

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


L.S.V. WORLDWIDE, LTD.,)
)
) Petitioner,)
)
) v.)
)
) T-SHIRT INTERNATIONAL, INC.)
)
) Registrant.)

Cancellation No. 92042255

Reg. No. 2,696,715

Mark: **O.V.B.**

Assistant Commissioner for Trademarks
2900 Crystal Drive,
Arlington, VA 22202-3513


10-24-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

MOTION TO SUSPEND

Pursuant to 37 CFR §2.117 and TBMP §510.02, Registrant, T-Shirt International, Inc. ("TSI"), through its undersigned counsel, respectfully moves to suspend the above-captioned cancellation proceeding pending the outcome of an existing civil action between the parties in Federal district court.

TSI filed a Complaint for Declaratory Judgment (copy attached as Exhibit A), in the United States District Court for the Southern District of West Virginia on or about September 10, 2002, Civil Action No. 3:02-1130. On or about December 19, 2002, TSI filed an Amended Complaint for Declaratory Judgment (copy attached as Exhibit B) in the above-mentioned civil

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action. On or about January 15, 2003, Petitioner, L.S.V. Worldwide, LTD. (“LSV”) filed its Answer, Counterclaims and Third-Party Complaint (copy attached as Exhibit C). On or about February 6, 2003, TSI filed its Answer of T-Shirt International, Inc. To Counterclaims (copy attached as Exhibit D), and Sam’s Club filed its Answer Of Sam’s Club To Third-Party Claims (copy attached as Exhibit E).

In its Amended Complaint for Declaratory Judgment, TSI alleges that TSI’s Marks do not infringe LSV’s Marks (Am. Compl. ¶ 14), and seeks a judgment declaring that TSI has not infringed LSV’s Marks (Am. Compl. ¶ 15, and at 5 ¶ 1). TSI’s Marks include:

1. OLD VARSITY BRAND (word mark), serial no. 78/069,711;
2. O.V.B. (word mark), serial no. 78/069,732, now registration no. 2,696,715;

and

3. OLD VARSITY BRAND O.V.B. (stylized mark), serial no. 78/196,233.

(Am. Compl. ¶ 7). LSV’s Marks include ONE TOUGH BRAND OTB (stylized mark), registration no. 2,452,866, and OTB (word mark), registration no. 2,490,664. (Am. Compl. ¶ 6).

TSI also alleges that TSI’s Marks do not cause confusion, or cause mistake, or deceive, nor is it likely to cause confusion, or cause mistake, or deceive, consumers when viewed in light of LSV’s Marks. (Am. Compl. ¶ 17). Accordingly, TSI is seeking a judgment declaring that TSI has not engaged, nor is it continuing to engage, in federal unfair competition by using its TSI Marks in connection with unisex casual clothing when the TSI Marks are viewed in light of LSV’s Marks. (Am. Compl. ¶ 18, and at 5 ¶ 2).

TSI further alleges that TSI's use of the TSI Marks does not dilute or cause dilution of LSV's Marks (Am. Compl. ¶ 21). Therefore, TSI is seeking a judgment declaring that TSI and its use of TSI Marks does not dilute or cause the dilution of LSV's Marks. (Am. Compl. ¶ 22, and at 5 ¶ 3).

LSV filed a Petition for Cancellation of TSI's registration number 2,696,715, for the mark O.V.B., on or about July 9, 2003, thus instituting the above-captioned proceeding with the Trademark Trial and Appeal Board ("TTAB"). LSV alleges that TSI's O.V.B. mark so resembles LSV's OTB Marks as to be likely to cause confusion, to cause mistake, or to deceive. (Pet. For Cancellation ¶ 27). LSV also alleges that TSI's O.V.B. mark consists of and comprises matter that may disparage and falsely suggest a connection with LSV or one of its licensees. (Pet. For Cancellation ¶ 30). Furthermore, LSV alleges that TSI's use of its O.V.B. mark dilutes the distinctive quality of LSV's OTB Marks. (Pet. For Cancellation ¶ 34). As a result of these allegations, LSV is seeking cancellation of TSI's registration no. 2,696,715 for the O.V.B. mark. (Pet. For Cancellation at 12).

The civil action instituted by TSI over one year ago will therefore have a bearing on the cancellation proceeding instituted by LSV.¹ Specifically, both proceedings involve determinations on whether TSI's use of its O.V.B. mark infringes, constitutes unfair competition with, or dilutes LSV's O.T.B. Marks. A regulation promulgated by the Patent and Trademark Office provides that

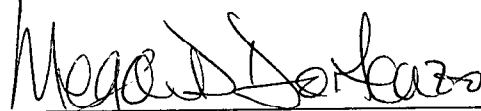
¹The status of the civil action in West Virginia is much farther along than that of the instant cancellation proceeding. That is, discovery is scheduled to be completed on October 31, 2003, with trial set for January 2004.

[w]henever 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 or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 CFR §2.117(a). The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") provides that "[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board." TBMP §510.02(a) (2d ed. June 2003). Since the final determination of the civil action will have a bearing on the issues before the TTAB in the above-captioned proceeding, TSI respectfully requests that the TTAB suspend proceedings involving Cancellation No. 92042255 pending the outcome of Civil Action No. 3:02-1130.

Dated this 24th day of October, 2003.

Respectfully submitted,



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Counsel for T-Shirt International, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this the 24th day of October, 2003, I served the foregoing
“Motion to Suspend,” upon the counsel for Petitioner by depositing true copies thereof in the United
States mail, postage prepaid, in an envelope addressed as follows:

Susan B. Larrabee, Esq.
KOO, LARRABEE, LAU-KEE & LANE LLP
106 Corporate Park Drive
White Plains, NY 10604



A handwritten signature in black ink, appearing to read "Megan Larrabee", is written over a horizontal line.

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