

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

Baxley

Mailed: October 2, 2008

Cancellation No. 92049828

Linden Research, Inc.

v.

Richard P. Minsky

Andrew P. Baxley, Interlocutory Attorney:

On October 1, 2008, respondent filed an unconsented motion to suspend this case pending final determination of a civil action styled *Minsky v. Linden Research, Inc.*, Case No. 08-CV-819, filed in the United States District Court for the Northern District of New York. Upon becoming aware of such filing, the Board attorney assigned to this case contacted petitioner's attorney, who indicated that petitioner opposes the motion to suspend.

Full briefing of respondent's motion may not be complete until after the deadline for the parties' discovery conference as set in the Board notice instituting this proceeding. Accordingly, the Board, in exercising its inherent authority to control the scheduling of cases on its docket, determined that the motion to suspend should be decided by telephone conference. On October 2, 2008, such conference was held between petitioner's attorney Bobby A.

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Ghajar, applicant's attorney Tamiko R. Franklin, and Board interlocutory attorney Andrew P. Baxley.

When the Board is made aware that a party or parties to a pending case are engaged in a civil action which may have a bearing on the case, the Board case may be suspended until termination of the civil action. See Trademark Rule 2.117(a). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

Respondent's attorney indicated during the telephone conference that respondent opposes suspension of this case because the civil action involves infringement and dilution claims, whereas this proceeding involves a fraud claim. However, after reviewing the pleadings in the civil action and in this proceeding, the Board finds that suspension is appropriate in this case. To prevail in the district court, respondent, as plaintiff in the civil action, must establish that he has protectable trademark rights in the involved SLART mark. The district court's findings with regard to whether respondent has such rights may have a bearing on the fraud claim in this proceeding, to the extent that such

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claim is based on alleged misrepresentations that respondent made concerning the nature of that mark in response to an Office Action during *ex parte* prosecution of the underlying application for involved Registration No. 3399258. Further, those findings would be binding upon the Board. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986); *Other Telephone Co. v. National Telephone Co.*, 181 USPQ 79 (Comm'r Pats. 1974); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971). Therefore, notwithstanding the differences in the claims in the civil action and in this proceeding that petitioner noted during the telephone conference, the Board finds that suspension of this proceeding is appropriate.

In view thereof, respondent's motion to suspend this proceeding pending final determination of the civil action is granted. Proceedings herein are **suspended** indefinitely, pending final determination, i.e., following the termination of any and all appeals and/or remands, of Case No. 08-CV-819.

Annual inquiry may be made as to the status of the civil action. Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period, the

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Board should be notified of any address changes for the parties or their attorneys.