

ESTTA Tracking number: **ESTTA316814**

Filing date: **11/13/2009**

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

Proceeding	91192206
Party	Defendant EnviroGLAS, LLC
Correspondence Address	STEVE H. CLEMONS LEGGETT & CLEMONS, PLLC SUITE 310 2745 NORTH DALLAS PARKWAY PLANO, TX 75093 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Date	11/13/2009
Attachments	Motion to Suspend- Enviroslab.pdf (5 pages)(138681 bytes) Plaintiffs Amended Complaint.pdf (75 pages)(2092662 bytes)

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

American Terrazzo Company Ltd.,	§	Mark: ENVIROSLAB
Opposer,	§	Serial No.: 76/686,343
V.	§	Filed: January 31, 2008
EnviroGLAS, LLC,	§	Published: June 16, 2009
	§	
Applicant.	§	Opposition No. 91192206
	§	

APPLICANT'S MEMORANDUM IN SUPPORT OF
MOTION TO SUSPEND PENDING LITIGATION IN FEDERAL DISTRICT COURT

Applicant EnviroGLAS, LLC files this motion to suspend Opposer American Terrazzo Company Ltd.'s opposition pending the outcome of litigation in the United States District Court for the Northern District of Texas.

Introduction

1. Opposer is American Terrazzo Company Ltd.; Applicant is EnviroGLAS, LLC.
2. American Terrazzo Company Ltd. initiated an opposition against EnviroGLAS, LLC's Application Serial No. 76/686,343 for the mark ENVIROSLAB.
3. The subject application was filed on January 31, 2008 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intention to use the mark in commerce.
4. The subject application was published for opposition on June 9, 2009. After their request for an extension of time was granted, American Terrazzo Company filed their opposition on October 7, 2009.
5. Because litigation arising out of the same operative set of facts, the same

transactions, and the same occurrences is already pending in another forum, the Board should suspend this opposition.

Argument & Authority

6. American Terrazzo sued EnviroGLAS, LLC in the United States District Court for the Northern District of Texas, Dallas Division, on February 10, 2009, styled Civil Action No. 3:0-cv-00265-G, for nineteen different claims, including:
 - a. False or Fraudulent Representation to the USPTO;
 - b. Declaratory Judgment as to the ownership of the "EnviroGLAS" Trademark;
 - c. Violations of the Lanham Act; and
 - d. Various claims arising out of soured relations between EnviroGLAS, LLC's President, Tim Whaley, and American Terrazzo Company.
7. Attached as Exhibit A is a copy of American Terrazzo Company's petition in that suit. That lawsuit and the present Opposition proceeding involve the same parties and the same underlying issues, although the named trademark in that suit is not the same as in this Opposition.
8. Both this Opposition and that suit involve disputes about the circumstances under which Tim Whaley—EnviroGLAS, LLC's President—left American Terrazzo Company to form his own company. The suit in the Northern District of Texas will be examining whether Whaley and EnviroGLAS, LLC acted fraudulently toward American Terrazzo Company and toward the USPTO. That court will also determine whether EnviroGLAS, LLC is the proper owner of the "EnviroGLAS" Trademark.

9. In order to decide the issues in the case before it the Northern District of Texas will necessarily decide issues which are pertinent in this case, such as the truth behind the allegations that American Terrazzo Company made in its Notice of Opposition. That court will make findings of fact and law which would be directly applicable to these proceedings.
10. The veracity of Opposer's allegations are material to this Opposition proceeding. Two concurrent proceedings could lead to inconsistent factual and legal findings between this Board and the Court in the Northern District of Texas.
11. It is appropriate for this Board to stay or suspend this Opposition proceeding pending the outcome of the litigation in the District Court. In *Dwinell-Wright Co. v. National Fruit Product Co.* there was litigation over five trademarks. The litigation began in federal district court. 129 F.2d 848, 853 (1st Cir. 1942). The defendant in that litigation subsequently filed a cancellation proceeding. The plaintiff asked the examiner in charge for a stay pending the outcome of the federal district court litigation, and shortly thereafter asked the federal district court for injunction. Although the stay—which the examiner had originally granted—was vacated by the Assistant Commissioner of Patents, the injunction was granted, halting the action before the USPTO. *Id.*
12. In *Dwinell-Wright*, the First Circuit Court of Appeals noted that “it is just as harassing and vexatious, and there is just as much waste and duplication of effort involved in twice trying the same issue between the same parties whether the second trial is before an administrative tribunal or before a court...” *Id.*
13. While this action is different because the Trademark at issue before this Board is

not the same as the Trademark in the litigation in federal district court, the same nucleus of operative fact, the same transactions, and the same occurrences give rise to both proceedings. In order to prevent this Board, and the federal district court, from hearing duplicitous testimony, and analyzing nearly identical arguments, this Board should suspend the pending Opposition proceeding.

Conclusion

14. The underlying controversy in this Opposition is already pending in the United States District Court for the Northern District of Texas. This Board should suspend this Opposition.

Prayer

15. For these reasons, EnviroGLAS, LLC asks the Board to grant the Applicant's Motion to Suspend, or in the alternative, to toll the time for EnviroGLAS, LLC's Response to the American Terrazzo Company's Opposition during the Board's review and consideration of this Motion.

Date: 13 November 2009

Respectfully Submitted,

By: 

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