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

Proceeding	91228881
Party	Plaintiff Hillstone Restaurant Group, Inc.
Correspondence Address	Uly S. Gunn Alston & Bird LLP 1201 West Peachtree Street Atlanta, GA 30309 UNITED STATES sam.gunn@alston.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Uly S. Gunn
Filer's e-mail	sam.gunn@alston.com, david.stewart@alston.com
Signature	/Uly S. Gunn/
Date	09/19/2016
Attachments	Motion to Suspend.pdf(204533 bytes ) Motion to Suspend - Exhibit A - Complaint.pdf(560050 bytes )

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

In the Matter of U.S. Application Serial No. 86/730,033  
Mark: HILLSTONE

HILLSTONE RESTAURANT )  
GROUP, INC. )  
 )  
Opposer, )  
 )  
vs. )  
 )  
HILLSTONE MANAGEMENT, LLC )  
 )  
Applicant. )  
 )  
 )  
\_\_\_\_\_ )

Opposition No. 91228881

**MOTION TO SUSPEND OPPOSITION PROCEEDING**

Opposer Hillstone Restaurant Group, Inc. (“Hillstone”) files this motion to request the suspension of this proceeding pending the outcome of a recently filed civil action that has a direct bearing on the opposition.

In its Notice of Opposition in this matter, Hillstone alleged that applicant Hillstone Management, LLC’s (“Hillstone Management”) application Ser. No. 86/730,033 for the mark HILLSTONE should not be allowed to register because that mark is likely to confuse consumers into believing, mistakenly, that Hillstone Management’s services originate from, are associated or affiliated with, and/or are sponsored or endorsed by Hillstone, and therefore infringes Hillstone’s federally-registered HILLSTONE mark. On September 13, 2016, Hillstone filed a complaint in the United States District Court for the Northern District of Texas against Hillstone Management alleging federal trademark infringement (among other counts) and seeking as part of its relief a permanent injunction against any further use of the HILLSTONE mark by Hillstone Management. A file-stamped copy of this complaint, assigned Case No. 3:16-cv-02624-D, is

attached as Exhibit A. The complaint was served on Hillstone Management on September 15, 2016.

The Board has the discretion to suspend proceedings before it upon notice that the parties to that proceeding are “engaged in a civil action . . . which may have a bearing on the case.” 37 C.F.R. § 2.117; TBMP § 510.02(a). A federal lawsuit between the same parties as are engaged in an opposition involving identical allegations of trademark infringement as those found in the notice of opposition has a bearing on that opposition proceeding and therefore merits suspension. *See Arcadia Group Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d 1134, 1136 (T.T.A.B. 2011) (suspending opposition where opposer had filed a civil action alleging trademark infringement and seeking to enjoin applicant’s use of mark at issue); *see also The Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. 689, 691-92 (T.T.A.B. 1975), *rev’d on other grounds*, 193 U.S.P.Q. 149 (C.C.P.A. 1977) (same).

Here, the outcome of Hillstone’s trademark infringement claims in its complaint against Hillstone Management will have a direct bearing on the present opposition proceeding, as the same issues before the Board in the opposition will be before the federal court in the civil action. Hillstone therefore respectfully requests the Board suspend these proceedings until resolution of the above referenced proceeding in the Northern District of Texas.

Respectfully submitted this 19th day of September, 2016.

By: /Uly S. Gunn/  
David J. Stewart, Esq.  
Georgia Bar No. 681149  
david.stewart@alston.com  
Uly S. Gunn, Esq.  
Georgia Bar No. 261871  
sam.gunn@alston.com

ALSTON & BIRD LLP  
1201 West Peachtree Street  
Atlanta, Georgia 30309  
Telephone: (404) 881-7000  
Fax: (404) 881-7777

*Attorneys for Opposer*  
HILLSTONE RESTAURANT  
MANAGEMENT

**CERTIFICATE OF ELECTRONIC FILING AND SERVICE**

I hereby certify that the foregoing **MOTION TO SUSPEND OPPOSITION PROCEEDING** is being submitted to the Trademark Trial and Appeal Board via electronic means by filing with the Electronic Systems for Trademark Trial and Appeals on September 19, 2016. A true and correct copy was also mailed to the Applicant's attorney of record via U.S.

