

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

In the Matter of Trademark Application
Serial No. 78/955,663
for the mark **BONGOS CUBAN CAFÉ**

-----X
ROBERTO NOBLE,

Opposer,

v.

ESTEFAN ENTERPRISES, INC.

Applicant.
-----X

Opposition No. 91177695

ROBERTO NOBLE'S MOTION TO SUSPEND PROCEEDINGS PENDING THE
DETERMINATION OF A FEDERAL DISTRICT CIVIL ACTION

Opposer, ROBERTO NOBLE, ("Noble"), by and through undersigned counsel, pursuant to TBMP §510.02(a), hereby requests the Board suspend this action pending the outcome of a federal district court proceeding, and states:

1. Noble brings to the Board's attention the pendency of the action in the United States District Court for the Southern District of Florida, styled *Marrero Enterprises of Palm Beach, Inc. v. Estefan Enterprises, Inc.*, Case No. 06-CIV-81036- Ryskamp (the "Marrero action").

2. On October 31, 2006, the undersigned attorney in this proceeding filed a Complaint for Declaratory Judgment on behalf of Marrero Enterprises of Palm Beach, Inc. ("Marrero") against ESTEFAN ENTERPRISES, INC. ("EEI") in West Palm Beach, Florida. The *Marrero* action involves a claim by Marrero for a declaration of non-infringement between COCO BONGO as a trademark and EEI's BONGOS CUBAN CAFE trademark (see Complaint for Declaratory Relief attached hereto as *Exhibit "A"*); a declaration that EEI's mark is not

protectable in the bar, nightclub, and entertainment industries; and for Cancellation of EEI's U.S. Registration No. 2,490,999. EEI asserted an Amended Counterclaim for infringement of its BONGOS CUBAN CAFE mark (see Amended Counterclaim attached hereto as *Exhibit "B"*). Marrero also raises many of the same affirmative defenses as Noble has raised herein. On November 29th, 2007, the U.S. District Court in the *Marrero* action joined Noble as a necessary party to that action. Marrero and Noble have also recently filed a motion for leave to jointly file an Amended Complaint in the *Marrero* case.

3. On September 19, 2006, Marrero assigned all right, title and interest in its COCO BONGO marks to Noble. Noble licensed to Marrero the right to use his COCO BONGO trademark.

4. The final determination of the *Marrero* action may have a bearing on the issues before the Board, because both proceedings are between the same parties concerning the same trademark rights.

5. In its Order dated January 29th, 2008, in a related Board proceeding involving EEI and Noble (*Estefan Enterprises, Inc. v. Roberto Noble and Bongo SA de CV*, consolidated proceeding Opposition No. 91121980), the Board suspended proceedings pending disposition of the civil litigation (*Marrero* action), and stated that "[i]n view of the relationship between Marrero and Noble, and the claims presented in the court case, a determination in the court case may have a bearing on this Board proceeding."

Opposer ROBERTO NOBLE hereby requests the Board suspend this proceeding pending disposition of the *Marrero* action.

CERTIFICATE OF GOOD FAITH

Pursuant to 37 C.F.R. §2.120 (e), counsel for Opposer has conferred with counsel for Applicant in a good faith effort to resolve the issues raised in the herein Motion, who has objected to the relief sought.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing document was served on this 3rd day of March, 2008, by first class mail to Karen L. Stetson, Esq., P.O. Box 403023, Miami, Florida and TTAB.

Respectfully submitted,

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
WEST PALM BEACH DIVISION

MARRERO ENTERPRISES OF
PALM BEACH, INC.,
a Florida corporation,

Plaintiff,

vs.

ESTEFAN ENTERPRISES, INC.
a Florida corporation,

Defendant.

CASE NO.

06-81036
CIV-RYSKAMP

MAGISTRATE JUDGE
VITUNAC

FILED BY
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S.D. OF FLA.-FT. L.

COMPLAINT FOR DECLARATORY JUDGMENT

COMES NOW Plaintiff, MARRERO ENTERPRISES OF PALM BEACH, INC.
and for their original Complaint for Declaratory Judgment against Defendant, ESTEFAN
ENTERPRISES, INC. alleges as follows:

PARTIES

1. Plaintiff MARRERO ENTERPRISES OF PALM BEACH, INC.
(hereinafter "Marrero") is a corporation formed under the laws of the State of Florida and
maintains its principal place of business at 2677 Forest Hill Boulevard, #112-116, West
Palm Beach, Florida 33406.

2. Defendant ESTEFAN ENTERPRISES, INC. (hereinafter "Estefan") is,
upon information and belief, a corporation formed under the laws of Florida with its
principal place of business at 420 Jefferson Avenue, Miami Beach, Florida, 33139. Upon

information and belief, Estefan and/or its subsidiaries do business and make sales to retailers and other entities in this federal judicial district and throughout the United States.

JURISDICTION AND VENUE

3. This action arises under the under 28 U.S.C. §§2201 and 2202 in that it is an action solely for a declaratory judgment of non-infringement.

4. Subject matter jurisdiction of this Court is proper pursuant to 28 U.S.C. § 1338.

5. At all times material hereto, the exercise of personal jurisdiction over Estefan is appropriate under the circumstances of this case as its principal place of business is located in Florida, more specifically, within the jurisdiction of the United States District Court, Southern District of Florida.

6. Venue is proper in this district under 28 U.S.C. 1391(c) because Estefan has engaged in business in the Southern District of Florida and all of the facts and allegations of infringement and unfair competition occurred in West Palm Beach, Florida. Additionally, venue is proper in the West Palm Beach Division of the United States District Court of the Southern District of Florida because the Defendant's counsel sent a "cease-and-desist" letter to the Plaintiff in this District, threatening federal trademark infringement regarding Plaintiff's mark COCOBONGO for its use of the mark in connection with Plaintiff's West Palm Beach, Florida nightclub.

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