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

Proceeding	87351374
Applicant	Roma USA, LLC
Applied for Mark	ROMABIO
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Submission	Applicant's Motion to Suspend
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Date	04/11/2018

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

In Re Application of
“ROMABIO (and design)”

Serial No.: 87351374

**MOTION TO SUSPEND PENDING OUTCOME OF
PETITION FOR PARTIAL CANCELLATION**

Roma USA, LLC (“Appellant”), hereby moves, pursuant to Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1213, to suspend the instant appeal pending the outcome of its Petition for Partial Cancellation of Trademark Reg. No. 4,311,113 (the “’113 Registration”).

Facts

1. On February 27, 2017, Petitioner filed Trademark Application Ser. No. 87/351374 for the mark ROMABIO (and design), depicted below, in connection with “House paint; Lime wash paint” in Class 002 (the “ROMABIO Application”).

The logo for ROMABIO features the word "ROMABIO" in a bold, black, sans-serif font. The letter "O" is stylized with a circular shape that has a small gap at the top, resembling a stylized eye or a specific design element. The letters are closely spaced and centered.

2. On May 25, 2017, a first Office Action was issued preliminarily refusing registration of the ROMABIO Application based upon Section 2(d) of the Trademark Act, citing the ’113 Registration as a bar to registration based on likelihood of confusion with the goods in Class 002 set forth therein.

3. The ’113 Registration for ROMA (and design), depicted below, lists “Paints, varnishes, lacquers; metals in foil and powder form for painters, decorators, printers and artists” as goods in Class 002.



4. On August 8, 2017, Appellant filed a response to the Office Action, arguing that there is no likelihood of confusion between the mark subject to the ROMABIO Application and the mark subject to the '113 Registration.

5. On August 31, 2017, a Final Office action was issued continuing the Section 2(d) refusal discussed in Paragraph 2 above.

6. Appellant subsequently filed Requests for Reconsideration on January 5, 2018 and February 23, 2018, which were denied on January 30, 2018 and March 16, 2018, respectively.

7. Appellant does not believe that there is a likelihood of confusion between its ROMABIO (and design) mark and the ROMA (and design) mark subject to the '113 Registration, notwithstanding that the Patent and Trademark Office has (erroneously) stated that there is.

8. Appellant filed the instant appeal on February 23, 2018, which was suspended pending the resolution of the March 16, 2018 request for reconsideration.

9. The instant proceedings resumed on March 19, 2018. Briefs have yet to be filed and there are no outstanding motions.

10. On April 4, 2018, Appellant filed with the Board a Petition for Partial Cancellation of the '113 Registration with respect to the goods set forth therein in Class 002, Proceeding No. 92068327, on the grounds of abandonment. Such proceeding remains pending.

Argument

Board procedure strongly favors the suspension of an *ex parte* appeal pending the resolution of an *inter partes* proceeding that may substantively affect the merits of the appeal.

Prior to the issuance of the Board's decision in an *ex parte* appeal, proceedings with respect to the appeal may be suspended by the Board upon written request by the applicant showing good cause for the requested suspension. Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, [include]:

(1) The applicant is involved in a civil action or a Board *inter partes* proceeding, that may be dispositive of the issue(s) involved in the appeal, or the applicant has filed a Petition to the Director that may have a bearing on the appeal—the Board may suspend pending final determination of the civil action or Board *inter partes* proceeding.

TBMP § 1213 (internal citations omitted).

As set forth above, Appellant's pending ROMABIO Application has been refused registration based on a Patent and Trademark Office determination that the mark subject thereto is likely to be confused with the mark subject to the '113 Registration with respect to the goods set forth therein in Class 002. The outcome of pending *inter partes* Proceeding No. 92068327 may have a dispositive impact on the instant appeal. In the event that Appellant's Petition for Partial Cancellation is sustained, the '113 Registration will be canceled with respect to Class 002 and no longer serve to bar approval of the ROMABIO Application. Because there are no outstanding motions and briefs have yet to be filed in this appeal, a suspension thereof will not prejudice Appellant or the Patent and Trademark Office.

WHEREFORE, Appellant respectfully requests that the Board suspend the instant appeal pending the outcome of *inter partes* Proceeding No. 92068327.

Respectfully submitted,

Dated: April 11, 2018

By: /Anthony E. Rufo/

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