Mail:

Jerry C. Harris, Jr.  
Wick Phillips Gould & Martin LLP  
3131 McKinney Avenue, Suite 100  
Dallas, Texas 75204

/Uly S. Gunn/  
Uly S. Gunn, Esq.

# Exhibit A

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION**

HILLSTONE RESTAURANT GROUP,  
INC.,

Plaintiff,

v.

HILLSTONE MANAGEMENT, LLC,

Defendant.

CIVIL ACTION NO. \_\_\_\_\_

**COMPLAINT AND JURY TRIAL DEMAND**

Plaintiff Hillstone Restaurant Group, Inc. (“Hillstone”) files this complaint against Defendant Hillstone Management, LLC (“Hillstone Management”) and in support hereof alleges as follows:

**INTRODUCTION**

1. This is a civil action for trademark infringement, trademark dilution, false designations of origin, and unfair competition arising under the Lanham Act, the Texas Business and Commerce Code, and the common law of the State of Texas. Hillstone seeks injunctive relief, damages, punitive damages and recovery of its reasonable costs and attorneys’ fees.

**PARTIES**

2. Hillstone is a Delaware corporation with its principal place of business at 2710 Camelback Road, Suite 200, Phoenix, Arizona 85016.

3. Hillstone Management is a Texas limited liability company with its principal place of business at 2301 Cedar Springs Road, Suite 200, Dallas, Texas 75201.

**JURISDICTION AND VENUE**

4. This Court has original jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 (Lanham Act), 28 U.S.C. § 1331 (federal question), and 28 U.S.C. § 1338 (trademark and unfair competition) because this case arises under the Lanham Act, 15 U.S.C. § 1051, *et seq.*

5. This Court has original jurisdiction over Hillstone's state statutory and common law claims pursuant to 28 U.S.C. § 1332 (diversity jurisdiction). There is complete diversity of citizenship between Hillstone and Hillstone Management, and the matter in controversy between Hillstone and Hillstone Management exceeds the sum of \$75,000, exclusive of interest and costs.

6. This Court has supplemental jurisdiction over Hillstone's state statutory and common law claims pursuant to 28 U.S.C. § 1367 (supplemental jurisdiction).

7. This Court has personal jurisdiction over Hillstone Management because Hillstone Management resides in this judicial district, has committed tortious acts within this judicial district, has transacted business within this judicial district, and has otherwise made or established contacts with this judicial district sufficient to permit the exercise of personal jurisdiction by this Court over it.

8. Venue is proper within this Court pursuant to 28 U.S.C. § 1391(b) because Hillstone Management resides in this district, a substantial part of the events and injury giving rise to Hillstone's claims is occurring within this judicial district, and because Hillstone Management is subject to personal jurisdiction within this judicial district.



**FACTUAL BACKGROUND**

**Hillstone and its Famous HILLSTONE Mark**

9. Hillstone is a privately-held restaurant management company that owns and operates 49 restaurants in 14 states under fifteen different brands.

10. Among Hillstone's most well-known restaurant brands is HILLSTONE, a chain of ten restaurants located across the country, including in Dallas, Texas.

11. Hillstone has used the distinctive HILLSTONE service mark in interstate commerce since at least as early as 2005 in connection with restaurant services, and Hillstone has operated a restaurant in Dallas under the HILLSTONE mark since 2010. Prior to 2010, Hillstone was already known to consumers in the Dallas area due to its operation of other restaurants there, including restaurants under the HOUSTON'S and CAFÉ R&D (now R+D KITCHEN) marks.

12. In recognition of Hillstone's rights in the HILLSTONE mark, the United States Patent and Trademark Office ("USPTO") issued Hillstone Trademark Reg. No. 3,549,950 for the HILLSTONE mark in 2008 for use in connection with restaurant services.

