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

Proceeding	92057820
Party	Plaintiff American Pro International Corp.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

American Pro International Corp.,
Petitioner,

v.

American DJ Supply, Inc.,
Registrant.

Cancellation No.: 92057820
Registration No.: 3,964,197
Mark: **AMERICAN AUDIO**
Registration Date: May 24, 2011

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO SUSPEND
PROCEEDINGS**

Petitioner, American Pro International Corp. (“American Pro” or “Petitioner”), respectfully submits this memorandum in Opposition to Respondent’s Motion to Suspend Proceedings (“Motion to Suspend”), filed by Registrant, American DJ Supply, Inc. (“ADJ” or “Registrant”).

ADJ’s request for suspension is improper, given that, as presently constituted, final determination of the pending litigation referenced in ADJ’s Motion to Suspend will have no bearing on this Cancellation proceeding because the issue of cancellation of the ‘197 Registration is not before the district court. As a result thereof, ADJ’s suspension request should be denied.

While the Board is empowered with the discretion to suspend proceedings where a civil action seeks relief *identical* to the relief requested in the TTAB, the Board is not required to automatically suspend proceedings in the face of concurrent civil litigation. *See* 37 C.F.R. § 2.117 (“Whenever it shall come to the attention of the [Board] that a party or parties to a pending case are engaged in a civil action...which may have a bearing on the case, proceedings before the Board may be suspended until termination of

the civil action...” (emphasis added); *see also Boyds Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q. 2d 2017, 2018 (TTAB 2003)(“both the permission language of Trademark Rule 2.117(a)...and the explicit provisions of Trademark Rule 2.117(b) make clear that suspension is not the necessary result in all cases”); *Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 U.S.P.Q. 568, 570 (TTAB 1971)(rejecting notion that the Board “automatically suspends proceedings” when civil litigation is concurrently pending and observing that “[s]uspension under such circumstances is granted only after both parties have been heard on the question and the Board has carefully reviewed the pleadings in the civil suit to determine if the outcome thereof will have a bearing on the question of the rights of the parties in the Patent Office proceeding”).

As noted above, the district court will not determine whether the ‘197 Registration should be cancelled. Petitioner has not sought cancellation of the ‘197 Registration in the civil action. The existence of similar *claims* (or defenses), however, is not dispositive. *See Boyds Collection Ltd.*, 65 U.S.P.Q. 2d at 2018 n. 2 (denying motion to suspend despite civil action alleging, *inter alia*, trademark infringement, unfair competition under § 43 of the Lanham Act and dilution under § 43(a) of the Lanham Act). Because only the current proceeding would presently result in the cancellation of the ‘197 Registration, the district court will evaluate the issue of infringement in a manner different from this Board. *See Marc A. Bergsman, Tips From the TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings*, 80 Trademark Rep. 540, 540 (1990) (“district courts determine the right to use a mark” whereas the TTAB “is limited to deciding the rights to registration”).

As a result, the “legal issues” here are materially different from those in the civil action and the Board should exercise its discretion and **NOT** suspend this Cancellation proceeding.

For the reasons specified above, American Pro respectfully requests that the Board deny ADJ’s Motion to Suspend and promptly resume the Cancellation proceeding.

Date: November 4, 2013

Respectfully submitted,

FRIEDLAND VINING

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CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that the foregoing **PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND PROCEEDINGS** was served upon the Registrant by delivering true and correct copies of same to Registrant's counsel via U.S. mail on November 4, 2013 as follows:

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