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

Proceeding	92065799
Party	Defendant Hillside Plastics, Inc.
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Attachments	FINAL Hillside Motion to Suspend.pdf(39018 bytes) FINAL Exhibit A Hillside Motion to Suspend.pdf(1421022 bytes)

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

SALBRO BOTTLE INC.

Petitioner

vs-

HILLSIDE PLASTICS, INC.

Registrant.

Cancellation No 92065799

Registration No. 1605584



Mark:

REGISTRANT'S MOTION TO SUSPEND

Registrant, Hillside Plastics, Inc. (“Hillside”), through its counsel, hereby moves pursuant to Trademark Rule 2.117(a) (37 C.F.R. § 2.117(a)) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 510.02(a) that the Board suspend proceedings in the above-captioned cancellation, pending the disposition of an action pending in the United States District Court for the District of Massachusetts concerning the same mark and that involves related issues of law and fact. As grounds for this Motion, Hillside states as follows:

FACTS & HISTORY

As early as November of 2016 Registrant placed Petitioner, Salbro Bottle Inc. (“Salbro”) on notice of Registrant’s rights in the subject registration. This notice was based, in part, on an infringing product that was being offered for sale by a company by the name of Dominion & Grimm, a customer of Salbro. Salbro and Dominion & Grimm responded through a single counsel. On March 31, 2017, Hillside filed a Complaint and Demand for Jury Trial (“Complaint”) in the United States District Court for the District of Massachusetts against Dominion & Grimm USA, Inc. and Dominion & Grimm, Inc. (collectively, “D&G”). A copy of Hillside’s Complaint is attached hereto as Exhibit A. In its Complaint, Hillside asserts claims for

injunctive and other relief under the Federal Trademark Act, 15 U.S.C. § 1051, et seq. (“Lanham Act”), particularly 15 U.S.C. §§ 1114 and 1125, for infringement of a registered trademark, false designation of origin, false description or representation, trademark dilution and related unfair competition. Ex. A ¶¶ 27-44. Hillside also asserts claims under state law for infringement and unfair competition. *Id.* ¶¶ 45-53. Hillside’s claims arise out of D&G’s sale of blow-molded plastic jugs alleged to bear Hillside’s Mark. *See, e.g., id.* ¶ 18. In particular, in its Complaint, Hillside alleged that, “upon information and belief, Defendants [D&G] contracted with non-party Salbro Bottle, Inc. . . . to manufacture the [allegedly infringing] jugs according to specifications that Defendants provided to Salbro.” *Id.* Dominion & Grimm USA, Inc.’s response to the Complaint is due on June 20, and Hillside is presently executing service on Dominion & Grimm, Inc. in Canada.

On that same day, Salbro filed this action seeking to cancel Registration No. 1605584, which was granted to Hillside by the United States Patent and Trademark Office in 1990. Petition to Cancel (“Petition”) ¶ 5. Salbro, a manufacturer of bottles for food and beverages, asserts that Hillside’s Registered Mark, which covers blow-plastic jugs, is functional. *Id.* ¶¶ 1-2, 25-28.

ARGUMENT

It is standard procedure for the Board to suspend administrative proceedings such as this pending the outcome of a related civil action. *See* 6 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 32:47 (4th ed.) (citing *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 1971 WL 16554 (TTAB 1971); *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d 1550, 2011 WL 3381380 (TTAB 2011)). The TBMP states that: “Unless there are unusual circumstances, the Board will

suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” TBMP § 510.02(a).

Registrant respectfully submits that this cancellation proceeding should be suspended pending the outcome of related litigation pending in the United States District Court for the District of Massachusetts. Suspension of this proceeding is proper because the District Court’s decision regarding the trademark at issue clearly “may have a bearing on the issues before the Board.” *See* TBMP § 510.02(a). Both proceedings concern the same Registered Mark and, at bottom, the same allegedly infringing products. *Compare, e.g.,* Ex. A ¶¶ 14, 18 with Petition ¶¶ 4, 5. Indeed, Salbro and D&G apparently believe that their interests with regard to the Registered Mark are aligned as Salbro’s counsel in this action has also been representing D&G in negotiations with Hillside concerning the federal district court litigation. Moreover, while Salbro is not a party in the Massachusetts action, as noted above, the allegedly infringing products at issue in that case are believed to have been manufactured by Salbro. Ex. A ¶ 18. And Hillside would anticipate taking discovery from Salbro in the District Court action, as a third-party. As such, any decision by the federal district court concerning whether D&G has infringed upon a valid trademark by directing Salbro to manufacture the jugs at issue will necessarily bear on the issues raised by this cancellation proceeding. And while D&G has yet to file an answer in the Massachusetts action, it does not strain credulity to expect that D&G will defend the action, at least in part, on the issues raised by Salbro in this cancellation. As such, it is reasonable to anticipate that the District Court will be deciding, at least in part, the identical issue presented by this cancellation proceeding. Where the decision by the court may be dispositive of the issues before the Board, a “motion to suspend is well taken.” *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), *abrogation on*

other grounds recognized by Gaylord Enter. Co. v. Calvin Gilmore Prod., Inc., 59 USPQ2d 1369 (TTAB 2000); *see also New Orleans Louisiana Saints LLC*, 2011 WL 3381380, at *2 (“Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.”); *Kearns-Tribune, LLC v. Salt Lake Tribune Publ’g Co., LLC*, Opp. No. 151,843, 2003 WL 22134916, at *3 (TTAB Sept. 11, 2003) (citing *General Motors* and suspending proceeding where outcome of civil action “may have a bearing on the issues before the Board”).

WHEREFORE, for all the foregoing reasons, Registrant Hillside respectfully prays that this Board suspend all proceedings herein pending the disposition of the litigation in the United States District Court for the District of Massachusetts.

Respectfully submitted,

Dated: June 7, 2017
New York, New York

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