13. This registration is valid and subsisting in law, was duly and legally issued, is *prima facie* evidence of the validity of the mark registered, and constitutes constructive notice of the ownership of this mark by Hillstone in accordance with Sections 33(a), 7(b) and 22 of the Lanham Act, 15 U.S.C. §§ 1115(a), 1057(b) and 1072.

14. The HILLSTONE registration is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and, pursuant to Section 33(b) of the Act, 15 U.S.C. § 1115(b), constitutes conclusive evidence of Hillstone's exclusive right to use the HILLSTONE mark identified in the registration in commerce in the United States.

15. Through substantial marketing, publicity and sales, the HILLSTONE mark is famous in that it is widely recognized in the Dallas-Fort Worth metropolitan area and throughout Texas.

16. The HILLSTONE mark achieved this fame well-prior to the actions of Hillstone Management complained of herein.

**Hillstone Management and its Wrongful Conduct**

17. Hillstone Management is a Texas-based real estate management company that, under the service mark HILLSTONE, serves as a property management company for select assets owned by a third party and its affiliates.

18. Hillstone Management is headquartered in Dallas, approximately five miles from the HILLSTONE restaurant in Dallas.

19. Upon information and belief, Hillstone Management manages six apartment complexes in the Dallas-Fort Worth area and elsewhere in Texas that operate under the following service marks, each of which includes the term “Hillstone” as the dominant, distinctive element of the mark: HILLSTONE ON THE PARKWAY, HILLSTONE AT PRUE, HILLSTONE RANCH, HILLSTONE ON CENTER, HILLSTONE TRINITY OAKS, and HILLSTONE ON THE TRAIL.

20. Upon information and belief, Hillstone Management owns each of these marks and licenses them to an affiliate for use in connection with the apartment complexes.

21. Hillstone Management operates a website to promote its services that is located at a domain name that also consists in dominant part of Hillstone’s mark:  
<hillstoneproperties.com>.

22. On August 9, 2015, Hillstone Management filed an application with the USPTO to register the HILLSTONE mark in connection with “[r]eal estate management services; real estate management consultation; real estate services, namely, property management services for apartment buildings; leasing of apartments; management of apartments; real estate services, namely, rental, leasing, and management of commercial property, offices, and office space” (the “Application”).

23. In the Application, Hillstone Management claims a date of first use of the HILLSTONE mark of February 24, 2012.

24. Hillstone filed an opposition to the Application with the USPTO’s Trademark Trial and Appeal Board that is presently pending.

25. Upon information and belief, Hillstone Management adopted its HILLSTONE mark with actual knowledge of Hillstone’s rights in its HILLSTONE mark and with the purpose and intent of trading on those rights.

## COUNT I

### Federal Trademark Infringement

26. Hillstone incorporates by reference the allegations contained in paragraphs 1 - 25 of this Complaint as if fully set forth herein.

27. The HILLSTONE mark serves to identify to the public services that are offered by Hillstone alone, or services that are sponsored by, approved by, authorized by, associated with, or affiliated with Hillstone alone.

28. Hillstone Management is using copies of Hillstone’s federally registered HILLSTONE mark in interstate commerce without Hillstone’s authorization or consent in connection with the sale and offering for sale of services in a manner that is likely to cause

confusion, mistake, or deception as to whether the services originate from Hillstone, or are sponsored or endorsed by, or associated or affiliated with, Hillstone.

29. Hillstone Management's conduct will enable Hillstone Management to earn profits to which Hillstone Management is not in law, equity or good conscience entitled, and has unjustly enriched Hillstone Management, all to Hillstone Management's profit.

30. Hillstone Management's conduct constitutes service mark infringement in violation of Section 32(1) of the Trademark Act of 1946, 15 U.S.C. § 1114(1).

31. As a direct and proximate result of Hillstone Management's conduct in violation of 15 U.S.C. § 1114(1), Hillstone has suffered actual and irreparable injury for which no adequate remedy exists at law.

32. Hillstone Management's wrongful conduct will continue to cause such injury unless enjoined by this Court.

## COUNT II

### Federal False Designations of Origin & Unfair Competition

33. Hillstone incorporates by reference the allegations contained in paragraphs 1 – 25 of this Complaint, as if fully set forth herein.

