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

Proceeding no.	91274561
Party	Plaintiff Tile Tech, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	03/02/2022
Attachments	Motion for suspension in view of civil proceeding.pdf(22543 bytes) Exhibit A to Motion.pdf(3701151 bytes)

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

In the matter of Application No. 88778306:

Tile Tech, Inc.,

Opposer,

v.

Hanover Prest-Paving Company DBA
Hanover Architectural Products,

Applicant.

Opposition No. 91274561

Opposed Trademark: American flag design

MOTION FOR SUSPENSION IN VIEW OF CIVIL PROCEEDING

The parties are engaged in a civil action which will have a bearing on this proceeding. Applicant, Hanover Prest-Paving Company DBA Hanover Architectural Products, a Pennsylvania corporation (“**Applicant**”), filed the civil action against opposer, Tile Tech, Inc. (“**Opposer**”). The case is currently pending. Accordingly, Opposer hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117. In support of this Motion, Applicant submits herewith **Exhibit A**, which is a copy of the Amended Complaint filed by Applicant. The civil action is pending in United States District Court, Middle District of Pennsylvania (Case 1:21-cv-00806-CCC) for, among other things, infringement of the same trademark that is at issue in Applicant’s application opposed herein.

Whenever it comes to the attention of the Board that the parties to a case before it are involved in a civil action which may be dispositive of the Board case, the proceedings before the Board may be suspended upon final determination of the civil action. TBMP § 510.02(a). A civil action need not be dispositive on the issues, however, for the Board to suspend proceedings. Ordinarily, the Board will suspend proceedings in the case before it if the final

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determination of the other proceedings may have a bearing on the issues before the Board. TBMP § 510.02, citing 37 C.F.R. § 2.117(a); *see, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550,1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have bearing on issues before the Board).

In the Amended Complaint, Applicant alleges willful, deliberate infringement of its American flag “trademark” by Opposer – the same trademark at issue in the opposed Application. Additionally, in the Complaint, Applicant seeks a determination by the District Court of priority and likelihood of confusion, and Opposer intends to assert defenses to Applicant’s allegations on the same or similar grounds to the grounds for relief set forth in Opposer’s Notice of Opposition in this proceeding.

Suspension of Board proceedings is within the discretion of the TTAB, and will generally be granted when a final decision of the court will likely be controlling on the issues to be decided by the TTAB. *In Whopper Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB1971), the Board suspended proceedings, finding that “There can be no doubt ... that the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues.” There can be no doubt that issues involved in the civil action are involved here.

Conclusion

In view of the fact that the pending civil action involves the determination of priority, likelihood of confusion, validity, and enforceability of Applicant’s trademark opposed herein, and those issues will impact the pending trademark application and the opposition to the same, the determination of these issues in the civil action will likely be dispositive of, or will at least have bearing on, this proceeding. Opposer therefore respectfully requests suspension of these proceedings pending determination of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

Respectfully submitted,

FREEMAN, FREEMAN & SMILEY, LLP

By: /s/ Mark. B. Mizrahi

Mark B. Mizrahi

Attorneys/Agents for Opposer

Date: March 2, 2022

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CERTIFICATE OF SERVICE

I certify that I served:

MOTION FOR SUSPENSION IN VIEW OF CIVIL PROCEEDING

on March 2, 2022 by:

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Mark Mizrahi

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