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

Proceeding	92066746
Party	Defendant Facility Pro, Inc.
Correspondence Address	FACILITY PRO INC 6451 NORTH FEDERAL HIGHWAY, SUITE 408 FT LAUDERDALE, FL 33308 UNITED STATES
Submission	Other Motions/Papers
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Signature	/Ryan T. Santurri/
Date	10/31/2017
Attachments	Memo Op MDefault Judgment and Request for Stay.pdf(5671685 bytes)

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

In the Matter of Service Mark Registrations:

Reg. No.: 4,903,047
Registrant: Facility Pro, Inc.
Filed: February 27, 2015
Issued: February 16, 2016
Mark: **FACILITY PRO**

Reg. No.: 4,949,195
Registrant: Facility Pro, Inc.
Filed: February 27, 2015
Issued: May 3, 2016
Mark: **FACILITY PRO THE MAINTENANCE
PROFESSIONALS (and design)**

FACILITIES PRO-SWEEP, INC.,

Petitioner,

Cancellation No. 92066746

v.

Registration Nos. 4,903,047 and
4,949,195

FACILITY PRO, INC.,

Registrant

**REGISTRANT'S MEMORANDUM IN OPPOSITION TO
MOTION FOR DEFAULT JUDGMENT FOR FAILURE TO ANSWER
AND REQUEST TO SUSPEND PROCEEDINGS**

Registrant, Facility Pro, Inc. ("FPI"), through the undersigned counsel, hereby submits this memorandum in opposition to Petitioner's Motion for Default Judgment for Failure to Answer, and states as follows:

The reason for FPI's failure to respond is simple. FPI never received notice of the proceeding. Counsel for FPI is the same as in Opposition No. 91235411 and in litigation between the parties captioned *Facilities Pro-Sweep, Inc. v. Facility Pro, Inc.*, Case No. 17-60675-CIV-

DIMITROULEAS, currently pending in the United States District Court for the Southern District of Florida. Counsel for petitioner is, likewise, counsel in each of these other matters between the parties. The petition for cancellation lists an outdated physical address for FPI and an email address of a lawyer in the undersigned firm (David Sigalow-dsigalow@allendyer.com), and Petitioner contends it served a copy of the petition on both. (Paper No. 4, ¶6.) Given the incorrect physical address, Registrant has no record of receiving the petition. Additionally, the undersigned law firm has no record of receiving the ESTTA notification of this action. (Ex A-Decl. of David Sigalow, ¶3.) Had FPI or David Sigalow received the cancellation petition, an answer would have been timely filed. The undersigned firm received a copy of the motion for default, which was the first time it became aware of this proceeding. (Sigalow Decl., ¶3.) Having never received notice, Registrant requests the motion for default be denied and new dates issued. Additionally, Registrant requests a week extension of time to file an answer to the petition.

As an alternative to new dates and a request to file an answer, Registrant requests that the TTAB suspend this cancellation proceeding pending the outcome of a civil action involving the parties. (A true and correct copy of the Complaint is attached hereto as Exhibit B). Specifically, the civil action was filed four months prior to this proceeding, and the claims bear on the issues presented to the Board in the Petition. Facilities Pro-Sweep, the Plaintiff in the civil action, alleges claims of infringement of its marks by the use of the FPI marks in this cancellation action.

It is the policy of the Board to suspend cancellation proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board's proceedings. TBMP §510.02, citing 37 C.F.R. § 2.117(a); *see also New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011) (civil action

need not be dispositive of Board proceeding, but only needs to have bearing on issues before the Board); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975); *Tokaido v. Honda Associates, Inc.*, 179 USPQ 861 (TTAB 1973). This policy makes perfect sense. When a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board. *See* TBMP § 510.02(a); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848 (2d Cir. 1988) (PTO registration would not affect the legal standard applied in infringement claim or the scope of the required fact-finding; the district court will still independently have to determine the validity of the mark). While the Supreme Court recently found that TTAB decisions can be binding on a federal court (*B&B Hardware Inc. v. Hargis Industries*, 135 S.Ct. 1293, 1310 (2015)), under no circumstances could this Board's decision resolve all issues in the pending federal litigation, which encompass Petitioner's rights, which are not involved in this proceeding. As such, there is no reason for the parties or the Board to spend time and resources on this dispute when the resolution at the Board will not resolve the first-filed federal litigation between the same parties.

Equitable considerations favor suspension of the cancellation proceeding because conducting two trials involving the same parties and the same issues will undoubtedly result in duplication of effort and expense. There is also the potential that simultaneous proceedings on these issues could result in inconsistent results. Accordingly, Registrant respectfully requests that the Board suspend these cancellation proceedings until final disposition of the civil action noted above.

Respectfully submitted October 31, 2017.

/s/Ryan T. Santurri

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and complete copy of the foregoing has been served by email on October 31, 2017 to:

John F. Bradley, Esq.

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Bradley Legal Group, P.A.

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/s/ Ryan T. Santurri

Ryan T. Santurri

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