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

Proceeding	91171049
Party	Plaintiff JohnSpiegelberg JohnSpiegelberg 2416 Broadway Street Lubbock, TX 79401 UNITED STATES
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Submission	Motion to Suspend for Civil Action
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Date	09/19/2006
Attachments	Reply to Response to Motion to Suspend.pdf (4 pages)(18846 bytes) Appendix.pdf (1 page)(11375 bytes) Exhibit 1.pdf (2 pages)(22831 bytes) Exhibit 2.pdf (13 pages)(466727 bytes) Exhibit 3.pdf (7 pages)(50584 bytes) Exhibit 4.pdf (2 pages)(181744 bytes)

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

JOHN SPIEGELBERG, d/b/a CHROME Opposer,	§ § §	
v.	§	OPPOSITION No. 91171049
CHROME CLOTHING COMPANY, Applicant	§ § § § §	Serial No. 78/687,171 Design Mark: CHROME CLOTHING COMPANY Pub. For Opp. Date: 5/2/06

OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO SUSPEND PROCEEDINGS

Opposer John Spiegelberg, d/b/a Chrome, files this Reply to counter Applicant's unsupported arguments that allege forum-shopping. Filing an opposition to arrest improper registration is properly done with the Trademark Trial and Appeal Board. A trademark infringement action is properly brought in a federal court and not before the Trademark Trial and Appeal Board. This is exactly what Opposer has done, and, therefore, is not based on forum shopping as Applicant incorrectly and without support claims in its Response. To avoid the possibility of inconsistent judicial outcomes and to preserve taxing the judicial resources of both the TTAB and a federal court, Opposer has properly filed a motion to suspend proceedings.

Notably, in its Response, Applicant concedes the TTAB has discretion to suspend, but Applicant neither provides any legal authority nor controverts Opposer's legal authority provided in the Motion as to why the TTAB should not suspend the instant proceedings. In fact, the Motion's legal authority clearly shows that the TTAB should exercise its discretion in suspending the instant proceedings because the proceedings in the co-pending, federal action will conclusively determine the Chrome's and CCC's respective rights in the mark under application,

and, therefore, will be dispositive of all issues raised in this proceeding. *See* Tokaido v. Honda Assoc., Inc., 179 U.S.P.Q. at 862 ("[W]hile a decision of the District Court would be binding upon the Patent Office, a decision by the Trademark Trial and Appeal Board would only be advisory in respect to the disposition of the case pending in the District court."); *See also* Sam S. Goldstein Indus., Inc. v. Botany Indus., Inc., 301 F. Supp. 728, 731, 163 U.S.P.Q. 442, 443 (S.D.N.Y. 1969) (noting that PTO "findings would not be *res judicata* in this [civil action]" and denying motion to stay district court proceedings). *See* Opposer's Brief in Support of its Motion to Suspend, pp. 2, 3.

Finally, as to outstanding discovery, Applicant calls upon equity to forestall suspension. First, discovery continues until July 16, 2007 in the co-pending, federal action, and, thus, there is plenty of time for discovery. *See* Exhibit 1. Second, the equitable bromide of he who seeks equity must do equity is applicable here. That is, Applicant cannot rely on equity because it has unclean hands. Opposer filed and served the co-pending, federal action on June 7, 2006. *See* Exhibit 2. Opposer rightly requested Applicant in the federal action to execute and return a request for waiver of service of summons on or before July 7, 2006 in order to avoid the expense of personal service. Fed. R. Civ. P. 4. If executed by July 7, 2006, then the response was not due until August 7, 2006. Instead, Applicant in the federal action failed and refused to ever execute the request for waiver of service of summons. *See* Exhibit 3. As a result, Opposer had to have a summons issued and served on Applicant in the federal action on August 28, 2006. *See* Exhibit 4. On September 15, 2006, Applicant finally made a filing in the federal action – *3 months after the answer was due* – and Opposer now must file a motion to recoup unnecessary expenses for service because Applicant has neither offered to pay for this unnecessary service nor provided any reason for its refusal to timely file anything except that its *four attorneys* were

seeking other counsel in Tulsa, which has at least 16 firms that practice intellectual property law according to Martindale-Hubbell listings. *See* http://www.martindale.com/Intellectual-Property/Oklahoma/Tulsa/1426-LL2/firms.html (visited September 19, 2006). In sum, Applicant's reliance on equity to forestall suspension is unavailable because its conduct has been far from equitable and vitiates its reliance on equity to have the TTAB exercise its discretion in its favor and counter to well-established law on suspension.

Opposer again respectfully requests the Board to grant its Motion to Suspend.

Respectfully submitted,

Dated: September 19, 2006

By: /Erik J. Osterrieder/

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CERTIFICATE OF TRANSMISSION

This is to certify that a true and correct copy of OPPOSER'S MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.117(a) is being transmitted, via ESTTA, to the Trademark Trial and Appeal Board, on the date of signing below.

Dated: September 19, 2006

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CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO SUSPEND PROCEEDINGS was provided via courtesy email and served on the date of signing below, on Applicant Chrome Clothing Company, through their attorneys of record, *via First Class Mail*, with sufficient postage, in an envelope addressed to:

Head, Johnson & Kachigian
Mark Kachigian, Jason Jenkins, and Shawn Dellegar
228 West 17th Place
Tulsa, Oklahoma 74119

Dated: September 19, 2006

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