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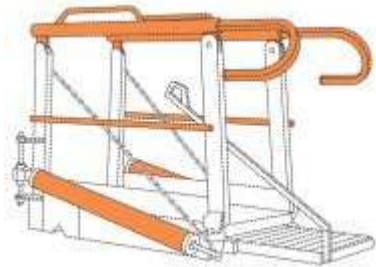
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92068857
Party	Defendant SafeRack, LLC
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Submission	Motion to Suspend for Civil Action
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Signature	/sara centioni kanos/
Date	08/10/2018
Attachments	Motion to Stay Cancellation.pdf(72528 bytes ) Exhibit A pleadings.pdf(732716 bytes ) Exhibit B order.pdf(299265 bytes )

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

In the matter of Trademark

Registration No. 5211514  
Registration Date: May 30, 2017



Mark:

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Bullard Company,

Petitioner,

v.

SafeRack, LLC,

Registrant.

Opposition No. 92068857

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**REGISTRANT’S MOTION TO SUSPEND CANCELLATION**

Pursuant to 37 C.F.R. §§ 2.117(a) and (c) and TBMP § 510.02, SafeRack, LLC (“Registrant”), by and through its undersigned counsel, hereby moves to suspend the instant proceedings until final determination of a civil action filed by Registrant in the U.S. District Court, District of South Carolina, Charleston Division.

**I. INTRODUCTION**

Registrant provides metal fall protection equipment and related components with the following mark (hereinafter “Orange Mark”):



Registrant filed a federal application for registration of Registrant's Orange Mark on June 11, 2014. The Office issued a registration on May 30, 2017 (the "Registration").

On June 20, 2017, Registrant filed a lawsuit against Petitioner in the District Court of South Carolina, Charleston Division (the "Litigation").<sup>1</sup> Registrant sued for infringement of its trademark rights in the Orange Mark. See Attached as **Exhibit A**, Registrant's Complaint and Petitioner's Answer.

Although Petitioner's Answer did not include a claim for cancellation of the Registration, Petitioner did assert affirmative defenses based on similar allegations to those in the instant Petition for Cancellation. These include: functionality (fifth affirmative defense); inherent distinctiveness (seventh affirmative defense); generic (eleventh affirmative defense); secondary meaning (twelfth affirmative defense); and abandonment (twenty-third affirmative defense). See **Exhibit A**, Answer at p. 7-10.

Despite having opportunity in the Litigation to explore these defenses, Petitioner waited over one year to assert the same allegations in the instant proceeding (the "Cancellation"). In conjunction with the filing of the Cancellation, Petitioner also moved unsuccessfully to stay the Litigation. See Order Denying Petitioner's Motion to Stay attached as **Exhibit B**.

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<sup>1</sup> Registrant's lawsuit, Civil Action No. 2:17-cv-1613-RMG, has been pending for over one year, and is set for trial on or after December 2018. By separate motion, Registrant also seeks a dismissal of the Cancellation based on Petitioner's failure to state a claim.

Maintaining this proceeding in parallel with the Litigation violates principles of judicial economy, creates unnecessary delay in the determination of Registrant's rights, and fosters duplication of effort. Bullard failed to demonstrate a pressing need to proceed with this Cancellation. See **Exhibit B**, at p. 5 ("Bullard's attempt to demonstrate such a pressing need is belied by the fact that it waited over one year to initiate the proceedings before the TTAB."). As explained by the District Court of South Carolina in the attached order denying Petitioner's Motion to Stay the Litigation:

Notably, this is not a case involving merely whether a trademark should be registered, an issue squarely in the purview of the TTAB. Instead, Plaintiffs here bring claims for infringement and unfair competition, seeking both damages and injunctive relief. These issues, therefore, would not be significantly simplified by waiting for the resolution of the TTAB proceedings.

(internal citations omitted).

Also significant, the Litigation is quickly approaching a final determination. Discovery closes in the Litigation on September 1, 2018, and trial is set for on or after December 1, 2018.

For these and following reasons, Registrant asserts that suspension of the Cancellation is warranted.

## II. ARGUMENT

The Board commonly suspends proceedings if a final determination of a U.S. District Court action will have a bearing on the issues that the Board is considering. See 37 C.F.R. §2.117(c), and TBMP §510.02(a). See also *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d 1550, 2011 WL 3381380 (T.T.A.B. 2011) (Opposition proceedings suspending because in pending civil

litigation applicant alleged infringement. The civil action need not be dispositive, it need only have a bearing on the issues before the Board). Further, the Board maintains broad discretion to suspend proceedings for good cause. See 37 C.F.R. §2.117(c).

When a civil action in a U.S. District Court involves common issues with those issues pending in a Board proceeding, the decision of the U.S. District Court will be binding upon the Board. See TBMP §510.02(a). See also *Tokaido v. Honda Associates, Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973) (“[I]t is clear that the outcome of the civil suit may well be dispositive of the issues raised by the pleadings of the parties in the cancellation proceeding before the Board.”); *Townley Clothes, Inc. v. Goldring, Inc.*, 100 U.S.P.Q. 57, 58 (Comr., 1953) (holding that “it is deemed to be the sounder practice to suspend the [Trademark] Office proceedings pending termination of the [civil] [c]ourt action”); *Squirrel Brand Company v. Barnard Nut Co. Inc.*, 101 U.S.P.Q. 340 (Comr., 1954) (Holding that proceedings were properly suspended where “the controlling issues presented for determination are necessarily the same as those of a civil action for infringement involving the same parties and trademarks”).

A review of the parties’ pleadings demonstrates that the Litigation and the Cancellation share common issues. Petitioner’s affirmative defenses are nearly identical to the allegations supporting the Cancellation. Any findings made by the U.S. District Court as to these affirmative defenses significantly impacts the Cancellation. What is more, Registrant seeks injunctive relief in the Litigation, which would also likely impact Petitioner’s claim.

In addition to serving judicial economy, the parties expect a final determination of the Litigation in fairly short order, namely months, not years. As explained, trial is set

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