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

Proceeding	92044438
Party	Defendant AARP AARP 601 E STREET, N.W. WASHINGTON, DC 20049
Correspondence Address	JOHN J. DABNEY MCDERMOTT WILL & EMERY LLP 600 THIRTEENTH STREET, NW WASHINGTON, DC 20005
Submission	Motion to Suspend for Civil Action
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Attachments	Motion to Suspend.pdf ( 16 pages )



alleging trademark infringement, false designation of origin, trademark dilution and unfair trade practices under federal and New York law.

AARP's complaint in the Federal Court Action seeks a permanent injunction, damages, and attorney's fees. AARP also seeks an order requiring Petitioner to withdraw this cancellation proceeding and its trademark application to register MODERN MATURITY for magazines, Ser. No. 78/448,077.

## II. ARGUMENT

Resolution of the Federal Court Action will necessarily resolve all of the issues before the Board in this proceeding, including the continuing validity of AARP's registration for MODERN MATURITY. *See* TBMP § 510.02(a). The federal court adjudicating the Federal Court Action would effectively have the "last word" regarding whether AARP's registration for MODERN MATURITY is still valid. Therefore, adjudication of the Federal Court Action would necessarily render this cancellation proceeding moot. In addition, if the court orders Petitioner to withdraw its cancellation petition in this matter, as AARP has requested, any further action in this proceeding would essentially be wasted effort for the Board and for the parties. *See Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. (BNA) 805 (TTAB 1971) (granting a motion to suspend when movant had filed an action in federal district court that would "have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues" and noting that "a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right ... would not be binding or res judicata in respect to the proceeding pending before the federal district court.").

Further, AARP's allegation that Petitioner has infringed AARP's MODERN MATURITY mark can only be decided by a federal court, and only the federal court can issue the injunction that is sought here and grant the monetary relief that is sought. AARP has also raised state law claims that are not within the jurisdiction of the TTAB. As a result, federal court is the only venue in which all issues between the parties can be resolved. It would be more efficient to allow the Federal Court Action to proceed to its conclusion before resuming this proceeding if necessary. *See Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848 (2d Cir. 1988) (holding that when court action concerns trademark infringement, the interest in prompt adjudication outweighs the value of having the views of the PTO); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563 (D. Minn. 1986) (TTAB should not be given primary jurisdiction when the district court action includes claims which cannot be raised before the Board). The TTAB routinely grants a motion to stay in favor of a federal court action. *See* TBMP § 510.02(a) ("Ordinarily, 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."); *see also General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ 2d 1933 (TTAB 1992) (granting petitioner's motion to stay the proceeding when petitioner had filed a case in federal district court that would be dispositive of the issues before the Board); *The Other Telephone Co. v. Connecticut Nat'l. Telephone Co.*, 181 USPQ 125 (TTAB 1974) (noting that once a civil action between the parties is filed in federal court, "[t]he only question for determination ... is whether the outcome of the civil action will have a bearing on the issues involved in the ... proceeding").

### III. CONCLUSION

For the foregoing reasons, AARP requests that its motion be granted.

Respectfully submitted,

AARP

Dated: January 6, 2006

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