

ESTTA Tracking number: **ESTTA625649**

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

Proceeding.	92059680
Applicant	Defendant Spark Industries, LLC
Other Party	Plaintiff Kretek International, Inc
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	No

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Spark Industries, LLC hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Spark Industries, LLC has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Spark Industries, LLC has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/Michael A. DiNardo/

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09/05/2014

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

In the matter of:

U.S. Trademark Registration No. 3,974,247

Mark: 

Registration Date: June 7, 2011

KRETEK INTERNATIONAL, INC.,

Petitioner,

vs.

SPARK INDUSTRIES, LLC,

Registrant.

Cancellation No. 92059680

STIPULATED MOTION FOR SUSPENSION OF PROCEEDINGS

Pursuant to 37 CFR §2.117(a) and TBMP § 510.02(a) Registrant, Spark Industries, LLC (“Registrant”) and Petitioner, Kretek International, Inc. (“Petitioner”), by and through their respective undersigned counsel, hereby jointly request that the Trademark Trial and Appeal Board (“T.T.A.B.” or “Board”) suspend this cancellation proceeding until the final determination of *Spark Industries, LLC v. Kretek International, Inc. et al.*, Civil Action No. 14-05726, in the United States District Court for the Central District of California, Western Division, because the civil case will have a bearing on the instant proceeding. The civil action was originally filed in Ventura County Superior Court of the State of California and removed to District Court on July 23, 2014.

**THE DETERMINATION IN THE CIVIL ACTION WILL HAVE A
DIRECT BEARING ON THE ISSUES BEFORE THE BOARD**

Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on the T.T.A.B. matter, the Board may suspend the proceeding until the final

determination of the civil action. 37 CFR §2.117(a) and TBMP § 510.02(a). This is because “a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent’s rights to retain its registration would not be binding or res judicata in respect to the proceedings before the federal district court.”

Whopper-Burger, Inc. v. Burger King Corp., 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971).

In this action, Petitioner seeks cancellation of the registration based on fraud, and in the alternative abandonment based on naked licensing. In the civil action pending in the Central District of California between the parties, Registrant seeks a declaration that Petitioner does not own any rights to the brand and the mark at issue, among other claims. The determination of ownership of the mark at issue is also raised in Petitioner’s counterclaim filed in the pending district court action. Accordingly, the District Court’s findings as to who owns the intellectual property, including the mark at issue may directly impact the issues before the Board here. As the civil action thus may have a bearing on the instant matter, suspension is proper. 37 CFR 2.117(a); TBMP § 510.02(a).

Based on the foregoing, Petitioner and Registrant respectfully request that the Board grant this Motion and suspend proceedings during the pendency of the related civil action.

Respectfully submitted,

MAYBACK & HOFFMAN, P.A.

/Catherine F. Hoffman/
By: _____
Catherine F. Hoffman, Esq.
James A Stepan, Esq.

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/Michael A. DiNardo/
By: _____
Scott W. Kelley, Esq.
Michael A. DiNardo, Esq.

Attorneys for Registrant,
Spark Industries, LLC

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the attached STIPULATED MOTION FOR SUSPENSION OF PROCEEDINGS to be served on this date via U.S. first class mail, postage prepaid, upon counsel for Petitioner, as follows:

Catherine F. Hoffman
James A. Stepan
Mayback & Hoffman, PA
5722 South Flamingo Road, Suite 232
Fort Lauderdale, FL 33330

Dated: September 5, 2014

/Nancy Hoover/

NANCY HOOVER