34. Hillstone Management is knowingly using imitations of the HILLSTONE mark without authorization or consent from Hillstone in interstate commerce in connection with the sale, offering for sale, distribution, and advertising of services in a manner that is likely to cause confusion, mistake, or deception as to the true source or sponsorship of Hillstone Management's goods and services.

35. Hillstone Management's conduct has enabled Hillstone Management to earn profits to which Hillstone Management is not in law, equity or good conscience entitled, and has

unjustly enriched Hillstone Management, all to Hillstone Management's profit and to Hillstone's damage and detriment.

36. Hillstone Management's conduct constitutes false designations of origin and unfair competition in violation of Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

37. As a direct and proximate result of Hillstone Management's conduct in violation of Section 43(a)(1)(A), Hillstone has suffered actual and irreparable injury for which no adequate remedy exists at law, and Hillstone Management's conduct will continue to cause such injury unless enjoined by this Court.

### **COUNT III**

#### **Trademark Dilution - Texas Business & Commerce Code § 16.103**

38. Hillstone incorporates by reference the allegations contained in paragraphs 1 - 25 of this Complaint, as if fully set forth herein.

39. Hillstone's HILLSTONE mark is inherently distinctive and, by virtue of its long and continuous use and promotion in Dallas and throughout Texas, has become widely recognized throughout the Dallas area and Texas as a whole and is therefore famous. Hillstone's HILLSTONE mark achieved this fame prior to Hillstone Management's first use of the HILLSTONE mark.

40. Hillstone Management's use of marks and names that consist of or incorporate the HILLSTONE mark constitutes knowing and willful trademark dilution in violation of Texas Business & Commerce Code § 16.103 in that such use is likely to blur the distinctive quality of the HILLSTONE mark.

41. Hillstone Management's conduct, as described above, has caused, and unless enjoined by this Court, will continue to cause irreparable harm, loss, and injury to Hillstone for which Hillstone has no adequate remedy at law.

**COUNT IV**

**Texas Common Law Unfair Competition**

42. Hillstone incorporates by reference the allegations contained in paragraphs 1 - 25 of this Complaint, as if fully set forth herein.

43. Hillstone Management has willfully and intentionally used marks and names that include the HILLSTONE mark without authorization or consent from Hillstone in commerce in connection with the sale, offering for sale, distribution, and advertising of services in a manner that is likely to cause confusion, mistake, or deception as to the true source or sponsorship of Hillstone Management's services.

44. Hillstone Management's conduct has enabled Hillstone Management to earn profits to which Hillstone Management is not in law, equity or good conscience entitled, and has unjustly enriched Hillstone Management, all to Hillstone Management's profit and to Hillstone's damage and detriment.

45. Hillstone Management's wrongful activity consisting of unauthorized use of the HILLSTONE mark is calculated to deceive consumers and is likely to cause confusion, mistake, and deception as to the association and affiliation of Hillstone Management's services with Hillstone and its HILLSTONE-branded services.

46. Hillstone Management's conduct constitutes unfair competition in violation of the common laws of the State of Texas.

47. As a direct and proximate result of Hillstone Management's conduct, Hillstone has suffered actual and irreparable injury for which no adequate remedy exists at law, and

Hillstone Management's conduct will continue to cause such injury unless enjoined by this Court.

48. Upon information and belief, Hillstone Management's conduct has been with full knowledge of Hillstone's rights and with an intent of trading thereon.

**JURY DEMAND**

Hillstone hereby demands trial by jury of all issues raised in this Complaint.

