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

Proceeding	91203708
Party	Defendant Fiber Composites, LLC
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Date	02/29/2012
Attachments	Cambridge v Fiber - Applicant Mot to Susp Proceed Disp of Fed Lit - Opp No 91203708.pdf (20 pages)(463879 bytes)

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

In the matter of Trademark
Application Serial No. 85/142,604
Mark: ARMORGUARD
Filing Date: September 30, 2010
Publication date: January 10, 2012

CAMBRIDGE PAVERS, INC.,

Opposer,

v.

FIBER COMPOSITES, LLC,

Applicant.

Opposition No. 91203708

**APPLICANT'S MOTION TO SUSPEND PROCEEDING PENDING
DISPOSITION OF FEDERAL LITIGATION AND MEMORANDUM IN SUPPORT**

Applicant Fiber Composites, LLC (hereinafter "Applicant"), by and through the undersigned counsel, files this Motion to Suspend Proceeding Pending Disposition of Federal Litigation and Memorandum in Support, pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a). For the reasons set out below, Opposer Cambridge Pavers, Inc.'s (hereinafter "Opposer") Notice of Opposition, which was filed February 7, 2012, should be suspended pending the outcome of a prior pending federal district court action.¹

ARGUMENT

This Opposition Proceeding should be suspended pending the outcome of a federal district court action for trademark infringement, false designation of origin, dilution, and unfair

¹ While the Trademark Trial and Appeal Board ("Board") considers this Motion, Applicant respectfully requests that the Board suspend this Opposition Proceeding "with respect to all matters not germane to the motion" pursuant to 37 C.F.R. § 2.127(d).

competition between these same parties and involving the identical claim in the United States District Court for the District of New Jersey, Case No. 2:11-CV-05543 (WJM)(MF) (hereinafter “federal litigation” or “federal court action”) (*see* true and correct copy of Opposer’s Complaint, attached hereto as Exhibit A). Opposer, as Plaintiff, filed the federal court action on September 23, 2011 against Applicant, as Defendant, and Homer TLC, Inc. Opposer then filed the Notice of Opposition on February 7, 2012.

“To the extent that a civil action in a [f]ederal district court involves issues in common with those in a proceeding before the Board, the decision of the [f]ederal district court is often binding upon the Board.” TBMP § 510.02(a). “[W]hile a decision by the District Court would be binding upon the [United States Patent and Trademark Office (“USPTO”)], a decision by the [Board] would only be advisory in respect to the disposition of the case pending in the District Court.” *Tokaido v. Honda Assocs. Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973) (“[N]otwithstanding the fact that the [USPTO] proceeding was the first to be filed, it is deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded”) (citations omitted). *See also Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (1971) (“The duty of this Court, as of every other judicial tribunal, is to decide actual controversies by a judgment which can be carried into effect, and not to give opinions upon moot questions or abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it.”) (quotation omitted). “The only question for determination . . . is whether the outcome of the civil action will have a bearing on the issues involved in the opposition proceeding.” *Other Tel. Co. v. Conn. Nat’l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126 (T.T.A.B. 1974), *petition denied*, 181 U.S.P.Q. 779 (Comm’r 1974). Here, the federal court action has been ongoing for five months and the final determination of that

federal court action will have a bearing on the issues before the Board because both proceedings are between the same parties and involve the same claims.

Specifically, both the Notice of Opposition and the federal litigation involve Applicant's ARMORGUARD Mark, as depicted in Application Serial No. 85142604, and Opposer's ARMORTEC Mark, as depicted in stylized font & design in Registration Nos. 3094763 and 3105701. In the Notice of Opposition, Opposer asserts that Applicant's ARMORGUARD Mark should be refused registration because of an alleged likelihood of confusion with Opposer's ARMORTEC Mark. Likewise, in the federal action, the basis for Opposer's claims for relief is an alleged likelihood of confusion between Applicant's ARMORGUARD Mark and Opposer's ARMORTEC Mark. *See* Exhibit A, pp. 4-7. Indeed, Opposer specifically identifies Applicant's Application Serial No. 85142604 for the ARMORGUARD Mark, as well as Opposer's Registration Nos. 3094763 and 3105701 in the Complaint in the federal litigation. *See* Exhibit A, Paras. 8, 12, and 17.

There can be no doubt then that the final resolution of the federal litigation will be dispositive of the issues in this Opposition Proceeding. To proceed further with a claim in this forum would waste the resources of this agency, while the federal court is considering identical evidence and arguments on the exact same claim. For all these reasons, the Notice of Opposition should be suspended pending the outcome of the federal court action.

CONCLUSION

For the reasons set forth herein, Applicant respectfully submits that it has established good cause for the suspension of this Opposition Proceeding and requests the granting of its Motion to Suspend Proceeding Pending Disposition of Federal Litigation.

Dated: February 29, 2012

Respectfully submitted,

DLA PIPER LLP (US)

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