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

Proceeding	92045212
Party	Defendant Blue Marlin Blue Marlin 540 Florida Street San Francisco, CA 94110
Correspondence Address	Blue Marlin 540 Florida Street San Francisco, CA 94110
Submission	Motion to Suspend for Civil Action
Filer's Name	Maame A.F. Ewusi-Mensah
Filer's e-mail	mewusimensah@mofo.com, jleetaylor@mofo.com
Signature	/Maame A.F. Ewusi-Mensah/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DONNA KARAN INTERNATIONAL INC.,

Petitioner,

vs.

BLUE MARLIN CORP.,

Registrant.

Cancellation No.: 92,045,212

Registration No.: 2,656,473

BOX TTAB NO FEE

Commissioner for Trademarks

P.O. Box 1451

Arlington, VA 22313-1451

MOTION TO SUSPEND PROCEEDINGS PENDING OUTCOME OF CIVIL ACTION

Registrant Blue Marlin Corp. ("Blue Marlin") hereby requests that the Board suspend this cancellation proceeding pending the decision of the Federal District Court for the Northern District of California in *Blue Marlin Corp. v. Donna Karan International, Inc.*, Case No. 05-2376 MMC(JCS). Because the civil action involves the same parties, the same mark, and the same issues as this cancellation proceeding, Blue Marlin respectfully requests that this cancellation proceeding be suspended pending the outcome of the civil action. *See* TBMP §510.02(a); 37 C.F.R. §2.117(a).

I. Background

Blue Marlin, the Registrant in this cancellation proceeding, and Donna Karan International Inc. ("DKI"), the Petitioner in this cancellation proceeding, are already involved in a civil action in federal district court which will resolve the issues that are at the heart of this cancellation. On June 10, 2005, Blue Marlin filed a civil action in the Federal District Court for the Northern District of California, alleging, *inter alia*, federal trademark infringement of its

registered Five Star Mark (Registration No. 2,656,473). Attached hereto as **Exhibit A** is a copy of the Complaint as filed.

On November 30, 2005, DKI filed an Answer and Counterclaim in the civil action. Attached hereto as **Exhibit B** is a copy of the Answer and Counterclaim as filed. In its Counterclaim for Relief, DKI seeks a declaration from the court that Blue Marlin's registration for the Five Star Mark is "invalid and unenforceable." On the same day, DKI filed its Petition for Cancellation before the Board seeking cancellation of the Five Star Mark on the ground that it is invalid.

II. Argument

Suspension of this cancellation pending the outcome of the civil action is prudent because the civil action involves issues in common with this cancellation. *See* TBMP §510.02(a); 37 C.F.R. §2.117(a) ("Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding."). As the Board has explained on numerous occasions, the decision of the federal district court will be binding upon the Board, whereas the decision of the Board will not be binding upon the Federal District Court. *See* TBMP §510.02(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992) ("Petitioner's motion to suspend proceedings is well taken. A decision by the district court will be dispositive of the issues before the Board. Petitioner's motion to suspend proceedings is granted."); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689, 692 (TTAB 1975), *rev'd* on other grounds, 549 F.2d 785, 193 USPQ 149 (CCPA 1977) ("Applicant is advised that while the decision of the Federal District Court would be binding upon the Patent and Trademark Office, a decision by the Board would not be binding or *res judicata* as to the issues before the court."). Accordingly, to permit the Federal District Court to

decide the issues first is efficient and permits the Board to avoid wasted time and effort in deciding issues that will ultimately be decided in court.

This case is appropriate for suspension because DKI's allegations in its Petition for Cancellation are identical to those in its Counterclaim, and even set forth in precisely the same language, as demonstrated in the chart below:

Allegation¹	Alleged in Petition	Alleged in Counterclaim²
Graphic designs are commonly used in the apparel industry as ornamentation.	Paragraph 1	Paragraph 66
"[S]ingle and multiple star configurations are commonly used as ornamentation on apparel"	Paragraph 2	Paragraph 67
On its apparel, DKI uses source identifying brand indicia along with graphic designs used as ornamentation.	Paragraph 3	Paragraph 66
Blue Marlin does not "use the [Five Star Design Mark] as a trademark or source identifying indicia of any type."	Paragraph 4	Paragraph 68
The Five Star Design Mark "is not inherently distinctive, has not acquired secondary meaning, and does not, under any circumstance, function as a trademark."	Paragraph 4	Paragraph 69
Blue Marlin uses its Five Star Design Mark "only as ornamentation," and neither the public or the trade uniquely associate the Mark with Blue Marlin or its goods.	Paragraph 5	Paragraph 70

¹ Direct quotations are from the Petition.

² Exhibit B.

Allegation¹	Alleged in Petition	Alleged in Counterclaim²
The specimen of use filed for the Five Star Design Mark is unacceptable and does not match the drawing of the mark in the registration.	Paragraphs 6-7	Paragraph 71
Blue Marlin “seeks to monopolize all uses of star design ornamentation on clothing and accessories.”	Paragraph 8	Paragraph 73
It is in the interest of the public to preclude registration of merely ornamental designs.	Paragraph 8	Paragraph 72

As demonstrated above, the civil action involves issues that directly overlap with those in this cancellation. In fact, there are no matters to be decided in this cancellation proceeding that are not at issue in the civil action. Because the decision of the Federal District Court with respect to the validity of the registration Five Star Mark and the question of whether Blue Marlin is misusing the Five Star Mark to “monopolize” certain ornamental designs will be binding on the Board, the Board’s policy in such cases dictates that this proceeding be suspended. *See* TBMP 510.02(a). Suspension is particularly appropriate here where no action has been taken by the parties in the cancellation, the Board has yet taken no action in the cancellation proceeding (besides the setting of the schedule), and there are no other motions pending before the Board.

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