in the Pima County Superior Court, State of Arizona (*R. Leigh DeGrave, Jennifer L. DeGrave, et. al v. Water-Tec International, Inc., Richard*

J. DeGrave et al, Case No. C20077506) and August 7, 2009 in the United States District Court for the District of Arizona (*Water Tec of Tucson, Inc. v. Water Tec International, Inc.*, Case No. 4:09-cv-00434-DCB), as well as the district court's July 16, 2010 order staying its proceeding pending the disposition of the Arizona court proceeding. The district court's stay order found that Water Tec of Tucson, Inc. and Water Tec International, Inc. were commonly-owned and managed family companies that both used the WATER TEC and design trademark until 2007, when respondent's son took control of Water Tec of Tucson, Inc., and that respondent remains an officer and, with his wife, majority stockholder of Water Tec International, Inc. The district court's stay order also found that on October 30, 2008, the parties entered into a confidential settlement agreement; that both the state and district court actions involve claims of trademark infringement; that the settlement agreement may dispose of the disputed trademark rights; and that the district court action was a "spin-off" of the state action, and should be stayed.

Under Trademark Rule 2.117, a civil action "does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board." New Orleans Louisiana Saints LLC and

NFL Properties LLC v. Who Dat?, Inc., 99 USPQ2d 1550 (TTAB 2011). Petitioner opposes suspension of this proceeding because the civil litigation involves respondent's use of the WATER TEC mark, and not the registered mark for WATER IXC. However, petitioner's right to exclude others from use of the WATER TEC mark is central to the civil litigation, is challenged by respondent, and will have a bearing on this proceeding in which petitioner also asserts its right to use the WATER TEC mark. Accordingly, respondent's motion to suspend proceedings pending the disposition of the Arizona and district court proceedings is granted.

The parties notified the Board that the state court action had been dismissed on September 23, 2011, and that following expiration of the appeal period, petitioner would request resumption of the district court action.

Within twenty days after the final determination of the civil actions, the parties must notify the Board so that this case may be called up for appropriate action.

During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

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