

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

EUROSURGICAL S.A.)
Opposer,)
v.) Opposition No. 91,157,847
PATRIC BERTRANOU.) Application Serial No. 78157535
Applicant.) Mark: SCS-CLARIS

04 JAN 27 11 38 35

MOTION TO SUSPEND

PENDING OUTCOME OF ANOTHER PROCEEDING

Applicant, Patrick Bertranou., by and through Counsel, hereby requests the board suspend this Opposition, No. 91,157,847, pending the outcome of another proceeding involving the same parties. An Answer has previously been filed by Applicant on October 28, 2003.

A Notice of Opposition in these proceedings was filed by Opposer on September 11, 2003. The Notice of Opposition in these proceedings was filed by Eurosurgical, S.A. (hereinafter "Eurosurgical" or "Opposer").

Applicant, Patrick Bertranou, is the president and CEO of the company Orthotec, Inc. Applicant, Patrick Bertranou, is also the president and CEO of the company Orthotec, LLC. Orthotec, Inc. and Orthotec, LLC have the same physical address, namely 9595 Wilshire Boulevard, Los Angeles, CA 90212.

On July 2, 2002, a Complaint was filed by OrthoTec, LLC against Eurosurgical S.A. and Does 1 through 50, in Superior Court of the State of California for the County of Los Angeles. A copy of the First Amended Complaint, filed January 23, 2003, is attached as Exhibit A.

The First Amended Complaint in the Superior Court of the State of California includes causes of action for State Trademark Infringement, Dilution of Distinctive Quality of Trademarks and Trade Names, and Infringement of Trademarks and Trade Names to Enhance Value of Products. See Attached Exhibit A. The issues to be decided in the Superior Court of the State of California have bearing upon this proceeding, namely the First Cause of Action – Breach of Written Contract regarding the September 1998 written Assignment Agreement between Applicant and Opposer. See Attached Exhibit A, paragraph 5.

Applicant's answer and defenses in this Opposition rely in part upon the September 1998 Assignment Agreement. See Answer to Notice of Opposition, paragraphs 5, 13, and 14.

In addition, Opposer, EuroSurgical, S.A., recently filed a Complaint against Applicant, Patrick Bertranou, for trademark infringement in the United States District Court for the Central District of California. See attached Exhibit B. This action for trademark infringement clearly involves many of the same issues before the Board in this Opposition and the mark which is the subject of this Opposition, namely, SCS-CLARIS.

“Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on issues before the Board.” TMBP §510.2(a). Here, the issues regarding the September 1998 Assignment Agreement between the parties are integral to the determination of both this proceeding and the case pending the Superior Court of the State of California. In addition, the issues in the action recently filed in the U.S. District Court for the Central District of California are overlapping with the issues presented in this Opposition, namely the use of the mark SCS-CLARIS by Applicant. The interests of justice will be better served if the proceeding before the Board is suspended until a determination

is made in both the proceeding in the Superior Court of the State of California and the proceeding the U.S. District Court for the Central District of California.

Opposer has filed several other Oppositions against Applicant and its companies, as well as an action in Federal District Court in Delaware and in the U.S. District Court for the Central District of California in an effort to overwhelm and confuse Applicant with excessive and oppressive litigation. Any reasonable attempts to settle or mediate this Opposition are not likely to take place until following a decision or other conclusion in the Superior Court of the State of California and/or the U.S. District Court for the Central District of California.

Opposer will not be prejudiced by a suspension of these proceedings.

Conclusion

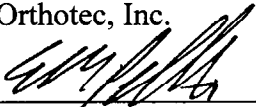
The issues in two other proceedings between Opposer and Applicant and Applicant's companies have a bearing upon the outcome of this Opposition. As a result, the interests of justice and of the Board will be best served by a suspension of the current Opposition pending the outcome of the case in the Superior Court of the State of California and/or the U.S. District Court for the Central District of California.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board grant the Motion to Suspend the Opposition Pending Outcome of Another Proceeding, pursuant to TBMP §510.02.

A duplicate copy of this Motion to Suspend has been sent via First Class Mail to counsel for Opposer on January 27, 2004.

Respectfully Submitted,

APPLICANT, PATRICK BERTRANOU
CEO of Orthotec, LLC
CEO of Orthotec, Inc.

By: 
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Attachments:

Exhibit A: First Amended Complaint, OrthoTec, LLC v. EuroSurgical, S.A., filed January 23, 2003

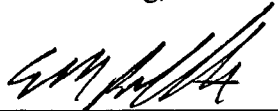
Exhibit B: Complaint and Demand For Jury Trial, EuroSurgical, S.A. v. Patrick Bertranou, Civil Action No. 03-8308PA, filed November 14, 2003, in United States District Court Central District of California.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Motion to Suspend was deposited as First Class mail with the United States Postal Service on JANUARY 27, 2004 to the following:

James R. Hastings
Collen IP
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, New York 10562

By:



Erik M. Pelton, Esq.

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