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

Proceeding no.	92081581
Party	Defendant Bates Electric, Inc.
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Submission	Motion to Suspend for Civil Action
Filer's name	Mindi Richter
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Date	07/20/2023
Attachments	REGISTRANT MOTION to Suspend.pdf(1385511 bytes)

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

BATES ELECTRIC, INC.

Petitioner,

Cancellation No.: 92081581

vs.

Mark: BATES ELECTRIC

BATES ELECTRIC, INC.

Registrant.

_____ /

MOTION TO SUSPEND DUE TO CIVIL ACTION

Registrant, Bates Electric, Inc. moves to suspend this action due to a pending civil action. Specifically, the mark at issue in this proceeding is the subject of a suit pending in the United States District Court for the Middle District of Florida, *Bates Electric, Inc. v. Bates Electric, Inc., et al.*, Case No. 8:23-cv-00670-WFJ-SPF in which Registrant sued Petitioner for trademark infringement and related claims, and Petitioner counterclaimed attempting to cancel Registrant's BATES ELECTRIC® mark at issue in this current proceeding. The Complaint and Amended Counterclaim from the civil action are attached hereto as Exhibits A and B.

When a civil action "may have bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action." 37 C.F.R. § 2.117(a); *see Seven-Up Co. v. Bubble Up Corp.*, 312 F.2d 472, 476 (C.C.P.A. 1963) (stating it is the practice of the USPTO to suspend proceedings pending before it until the determination of the civil action); *Gen. Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933 (T.T.A.B. 1992) (granting petitioner's motion to suspend because "a decision by the district court will be dispositive of the issues before the Board"); *The Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. (BNA) ¶ 689 (T.T.A.B. Aug. 19, 1975) (granting the motion to suspend, despite objections by the applicant, because the final resolution of the civil action may be dispositive of the issues involved in the T.T.A.B proceeding);

The Other Tel. Co. v. Connecticut Nat'l Tel. Co., Inc., 181 U.S.P.Q. (BNA) ¶ 125 (T.T.A.B. Feb. 11, 1974) (stating “the final determination of the civil suit will directly affect the resolution . . . in the proceeding before the [T.T.A.B.]”); T.B.M.P. § 510.02(a) (“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.”). A review of Registrant’s Complaint and Petitioner’s Answer, Affirmative Defenses and First Amended Counterclaims in the civil action indicates a decision by the Middle District Court will be dispositive of the issues in this proceeding before the Board. Specifically, in the civil case, Registrant sued Petitioner for infringement of the BATES ELECTRIC® mark that Petitioner is attempting to cancel in this proceeding, and Petitioner counterclaimed asking the Court to cancel Registrant’s BATES ELECTRIC® registration at issue in this proceeding. Indeed Petitioner’s counterclaim in the civil case contains the identical claims at issue in this proceeding.

Additionally, a decision of a federal district court is binding upon the Patent and Trademark Office, while a decision by the Board is not binding or res judicata as to the issues before the district court. *The Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. (BNA) ¶ 689 (T.T.A.B. Aug. 19, 1975); see *Townley Clothes, Inc. v. Goldring, Inc.*, 100 U.S.P.Q. (BNA) ¶ 57 (Com'r Pat. & Trademarks Dec. 28, 1953) (finding it would be against the interest of “judicial economy” for the parties to proceed in two forums simultaneously when the findings of the court may be controlling over the Board). Moreover, “suspension would avoid the undesirable result of the parties litigating the same issue in two forums, with potentially inconsistent results and would minimize waste of both the parties’ and the Board’s resources.” *Michel Farah*, No. OPPOSITION 151,334, 2003 WL 22022077, at *5 (Aug. 21, 2003) (finding the common legal and factual issues warranted suspension pending the ultimate outcome of the civil action); see *Townley Clothes, Inc. v.*

Goldring, Inc., 100 U.S.P.Q. (BNA) ¶ 57 (Com'r Pat. & Trademarks Dec. 28, 1953); *Squirrel Brand Co. v. Barnard Nut Co. Inc.*, 101 U.S.P.Q. (BNA) ¶ 340 (Com'r Pat. & Trademarks May 21, 1954) (denying a petition to resume proceedings in favor of suspension). In this case, any decision from the Middle District Court would be binding upon the Board, whereas a decision by the Board would not be binding on the Middle District Court. Further, both the civil action and the pending action have the same legal and factual issues, more specifically the issue of cancellation, in which suspension would be in the interest of judicial economy, and it would avoid the potential for inconsistent results.

WHEREFORE, Registrant, respectfully requests the Board to suspend this proceeding until the civil action concludes.

Respectfully submitted,

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PROOF OF SERVICE

The undersigned hereby certifies that the foregoing Motion has been served upon Attorneys for Applicant, Bates Electric, Inc., Bryan K. Wheelock, Harness, Dickey & Pierce, PLC, 7700 Bonhomme, Suite 400, St. Louis, MO 63105, as follows:

- by delivering a copy of the paper to the person served;
- by leaving a copy at the usual place of business of the person served, with someone in the person's employment;
- by leaving a copy at the residence of the person served, with a member of the person's family over the age of fourteen years and of discretion, since the person is not believed to have a usual place of business;
- by transmitting a copy to the person served by the "Express Mail Post Office to Addressee" service of the United States Postal Service;
- by transmitting a copy to the person served by first class mail;
- by transmitting a copy by overnight courier;
- by transmitting a copy to the person served by electronic mail (i.e., E-Mail);

on July 20, 2023.

/Mindi M. Richter/
Mindi M. Richter, Esquire

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