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

Proceeding	91246285
Party	Defendant Arlon Graphics, LLC
Correspondence Address	KEITH R DENNY SOLLERTIS PO BOX 5005, PMB #1076, 105 PASEO DELICIAS, SUITE 7 RANCHO SANTA FE, CA 92067 UNITED STATES kdenny@sollertis.com, dlizerbram@sollertis.com, gcorrea@sollertis.com 858-771-0081
Submission	Motion to Suspend for Civil Action
Filer's Name	Giovanni A. Correa
Filer's email	gcorrea@sollertis.com, kdenny@sollertis.com, dlizerbram@sollertis.com
Signature	/Giovanni A. Correa/
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Attachments	2019-03-22 Arlon Motion to Suspend.pdf(2030609 bytes )

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

A.P.A. SPA,  Opposer,  v.  ARLON GRAPHICS LLC,  Applicant.	Opposition No.: 91246285 Opposition Filed: February 6, 2019   Mark: <b>ARLON</b> Serial No.: 87390467
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**ARLON GRAPHICS LLC'S MOTION TO SUSPEND PROCEEDINGS PENDING  
DISPOSITION OF DISTRICT COURT ACTION**

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Applicant, Arlon Graphics LLC (“Applicant”), through its undersigned counsel, hereby moves the Board to suspend the above-referenced proceedings (the “TTAB Proceedings”) pending final disposition of federal district court case, *Arlon Graphics LLC v. A.P.A. S.p.A.*, Civil Action No. 8:19-cv-00524, filed March 15, 2019, in federal district court for the Central District of California (the “Civil Action”). Copies of the complaint and civil cover sheet are attached as Exhibit 1.

In the Civil Action Applicant seeks Declaratory Judgement that its use of its mark does not violate Section 32 or Section 43(a) of the Lanham Act, or constitute unfair competition or trademark infringement under the laws of the United States or under the common law of any state in the United States. Applicant alleged in the Civil Action that A.P.A. S.p.A. (“Opposer”) has claimed that Applicant’s use of its mark is likely to cause confusion, and has threatened and repeatedly implied the threat of legal action against Applicant. Applicant has also alleged that use of its mark is not likely to cause confusion, or to cause mistake, or to deceive as to the

affiliation, connection, or association of Applicant with Opposer or any other person, or as to the origin, sponsorship, or approval of Applicant's goods by Opposer or any other person.

When the parties are involved in court proceedings concerning the same marks and issues, the "standard procedure" of the Board is to suspend its administrative proceedings pending outcome of the civil litigation. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (quoting *6 McCarthy on Trademarks and Unfair Competition* §32:47 (5th ed. updated September 2017).) The Civil Action need not even be dispositive of the Board proceeding to warrant suspension. Rather, it is sufficient that the Civil Action have bearing on the issues before the Board to justify a suspension. *Id.*

Here, the Civil Action involves the same parties, the same marks, and the same services and activities as those at issue in the TTAB Proceedings. Accordingly, the parties and marks in the TTAB Proceedings and the Civil Action are the same or sufficiently related, such that the Civil Action will be dispositive of, or at least have a meaningful bearing upon, the issues before the Board.

Moreover, judicial economy is served by immediately suspending all activity in the TTAB Proceedings. See *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (1974). The parties will soon be engaged in discovery, including a discovery conference and initial disclosure in the TTAB Proceedings. The deadline for the Discovery Conference is April 17, 2019 and Initial Disclosure are due on May 17, 2019, The discovery period is scheduled to open on April 17, 2019. Because the Civil Action involves the issues currently before the Board, discovery in the Civil Action will involve documents, depositions, and other information that will also be gathered or produced in the TTAB Proceedings. Thus, suspending the TTAB Proceedings would avoid wasted time and expenses for both parties and

the Board. *See, e.g., Softbelly's Inc v. Ty, Inc.*, 2002 WL 1844210, \*3 (citing *Other Telephone*, 181 USPQ 126-27) ("It would be a waste of the Board's and the parties' time and resources to proceed to litigate this case at the Board when the same issues" are pending in court.) Given the foregoing, an immediate suspension of the proceedings, including discovery related deadlines, is appropriate.

For these reasons, Applicant respectfully requests that an order from the Board immediately issue suspending all activity related to the TTAB Proceedings, including all discovery deadlines.

Respectfully Submitted,

Dated: March 22, 2019

**SOLLERTIS**

By: /Keith R. Denny/

Keith R. Denny, Esq.

David Lizerbram, Esq.

Giovanni A. Correa, Esq.

**SOLLERTIS**

Mail to: PO Box 5005 PMB 107  
6105 Paseo Delicias Ste. 7  
Rancho Santa Fe, CA 92067

Emails: kdenny@sollertis.com  
dlizerbram@sollertis.com  
gcorrea@sollertis.com

Tel.: (858) 771-0081

Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the document(s) titled: **ARLON GRAPHICS LLC'S MOTION TO SUSPEND PROCEEDINGS PENDING DISPOSITION OF DISTRICT COURT ACTION**, has been served on Jess M. Collen, Esq. and Michael Nesheiwat, Esq., counsel for A.P.A. SPA, by forwarding said copy on March 22, 2019, via email to: [jcollen@collenip.com](mailto:jcollen@collenip.com); [mnesheiwat@collenip.com](mailto:mnesheiwat@collenip.com); [docket@collenip.com](mailto:docket@collenip.com); and [pmulhern@collenip.com](mailto:pmulhern@collenip.com)

Date: March 22, 2019

*/Giovanni A. Correa/*  
Attorney for Applicant

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