

THIS ORDER IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: March 22, 2018

Cancellation No. 92066377

*Cramer Products, Inc.*

*v.*

*Poly-Gel L.L.C.*

**Before Mermelstein, Wellington and Heasley, Administrative Trademark Judges.**

**By the Board:**

This case now comes up on the following motions:

1. Respondent's motion for discovery sanctions, filed March 6, 2018;
2. Respondent's motion for summary judgment, filed March 15, 2018; and
3. Petitioner's motion, filed March 16, 2018, to suspend pending disposition of a civil action between the parties in the United States District Court for the District of New Jersey, styled as *Cramer Prods., Inc. v. Poly-Gel, L.L.C.*, Case No. 2:18-cv-03473, filed March 12, 2018.

The motion for sanctions and to suspend for civil action are contested.

### **Motion for Sanctions**

Respondent seeks discovery sanctions in the nature of judgment in Respondent's favor and argues "no lesser sanction would seem to suffice."<sup>1</sup> Respondent alleges that

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<sup>1</sup> 6 TTABVUE 4. Respondent requests "entry of a judgment of default, on the merits." Default judgment lies for failure to enter an answer or otherwise respond and is available against the

on January 18, 2018, during a verbal discussion regarding potential settlement, Petitioner's counsel stated it "did not see why it should be compelled to respond to any discovery" served by Respondent. Respondent's counsel agreed to provide a settlement proposal and eventually to extend the deadline for Petitioner's responses to discovery until March 5, 2018.<sup>2</sup> Respondent argues that with no discovery responses served or reply from Petitioner concerning the settlement offer, Respondent filed the motion for sanctions on March 6, 2018, the last day of discovery.

In its response to the motion for sanctions, Petitioner recounts a different series of events leading to Respondent's filing of its motion for sanctions. In its attached declaration, Petitioner's counsel stated that Petitioner "never told [Respondent] that it was refusing to provide discovery responses."<sup>3</sup>

Trademark Rule 2.120(h)(2), 37 C.F.R. § 2.120(h)(2), provides that the Board may impose discovery sanctions if a party, or its attorney, after being duly served with discovery requests, informs the party seeking discovery that no response will be made. *See, e.g., Kairos Inst. of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1542-43 (TTAB 2008).

Without being privy to the actual conversations, we cannot agree with Respondent's characterization of Petitioner's statements made during settlement discussions as tantamount to a refusal to participate in discovery, as contemplated

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defendant in a proceeding. *See* Trademark Rule 2.114(a), 37 C.F.R. § 2.114(a) and Fed. R. Civ. P. 55(a). The Board construes the motion as one for judgment as a sanction.

<sup>2</sup> Declaration of Edwin D. Schindler, Atty. 6 TTABVUE 6-7.

<sup>3</sup> Declaration of Christina J. Moser, Atty. 8 TTABVUE 109.

by Trademark Rule 2.120(h)(2). We further note that Petitioner disputes Respondent's assertions in this regard.

Accordingly, Respondent's motion for sanctions is **denied**.

### **Motion for Summary Judgment**

Respondent's motion for summary judgment was filed during the pendency of Respondent's potentially dispositive motion for sanctions. When a party to a Board proceeding timely files a motion that is potentially dispositive of the proceeding, such as a motion for judgment, the case is considered automatically suspended by operation of Trademark Rule 2.127(d). Respondent alleges its motion for summary judgment is meant to "convert, supplement and now incorporate by reference ... its pending motion" for sanctions. The Board decides the motion for summary judgment on the merits.

By its motion for summary judgment, Respondent seeks judgment in its favor dismissing the petition to cancel alleging Petitioner has not responded to Respondent's discovery requests and thereby will not be able to establish common law rights in its mark.<sup>4</sup>

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). In deciding motions for summary judgment,

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<sup>4</sup>The Board notes the motion is not based on effective admissions, and does not include copies of Respondent's discovery requests. Even if the Board were to consider the discovery requests attached to Respondent's motion for sanctions, no requests for admissions were attached to that motion.

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the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1987); *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland*, 970 F. 2d 847, 23 USPQ2d at 1472.

Upon careful consideration of Respondent's arguments and exhibits, the Board finds Respondent has not met its burden of demonstrating that there is no genuine dispute of material fact in this case. Respondent's attempt to convert a discovery dispute into a motion for summary judgment is not sufficient as it merely relies on inferences that might be drawn from any lack of evidence. As discovery had not yet

closed in this proceeding when Respondent filed its initial motion for sanctions, no motion to compel was filed, trial had not yet opened and the Board has denied the motion for sanctions, there is no inference to be drawn from the putative lack of evidence.

In view thereof, the motion for summary judgment is **denied**.

### **Motion to Suspend for Civil Action**

In support of its motion to suspend, Petitioner argues that the civil action may have a bearing on issues before the Board, as that proceeding involves the same parties, the same or similar, as well as additional, issues, and that suspension of this Board proceeding would not prejudice Respondent. The filing includes a copy of the pleading filed in the civil action.

Where the parties to a Board proceeding are involved in a district court action concerning the same mark or registration, the Board will scrutinize the pleadings in the civil action to determine if the issues may have a bearing on the Board's decision in the Board proceeding. *Forest Labs. Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1061 (TTAB 1999) (requiring parties to submit copy of complaint in civil action so Board "may determine whether suspension of proceedings herein is warranted."). A decision by the District Court may be binding on the Board whereas a determination by the Board as to a defendant's right to obtain or retain a registration may have some preclusive effect as to some issues pending before the court. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2053 (2015) (finding when district court, as part of its judgment, decides issue overlapping Board's

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analysis, Board gives preclusive effect to court's judgment). Nonetheless, a civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond the right to registration, so judicial economy is usually served by suspension. *See id.* at 2056. Thus, the 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 La. Saints LLC v. Who Dat?, Inc.* 99 USPQ2d 1550, 1552 (TTAB 2011); Trademark Rule 2.117(a).

A review of the complaint in the civil action shows that it involves the same parties, involves a claim of trademark infringement of Petitioner's common law mark, and seeks an order cancelling Respondent's registration and a permanent injunction prohibiting Respondent from using its registered mark. The parties and the mark at issue in the civil action also appear in this Board proceeding, and it appears that resolution of the issues raised in the civil action may have a bearing on this case before the Board. The decision of whether to suspend this proceeding is within the Board's discretion, and the Board may do so at any stage of this proceeding. *See, e.g., Other Tel. Co. v. Conn. Nat'l Tel. Co.*, 181 USPQ 125, 126-27 (TTAB 1974) (suspending Board proceeding for disposition of civil action after opening of plaintiff's testimony period).

Accordingly, Respondent's motion to suspend for civil action is **granted**.

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Within **20 days after the final determination of the civil action**, the parties shall notify the Board so that this proceeding may be called up for appropriate action.<sup>5</sup> Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

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<sup>5</sup> A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).