**PRAYER FOR RELIEF**

WHEREFORE, by virtue of Hillstone Management's unlawful conduct as alleged in Counts I through IV above, Hillstone respectfully prays that:

1. The Court enter judgment that Hillstone owns valid and enforceable rights in the HILLSTONE mark, and that Hillstone Management, as a direct and proximate result of its unlawful and unauthorized use of the HILLSTONE mark, has:

- (a) infringed Hillstone's rights in its HILLSTONE mark in violation of 15 U.S.C. § 1114(1);
- (b) unfairly competed with Hillstone in violation of 15 U.S.C. § 1125(a)(1)(A);
- (c) diluted Hillstone's HILLSTONE mark by impairing the distinctiveness of that mark in violation of Texas Business & Commerce Code § 16.103; and
- (d) engaged in acts of unfair competition in violation of the common law of the State of Texas; and

2. The Court enter a permanent injunction restraining and enjoining Hillstone Management and each of its agents, servants, employees and all those persons in concert or participation with any of them, from:

- (a) using the HILLSTONE mark, any other name or mark that includes the term “Hillstone,” and any other confusingly similar name or mark of any kind or nature, including domain names and trade names, in connection with the promotion, advertisement, or offering of any goods or services in the United States;
- (b) otherwise diluting the distinctiveness of Hillstone’s HILLSTONE mark in any manner;
- (c) otherwise unfairly competing with, injuring the business or reputation of, or damaging the goodwill of Hillstone in any manner;
- (d) otherwise falsely representing that they are connected with, sponsored by, or associated with Hillstone; and
- (e) otherwise engaging in deceptive trade practices or unfair competition which in any way injures Hillstone.

3. Pursuant to Section 36 of the Lanham Act, 15 U.S.C. § 1118, Hillstone Management be directed to deliver up to Hillstone for destruction all advertising and promotional materials, signs, business cards and all other materials which bear the infringing HILLSTONE mark in any form, and all plates, molds, matrices and other means of making or duplicating the same;

4. An accounting be had and judgment be rendered against Hillstone Management for the profits, gains and advantages they have derived from its wrongful actions and the damages sustained by Hillstone as a result of Hillstone Management’s actions, with such amounts to be trebled as provided by law because of the willful and deliberate nature of Hillstone Management’s actions;



5. Hillstone Management be ordered to cease further use of the <hillstoneproperties.com> domain name and transfer the domain to Hillstone.
6. Hillstone Management be required to pay Hillstone actual damages, enhanced damages, and punitive damages in light of the willful, intentional and predatory nature of its actions;
7. Hillstone Management be required to pay Hillstone both the costs of this action and the reasonable attorneys' fees Hillstone has incurred in connection with this action; and
8. Hillstone be granted such other and further relief as the Court deems just and proper.

Respectfully submitted, this 13<sup>th</sup> day of September, 2016.

/s/ Darren L. McCarty

Darren L. McCarty  
Texas Bar No. 24007631  
ALSTON & BIRD LLP  
2828 North Harwood Street  
18th Floor  
Dallas, TX 75201  
Tel 214-922-3400  
Fax 214-922-3899  
darren.mccarty@alston.com

OF COUNSEL:

David J. Stewart  
Georgia Bar No. 681149  
david.stewart@alston.com  
Uly S. Gunn  
Georgia Bar No. 261871  
sam.gunn@alston.com  
ALSTON & BIRD LLP  
1201 W. Peachtree Street  
Atlanta, Georgia 30309  
(404) 881-7000 (telephone)  
(404) 881-7777 (facsimile)

Counsel for Plaintiff  
HILLSTONE RESTAURANT GROUP, INC.



**INSTRUCTIONS FOR ATTORNEYS COMPLETING CIVIL COVER SHEET FORM JS 44**

## Authority for Civil Cover Sheet

The JS 44 civil cover sheet and the information contained herein neither replaces nor supplements the filings and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. Consequently, a civil cover sheet is submitted to the Clerk of Court for each civil complaint filed. The attorney filing a case should complete the form as follows:

