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

Proceeding.	91183644
Applicant	Defendant Disney Enterprises, Inc.
Other Party	Plaintiff Stephen Slesigner, Inc.

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Disney Enterprises, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Disney Enterprises, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Disney Enterprises, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
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05/19/2008

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

STEPHEN SLESINGER, INC.		
Opposer,	Opposition No.	91183644
	Application Nos.:	77/130,188
v.		77/106,448
		77/106,287
DISNEY ENTERPRISES, INC.,		77/106,429
		77/106,420
Applicant.		

MOTION TO SUSPEND PROCEEDINGS PURSUANT TO 37 C.F.R. §2.117

Applicant, Disney Enterprises, Inc. ("Disney"), by and through its attorneys, O'Melveny & Myers LLP, respectfully submits this motion for suspension of proceedings, pursuant to 37 C.F.R. §2.117 (a), pending the completion of the civil action between Disney and Stephen Slesinger, Inc. ("SSI") before the Honorable Florence-Marie Cooper, in the United States District Court for the Central District of California (Case no. CV-02-08508 FMC), commenced on November 5, 2002. Pursuant to 37 C.F.R. §2.117 (a), "proceedings before the Board may be suspended until termination of the civil action" whenever "it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case." See TMBP §510.02(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933 (TTAB 1992); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 U.S.P.Q. 125 (TTAB 1974); *Tokaido v. Honda Associates Inc.*, 179 U.S.P.Q. 861 (TTAB1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (TTAB 1971).

As SSI's own opposition papers indicate, this is the fourth proceeding that it has initiated before this Board in an effort to bypass the parties' pending action in the Central District of California. (Opposition ¶¶ 5-6). In 2006, SSI filed a Cancellation proceeding against 25 of Disney's trademark registrations that consisted of or contained names or characters associated with Winnie the Pooh (hereinafter the "Pooh Marks"), citing the same grounds as SSI alleges in the instant Opposition. (Exhibit A). In response, Disney filed a motion to suspend, explaining that the parties were engaged in civil litigation that had a bearing on the requested Cancellation proceeding. (Exhibit B (without accompanying Exhibits) and Exhibit C). Specifically, Disney advised the Board that SSI's claimed ownership of the Pooh Marks was at issue in the federal civil action and that SSI itself had sought an order requiring that Disney's existing registrations for the Pooh Marks be "corrected" to reflect SSI's ownership. On February 27, 2007, the Board granted Disney's motion and suspended SSI's cancellation proceeding. (Exhibit D).

SSI next filed opposition No. 91179064 to three pending Disney trademark applications for the mark "MY FRIENDS TIGGER & POOH," raising issues identical to those raised in the first proceeding. (Exhibit E and A). Disney filed a motion to suspend the second proceeding and on March 5, 2008, the Board granted that motion. (Exhibit F). SSI also filed opposition No. 91182358 to yet another two of Disney's pending applications for the mark "MY FRIENDS TIGGER & POOH." (Exhibit G). As with the prior proceedings, Disney moved to suspend this third proceeding. (Exhibit H). SSI did not oppose Disney's motion to suspend, presumably in recognition that suspension of TTAB proceedings involving the Pooh Marks pending outcome of the civil action is appropriate. (See Exhibit I). As a result, on March 28, 2008, the Board granted Disney's unopposed motion to suspend. (Exhibit J)

Now before the Board is yet a fourth proceeding involving Pooh Marks. As with the previous proceedings, Disney respectfully submits that the Board should suspend the instant proceeding pending the outcome of the Central District of California litigation because it raises the same issues as that action. As the Board already has recognized, SSI's October 6, 2006 Fourth Amended Answer and Counterclaims ("FAAC") alleges that SSI is the "owner of rights in and to the Pooh trademarks" (Exhibit B ¶ 126), that any use of the Pooh Marks by Disney "has been pursuant to a license" (id. ¶ 130), and that the Pooh Marks previously registered by Disney rightfully belong to SSI and should be ordered corrected to reflect SSI's ownership (id. ¶137). Similarly, this fourth proceeding again alleges that SSI "secured rights in the Winnie the Pooh characters," including trademark rights (Opposition ¶ 2), that Disney is only a licensee of SSI's (id.), and that Disney has not received SSI's authorization to register any of the Pooh Marks nor is Disney entitled to do so (id. ¶¶ 4, 15). As the Board previously held, because the federal civil court already has been asked to determine the respective rights of SSI and Disney to own, use and register the Pooh Marks, those claims "have a bearing" on the instant opposition proceeding, 37 C.F.R. § 2.117(a).

When there is such an overlap, "it is deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded." *Tokaido*, 179 U.S.P.Q. at 861. This is because any decision by the federal civil court "would be binding upon the Patent and Trademark Office" while "a decision by the Board would not be binding or res judicata as to the issues before the court." *Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. 689,692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 U.S.P.Q. 149 (CCPA 1977). To prevent inconsistent or academic rulings (which most certainly would be the case here), suspension is appropriate even if "the trial in the federal court will take longer." *Whopper-Burger*, 171 U.S.P.Q. at 807.

As SSI seeks to have the Board determine issues squarely before the federal civil court, suspension is, yet again, proper.

As Disney previously advised the Board, the federal civil litigation remains pending. At a March 3, 2008 status conference in that matter, SSI's counsel specifically reconfirmed that SSI intends to pursue its trademark claims in the federal civil action. (Exhibit K, Reporter's Transcript at 7:1-4). The district court is set to hear a summary judgment motion by Disney addressing each of SSI's claims, including the trademark claims, in June 2008.

For these reasons, Disney respectfully requests that the Board yet again grant Disney's motion and suspend pending disposition of the federal civil action.

Dated: May 16, 2008

Respectfully submitted,

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