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

Proceeding	92071900
Party	Plaintiff ORAFOL Americas Inc.
Correspondence Address	ANUJ DESAI ARNALL GOLDEN GREGORY LLP 171 17TH ST NW, SUITE 2100 ATLANTA, GA 30363 UNITED STATES trademarks@agg.com, anuj.desai@agg.com 404-873-8500
Submission	Motion to Suspend for Civil Action
Filer's Name	Anuj Desai
Filer's email	trademarks@agg.com
Signature	/Anuj Desai/
Date	03/06/2020
Attachments	Motion to Suspend TTAB Proceeding.pdf(89077 bytes) Motion to Suspend TTAB Proceeding Exhibit 1.pdf(1307703 bytes)

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

In the matter of:

Registration No. **5661245**
For the Mark **651VINYL**

ORAFOL Americas Inc.

Petitioner,

v.

Vinyl Fanatic LLC,

Registrant.

Cancellation No. **92071900**

**PETITIONER'S MOTION TO SUSPEND PROCEEDINGS
PENDING DISPOSITION OF CIVIL ACTION**

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Petitioner ORAFOL Americas Inc. ("Petitioner") through its undersigned counsel, hereby moves the Board to suspend the above-referenced proceeding (the "TTAB Proceeding") pending final disposition of federal district court case *ORAFOL Americas Inc. et al. v. Vinyl Fanatic LLC et al.*, No. 4:20-cv-00043-RSB-CLR, filed March 5, 2020, in federal district court for the Southern District of Georgia (Savannah Division). True and correct copies of the Complaint and civil cover sheet from this action are attached hereto as **Exhibit 1**.

ARGUMENT AND CITATION TO AUTHORITY

The Complaint in the civil action seeks, *inter alia*, the same substantive relief sought in this proceeding, namely, a judgment that Registrant's registration for the 651VINYL mark (Registration No. 5661245) be cancelled under 15 U.S.C. § 1064. Moreover, the Complaint seeks additional relief under the Lanham Act and other laws with respect to Registrant's trademark infringement, false advertising, false designation of origin, violations of the Anticybersquatting Consumer Protection Act, and related federal and state law claims based on the 651, ORACAL 651, and 651VINYL marks at issue in this proceeding, as well as other marks belonging to Petitioner.

Given that the parties are now involved in court proceedings concerning the same marks and issues involved in this TTAB Proceeding, the "standard procedure" of the Board is to suspend its administrative proceeding pending outcome of the civil litigation. *New Orleans Louisiana Saints LLC et al. v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011) (quoting 6 *McCarthy on Trademarks and Unfair Competition* § 32:47 (5th ed. updated September 2017)).

Generally, a civil action need not even be dispositive of a 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 proceeding would, in fact, be dispositive of the matter before the Board, and it involves the same parties and marks subject to this TTAB Proceeding, as well as the same nucleus of operative facts, as a plain reading of the Complaint demonstrates.

Moreover, the pending civil action involves other parties and matters outside Board jurisdiction (including related issues of damages and injunctive relief) and involves the consideration of broader issues beyond right to registration, which is the only issue involved in this TTAB Proceeding. Therefore, pursuant to TBMP § 510.02(a), judicial economy is served by the requested suspension. *Accord The Other Tel. Co. v. Connecticut Nat'l Tel. Co.*, 181 U.S.P.Q. (BNA) ¶ 125 (T.T.A.B. Feb. 11, 1974).

Additionally, the parties are currently engaged in discovery in this TTAB Proceeding, but minimal written discovery has taken place as the parties were previously attempting to settle their dispute. No documents have been produced. No depositions have occurred or been noticed. And fact discovery is set to close on April 8, 2020. Because the civil action involves not only the issues currently before the Board, but also issues of false advertising, deceptive trade practices, and unfair competition, discovery in the civil action will involve documents, depositions, and other information that is not being and has not been gathered or produced in this proceeding. Thus, suspending the TTAB Proceeding, including as to all outstanding written discovery requests and deadlines 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 (T.T.A.B. Aug. 13, 2002) (citing *The Other Tel.*, 181 U.S.P.Q. (BNA) ¶ 125) ("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.)

CONCLUSION

For these reasons, Petitioner submits that an order from the Board immediately suspending the TTAB Proceeding, including all outstanding discovery requests and deadlines, is warranted. Petitioner respectfully requests that its motion be granted.

Respectfully submitted,

ARNALL GOLDEN GREGORY LLP

/Anuj Desai/

Anuj Desai | anuj.desai@agg.com

*Counsel for Petitioner
ORAFOL Americas Inc.*

171 17th Street, N.W., Suite 2100
Atlanta, Georgia 30363
Phone: (404) 873-8500
Fax: (404) 873-8501
trademarks@agg.com

CERTIFICATE OF SERVICE

I hereby certify that, on March 6, 2020, a copy of the foregoing motion was sent via e-mail to Registrant's counsel of record, as follows:

John W. Scruton
STITES & HARBISON
400 West Market Street, Suite 1800
Louisville, Kentucky 40202-3352
jscruton@stites.com
tmlou@stites.com

/Anuj Desai/

Anuj Desai

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