

ESTTA Tracking number: **ESTTA565182**

Filing date: **10/15/2013**

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

Proceeding	91208793
Party	Plaintiff PEI Licensing, Inc.
Correspondence Address	ARIEL Y BUBLICK NORVELL IP LLC 1776 ASH STREET NORTHFIELD, IL 60093 UNITED STATES abublick@norvellip.com, jburgett@norvellip.com, checht@norvellip.com, officeactions@norvellip.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Jay M. Burgett
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Date	10/15/2013
Attachments	131015 Motion to Suspend FINAL.pdf(472658 bytes)

KRYOS GUARD

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Applicant.

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Opposition No. 91208793

The Civil Action alleges trademark infringement, dilution and unfair competition and related Illinois State law and common law claims against the same mark that is subject to the above-referenced opposition proceeding (“Opposed Mark”). The Civil Action involves common legal and factual issues as those presented in the opposition

proceeding, and the issues raised in the Civil Action will decide the opposition proceeding. Moreover, the final resolution of the Civil Action will be dispositive of all issues involved in the opposition proceeding.

Accordingly, in the interest of judicial economy and to prevent potential for inconsistent rulings on the same issues presented in both the Civil Action and the opposition proceeding, and because the decision of the District Court will be binding on the Board, PEI respectfully requests that the Board grant PEI's motion to suspend the opposition proceeding pending the disposition of the Civil Action. Applicant may argue that its dispositive motion should be decided first; however, this motion was filed in lieu of responding to discovery, and after pleas to PEI to refrain from taking further action. Accordingly suspension is appropriate in this case, either by suspending all further action, including any ruling on Applicant's motion for judgment or, in the alternative, first denying Applicant's motion for judgment with leave to reinstate post suspension.

Alternatively, if the Board believes Applicant's motion has merit and should be briefed, PEI requests that the Board grant PEI twenty (20) days subsequent to the Board's denial of PEI's motion within which PEI can respond substantively to Applicant's motion for judgment on the pleadings.

Respectfully submitted,

PEI LICENSING, INC.

Dated: October 15, 2013

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**MEMORANDUM IN SUPPORT OF MOTION TO SUSPEND OPPOSITION
PROCEEDING PENDING THE DISPOSITION OF A CIVIL ACTION**

MEMORANDUM

PEI, through its predecessors and/or related companies, adopted and first used a penguin design on or in connection with apparel and related goods since at least as early as 1956, and the PENGUIN word mark since at least as early as 1967. Since these dates, PEI, through its predecessors and/or related companies, has continuously used the penguin design and PENGUIN word mark, in addition to a number of

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