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

Proceeding	92047910
Party	Plaintiff RobertoNoble
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Submission	Motion to Suspend for Civil Action
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Date	03/03/2008
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application  
Registration No. 2,490,999  
for the mark BONGOS CUBAN CAFE

-----X  
ROBERTO NOBLE, an individual :  
 :  
 :  
 Petitioner, :  
 : Cancellation No. 92,047,910  
 :  
 v. :  
 :  
 :  
 ESTEFAN ENTERPRISES, INC. :  
 :  
 :  
 Registrant. :  
-----X

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

Petitioner, 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 29<sup>th</sup>, 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 29<sup>th</sup>, 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.”

Petitioner 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 Petitioner has conferred with counsel for Registrant 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 3<sup>rd</sup> day of March, 2008, by first class mail to Karen L. Stetson, Esq., P.O. Box 403023, Miami, Florida and TTAB.

Respectfully submitted,

SANTUCCI, PRIORE & LONG, LLP  
Attorneys for Petitioner  
500 West Cypress Creek Road, Suite 500  
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By: /s/Michael I. Santucci  
Michael I. Santucci, Esq.  
Florida Bar Number: 0105260

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

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

06-81036

CASE NO.

CIV-RYSKAMP

MAGISTRATE JUDGE  
VITUNAC

Plaintiff,

vs.

ESTEFAN ENTERPRISES, INC.  
a Florida corporation,

Defendant.

FILED BY \_\_\_\_\_  
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**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

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