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

Proceeding	91235411
Party	Plaintiff Facility Pro, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	01/08/2018
Attachments	Motion to Suspend Proceedings.pdf(5108039 bytes)

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

In the matter of Trademark Application Serial No. 87/240404
Published in the Official Gazette on March 7, 2017
For the mark **FACILITIES PRO SWEEP**

FACILITY PRO, INC.,

Opposer,

Opposition No. 91235411

vs.

FACILITIES PRO-SWEEP, INC.

Applicant.

**OPPOSER'S MOTION TO SUSPEND PROCEEDINGS PENDING THE OUTCOME OF
FEDERAL COURT LITIGATION**

Opposer, Facility Pro, Inc. ("FPI"), through the undersigned counsel, hereby moves the Trademark Trial and Appeal Board ("Board") to suspend this cancellation proceeding pending the outcome of a civil action involving FPI and Petitioner, Facilities Pro-Sweep, Inc. pending in the U.S. District Court, Southern District of Florida, Case No. 17-60675-CIV-DIMITROULEAS, and states as follows:

Previously, Applicant moved to dismiss the notice of opposition, and after an Order on the motion, Applicant filed an amended notice. Rather than continuing to expend resources in this action when related litigation is ongoing, FPI files this motion to stay in an abundance of caution. The civil action (a copy of the Complaint is attached as Exhibit A) was filed in the U.S. District Court for the Southern District of Florida, and the claims bear on the issues presented to the Board. Applicant, the Plaintiff in the civil action, alleges claims of infringement of its marks by the use of the FPI marks in this cancellation action.

It is the policy of the Board to suspend cancellation proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board's proceedings. TBMP §510.02, citing 37 C.F.R. § 2.117(a); *see also New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have bearing on issues before the Board); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975); *Tokaido v. Honda Associates, Inc.*, 179 USPQ 861 (TTAB 1973). This policy makes perfect sense. When a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board. *See* TBMP § 510.02(a); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848 (2d Cir. 1988) (PTO registration would not affect the legal standard applied in infringement claim or the scope of the required fact-finding; the district court will still independently have to determine the validity of the mark). While the Supreme Court recently found that TTAB decisions can be binding on a federal court (*B&B Hardware Inc. v. Hargis Industries*, 135 S.Ct. 1293, 1310 (2015)), under no circumstances could this Board's decision resolve all issues in the pending federal litigation, which encompass the parties' claims in this proceeding. As such, there is no reason for the parties or the Board to spend time and resources on this dispute when the resolution at the Board will not resolve the federal litigation between the same parties.

Equitable considerations favor suspension of the proceeding because conducting two trials involving the same parties and the same issues will undoubtedly result in duplication of effort and expense. There is also the potential that simultaneous proceedings on these issues

could result in inconsistent results. Accordingly, FPI respectfully requests that the Board suspend these proceedings until final disposition of the civil action noted above.

Respectfully submitted January 8, 2018.

/s/Ryan T. Santurri

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Attorneys for Registrant, Facility Pro, Inc.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and complete copy of the foregoing has been served by email on January 8, 2018 to:

John F. Bradley, Esq.
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/s/ Ryan T. Santurri
Ryan T. Santurri

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