

ESTTA Tracking number: **ESTTA316758**

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

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

Proceeding	92051590
Party	Defendant Knoll, Inc.
Correspondence Address	KNOLL, INC. 1235 Water Street East Greenville, PA 18041 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	Marc P. Misthal
Filer's e-mail	mmisthal@grr.com
Signature	/Marc P. Misthal/
Date	11/13/2009
Attachments	92051590.pdf (199 pages)(3004634 bytes)

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

-----X
ALPHAVILLE DESIGN, INC.,
Petitioner
v.
KNOLL, INC.,
Respondent.
-----X

Cancellation No. 92051590

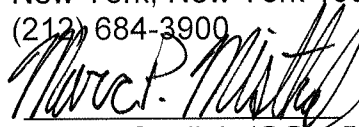
NOTICE OF MOTION TO SUSPEND

PLEASE TAKE NOTICE that, upon the accompanying Memorandum of Law dated November 12, 2009 and the Declaration of Marc P. Misthal dated November 12, 2009, Respondent Knoll, Inc. hereby moves the Trademark Trial and Appeal Board for an Order suspending the above-captioned Cancellation proceeding pursuant to 37 C.F.R. § 2.117 (a) in view of a civil action that “may have a bearing” on the present Cancellation proceeding.

Dated: November 12, 2009
New York, N.Y.

GOTTLIEB, RACKMAN & REISMAN, P.C.
Attorneys for Respondent
George Gottlieb
Barry A. Cooper
Marc P. Misthal
270 Madison Avenue, 8th Floor
New York, New York 10016
(212) 684-3900

By


George Gottlieb (GG – 5761)
Barry A. Cooper (BC – 9298)
Marc P. Misthal (MM – 6636)

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

-----X
ALPHAVILLE DESIGN, INC.,
Petitioner
v.
KNOLL, INC.,
Respondent.
-----X

Cancellation No. 92051590

RESPONDENT'S MOTION TO SUSPEND

Respondent Knoll, Inc. ("Knoll") respectfully requests that the Board issue an order, pursuant to 37 C.F.R. § 2.117 (a), suspending the above-identified Cancellation filed by Petitioner Alphaville Design, Inc. ("Alphaville") in view of a civil actions brought by Alphaville against Knoll that is pending in the federal district court for the Northern District of California and in which the registration that is the subject of this proceeding has been asserted and/or challenged. Because disposition of this civil action "may have a bearing" on the present Cancellation proceeding, the present Cancellation proceeding should be stayed. Pending a decision on the motion to suspend, Knoll also requests that its time to answer the Petition for Cancellation be extended until disposition of this motion. The declaration of Marc P. Misthal ("Misthal Dec.") is also submitted by Knoll in support of its motion to suspend.

Alphaville's Petition to Cancel

This is one of six Petitions to Cancel filed by Alphaville in the PTO.¹ The petitions to cancel, all filed the same day, seek to cancel registrations obtained by Knoll for Knoll's Barcelona Chair (Reg. No. 2,893,025), Barcelona Stool (Reg. No. 2,894,025), Barcelona Couch (Reg. No. 2,894,980), Barcelona Table (Reg. No. 2,894,979) and Flat Brno Chair (Reg. No. 2,894,980) and for the trademark BARCELONA (Reg. No. 772,313).

The Civil Action

Knoll has been involved in litigation against Alphaville in the Northern District of California, Alphaville Design, Inc. v. Knoll, Inc., Case No. 07 CV 05569 (MHP) (N.D.Cal. filed November 1, 2007) (hereinafter the "California Action") for two years. Copies of the relevant pleadings from the California Action are attached to the Misthal Declaration.

The California Action is a declaratory judgment action against Knoll. The declaratory judgment complaint includes a count alleging invalidity of Knoll's Barcelona Chair registration (Reg. No. 2,893,025), Barcelona Stool registration (Reg. No. 2,894,025), Barcelona Couch registration (Reg. No. 2,894,980), Barcelona Table registration (Reg. No. 2,894,979); Flat Brno Chair registration (Reg. No. 2,894,980) and BARCELONA mark registration (Reg. No. 772,313). Cancellation of each of these registrations is sought. See Misthal Dec., Ex. 1.

In connection with the California Action, the parties have taken discovery, including depositions, interrogatories and the exchange of documents.

¹ Knoll has filed substantially identical motions to suspend in each of the Cancellation proceedings.

Subpoenas have been served on third parties. Moreover, in November 2008 Alphaville made a motion for summary judgment on the question of the validity of Knoll's trademark registrations which raised issues virtually identical to the issues raised in the Petition for Cancellation. The court issued an order denying Alphaville's motion on June 5, 2009. A copy of the court's order is attached to the Misthal Declaration as Exhibit 7.

In the California Action Alphaville is represented by the firm of Coblentz, Patch, Duffy & Bass LLC.² This is the same firm that is representing Alphaville in each of the Cancellation proceedings now pending before the Board.

It is therefore apparent that the California Action encompasses the same issues (validity and cancellation) of the very same registrations which Alphaville seeks to cancel in this, and in the companion, cancellation proceedings. Accordingly, the Cancellation proceedings should be stayed.

ARGUMENT

I. THE CANCELLATION PROCEEDINGS SHOULD BE SUSPENDED

37 C.F.R. § 2.117 (a) provides, as follows:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

The most common situation involving a request for suspension pending the outcome of another proceeding arises where there is a civil action pending which may be dispositive of the issues before the Board. That is because "the

² The Coblentz firm was retained by Alphaville in July, 2009, and is working with co-counsel, Philip Green, Esq. of The Law Offices of Green & Green. Prior to July, 2009, Alphaville was represented by Mr. Green and the law firm of Sheppard Mullin.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.