

ESTTA Tracking number: **ESTTA443282**

Filing date: **11/28/2011**

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

Proceeding	91185411
Party	Plaintiff Bart Enterprises International LTD
Correspondence Address	CRISTINA ARENAS-SOLIS FERRAIUOLI TORRES MARCHAND & ROVIRA PSC 221 PLAZA, SUITE 403 SAN JUAN, PR 00917 UNITED STATES carenas@ftmrlaw.com, lbelendez@ftmrlaw.com
Submission	Other Motions/Papers
Filer's Name	Maristella Collazo-Soto
Filer's e-mail	trademarksca@ferraiuoli.com, mcollazo@ferraiuoli.com
Signature	/MaristellaCollazoSoto/
Date	11/28/2011
Attachments	Informative Motion of Proceedings in PR District Court.pdf (5 pages)(130189 bytes) Puerto Rico District Court Docket.pdf (69 pages)(5720160 bytes)

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

In the matter of Application Serial No. 77/047242
Publication in the *Official Gazette* of July 24, 2008
For: LOS ASTROLOGOS DE WALTER MERCADO

BART ENTERPRISES INTERNATIONAL LTD.
Opposer

v.

ASTROMUNDO INC.
Applicant

Opposition No. 91185411

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**INFORMATIVE MOTION REGARDING STATUS OF CIVIL CASE
RESOLUTION OF TRADEMARK ISSUE IN CIVIL CASE AND REQUESTING
THAT TRADEMARK BE REGISTERED TO THE RIGHTFUL OWNER, BART
ENTERPRISES INTERNATIONAL, LTD.**

COMES NOW, Bart Enterprises International, LTD.
(hereinafter "Bart"), by its undersigned attorneys, and
very respectfully states and prays:

1. On July 24, 2008, Bart filed a Notice of Opposition as
to the application of the above-referenced mark (the
"Trademark");

2. On August 9, 2010, Bart filed a motion titled:
INFORMATIVE MOTION REGARDING RESOLUTION OF TRADEMARK ISSUE
IN CIVIL CASE AND REQUESTING THAT TRADEMARK BE REGISTERED
TO THE RIGHTFUL OWNER, BART ENTERPRISES INTERNATIONAL, LTD.

requesting the suspension of the proceedings before the Trademark Trial and Appeal Board ("TTAB") until the resolution of the civil case Walter International Productions, Inc. et. al. v. Walter Mercado Salinas, et al., Civil No. 07-20136, before the United States District Court - Southern District of Florida, Miami Division (the "Florida District Court case").

3. On October 26, 2010, this TTAB granted said request and ordered the suspension of its proceedings pending the final determination of the Florida District Court case.

4. The Florida District Court case was appealed to the Eleventh Circuit Court of Appeals and they rendered their final decision on August 23, 2011, affirming the Florida District Court's decision.

5. Nonetheless, the Florida District Court's decision did not resolve the ownership issue of the "Walter Mercado" trademark. Therefore, another civil case was filed on 2009 in the District Court of Puerto Rico, by Walter Mercado Salinas and Astromundo, Inc., requesting the court to resolve, among others, the issue of ownership over the "Walter Mercado" trademark. See Mercado Salinas, et al. v. Walter International Productions, Inc. et. al., Civil No. 09-1509 (GAG-BJM), before the United States District Court

- Puerto Rico District (the "District Court of Puerto Rico case").

6. On October 28, 2011, the TTAB ordered the parties to inform of the status of the civil action which caused the suspension of this proceeding.

7. In compliance with said Order, Bart hereby informs the TTAB of the status of the civil case mentioned herein, the Florida District Court case, which has been finalized, as well as, the status of the second civil action that is currently pending concerning the registration of this Trademark application.

8. In the District Court of Puerto Rico case, a Preliminary Injunction was issued in favor of Bart on September 28, 2011 barring Mercado from using the "Walter Mercado" trademark in all of his business endeavors, except for the print and radio services he was providing when he assigned the trademark to Bart back in 1995.

9. This Order was appealed by plaintiffs in the case, Walter Mercado-Salinas and Astromundo, Inc., before the First Circuit Court of Appeals.

10. On November 3, 2011 oral arguments for the appeal pending before the First Circuit Court of Appeals were heard.

11. Within the District Court of Puerto Rico proceedings, dispositive motions for the case were filed by both parties on August 10, 2011. In these motions the major theme is the ownership of the trademark.

12. Additionally, parties have filed oppositions and replies to their respective dispositive motions.

13. The District Court of Puerto Rico and the First Circuit Court of Appeals have yet to enter judgments deciding any of the issues presented in the case, including the trademark ownership issue regarding the "Walter Mercado" trademark. Hence, there is not a final determination in the case herein mentioned. Attached is the docket report for Civil Case No. 09-1509. As can be seen, to this date, there are numerous issues pending before the Court.

WHEREFORE, Opposer respectfully requests that the Trademark Trial and Appeal Board take notice of the above mentioned, and continue the suspension of the proceedings until a final judgment has been entered in the Civil Case No. 09-1509.

I HEREBY CERTIFY that on this same date a true and exact copy of the foregoing Motion has been sent by e-mail and by First Class Mail to: Néstor Méndez Gómez, Esq., María D. Bertólez Elvira, Esq., and María Dolores Trelles



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.