- I. (a) **Plaintiffs-Defendants.** Enter names (last, first, middle initial) of plaintiff and defendant. If the plaintiff or defendant is a government agency, use only the full name or standard abbreviations. If the plaintiff or defendant is an official within a government agency, identify first the agency and then the official, giving both name and title.  
(b) **County of Residence.** For each civil case filed, except U.S. plaintiff cases, enter the name of the county where the first listed plaintiff resides at the time of filing. In U.S. plaintiff cases, enter the name of the county in which the first listed defendant resides at the time of filing. (NOTE: In land condemnation cases, the county of residence of the "defendant" is the location of the tract of land involved.)  
(c) **Attorneys.** Enter the firm name, address, telephone number, and attorney of record. If there are several attorneys, list them on an attachment, noting in this section "(see attachment)".
- II. **Jurisdiction.** The basis of jurisdiction is set forth under Rule 8(a), F.R.Cv.P., which requires that jurisdictions be shown in pleadings. Place an "X" in one of the boxes. If there is more than one basis of jurisdiction, precedence is given in the order shown below.  
United States plaintiff. (1) Jurisdiction based on 28 U.S.C. 1345 and 1348. Suits by agencies and officers of the United States are included here. United States defendant. (2) When the plaintiff is suing the United States, its officers or agencies, place an "X" in this box.  
Federal question. (3) This refers to suits under 28 U.S.C. 1331, where jurisdiction arises under the Constitution of the United States, an amendment to the Constitution, an act of Congress or a treaty of the United States. In cases where the U.S. is a party, the U.S. plaintiff or defendant code takes precedence, and box 1 or 2 should be marked.  
Diversity of citizenship. (4) This refers to suits under 28 U.S.C. 1332, where parties are citizens of different states. When Box 4 is checked, the citizenship of the different parties must be checked. (See Section III below; **NOTE: federal question actions take precedence over diversity cases.**)
- III. **Residence (citizenship) of Principal Parties.** This section of the JS 44 is to be completed if diversity of citizenship was indicated above. Mark this section for each principal party.
- IV. **Nature of Suit.** Place an "X" in the appropriate box. If the nature of suit cannot be determined, be sure the cause of action, in Section VI below, is sufficient to enable the deputy clerk or the statistical clerk(s) in the Administrative Office to determine the nature of suit. If the cause fits more than one nature of suit, select the most definitive.
- V. **Origin.** Place an "X" in one of the seven boxes.  
Original Proceedings. (1) Cases which originate in the United States district courts.  
Removed from State Court. (2) Proceedings initiated in state courts may be removed to the district courts under Title 28 U.S.C., Section 1441. When the petition for removal is granted, check this box.  
Remanded from Appellate Court. (3) Check this box for cases remanded to the district court for further action. Use the date of remand as the filing date.  
Reinstated or Reopened. (4) Check this box for cases reinstated or reopened in the district court. Use the reopening date as the filing date.  
Transferred from Another District. (5) For cases transferred under Title 28 U.S.C. Section 1404(a). Do not use this for within district transfers or multidistrict litigation transfers.  
Multidistrict Litigation – Transfer. (6) Check this box when a multidistrict case is transferred into the district under authority of Title 28 U.S.C. Section 1407.  
Multidistrict Litigation – Direct File. (7) Check this box when a multidistrict case is filed in the same district as the Master MDL docket.  
**PLEASE NOTE THAT THERE IS NOT AN ORIGIN CODE 7.** Origin Code 7 was used for historical records and is no longer relevant due to changes in statute.
- VI. **Cause of Action.** Report the civil statute directly related to the cause of action and give a brief description of the cause. **Do not cite jurisdictional statutes unless diversity.** Example: U.S. Civil Statute: 47 USC 553 Brief Description: Unauthorized reception of cable service
- VII. **Requested in Complaint.** Class Action. Place an "X" in this box if you are filing a class action under Rule 23, F.R.Cv.P. Demand. In this space enter the actual dollar amount being demanded or indicate other demand, such as a preliminary injunction. Jury Demand. Check the appropriate box to indicate whether or not a jury is being demanded.
- VIII. **Related Cases.** This section of the JS 44 is used to reference related pending cases, if any. If a related case exists, whether pending or closed, insert the docket numbers and the corresponding judge names for such cases. A case is related to this filing if the case: 1) involves some or all of the same parties and is based on the same or a similar claim; 2) involves the same property, transaction, or event; 3) involves substantially similar issues of law and fact; and/or 4) involves the same estate in a bankruptcy appeal.

**Date and Attorney Signature.** Date and sign the civil cover sheet.