

ESTTA Tracking number: **ESTTA933007**

Filing date: **11/05/2018**

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

Proceeding	91238235
Party	Defendant Zola Inc.
Correspondence Address	ANITA B POLOTT MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVE NW WASHINGTON, DC 20004 UNITED STATES trademarks@morganlewis.com, anita.polott@morganlewis.com, peter.byrne@morganlewis.com, michelle.raynes@morganlewis.com 202-739-5397
Submission	Motion to Suspend for Civil Action
Filer's Name	Peter G. Byrne
Filer's email	peter.byrne@morganlewis.com
Signature	/Peter G. Byrne/
Date	11/05/2018
Attachments	Motion to Suspend.pdf(3883333 bytes)

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

In re Application Serial No. 87/307,497)	
Reg. No. 4573734)	
Mark: ZOLA)	
)	
PREZOLA LIMITED,)	
)	
Petitioner/Opposer,)	
)	
v.)	Opposition No. 91238235
)	(Parent Case)
)	Cancellation No. 92067549
ZOLA, INC.)	
)	
Applicant/Registrant.)	
)	

MOTION TO SUSPEND FOR CIVIL ACTION

In accordance with Rule 2.117 of the Trademark Rules of Practice, and by and through its undersigned counsel, Applicant/Registrant Zola, Inc. (“Zola”) respectfully requests suspension of the above-styled consolidated opposition and cancellation proceedings (“Proceeding”) because the claims asserted by Petitioner Prezola Limited (“Prezola”) are the subject of a pending civil action.

The parties to this Proceeding are currently involved in a civil action, *Zola, Inc. v. Prezola Ltd.*, Civil Action No. 1:18-cv-10213, which is pending in the United States District Court for the Southern District of New York. In the civil action, Zola has, *inter alia*, requested a declaratory judgment that its ZOLA mark does not infringe Prezola’s PREZOLA Mark on the grounds that (a) Prezola does not have priority in its PREZOLA Mark in the United States vis-à-

vis the ZOLA Mark and/or (b) Zola's ZOLA Mark has not caused, nor is it likely to cause, confusion with Prezola's PREZOLA Mark. Moreover, Zola has requested an order directing the United States Patent and Trademark Office to dismiss the Proceeding on the same grounds. A copy of the Complaint is attached as **Exhibit 1**.

The same issues raised in the above referenced pending civil litigation, including priority and likelihood of confusion, have also been raised by Prezola in the Proceeding. Moreover, Zola's requested relief includes a request for the Board to dismiss the Proceeding. Thus, the outcome of the civil action will have a bearing on this Proceeding.

WHEREFORE, Zola requests that this Proceeding be suspended until termination of the above referenced civil action.

Respectfully submitted,

/s/ Anita B. Polott
Anita B. Polott
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, NW
Washington, DC 20004-2541
(202) 739-3000

Peter G. Byrne
MORGAN, LEWIS & BOCKIUS LLP
One Market Street, Spear Street Tower
San Francisco, CA 94610
(415) 442-1335

Dated: November 5, 2018

Attorneys for Zola, Inc.

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

In re Application Serial No. 87/307,497 Reg. No. 4573734)	
Mark: ZOLA)	
PREZOLA LIMITED,)	
Petitioner/Opposer,)	
v.)	Opposition No. 91238235 (Parent Case)
)	Cancellation No. 92067549
ZOLA, INC.)	
Applicant/Registrant.)	

CERTIFICATE OF SERVICE

I hereby certify that on November 5, 2018, a true and accurate copy of the foregoing Motion to Suspend for Civil Action was served on counsel for Prezola Limited, by emailing a copy to:

Charles P. Guarino
MOSER TABOADA
cguarino@mtiplaw.com

/s/ Peter G. Byrne

Peter G. Byrne

EXHIBIT 1

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.