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

Proceeding	92047910
Party	Defendant Estefan Enterprises, Inc.
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Attachments	BCC Cancelaltion Response to Motion to Suspend.pdf (5 pages)(25671 bytes) Marrero Scheduling Order.pdf (4 pages)(109472 bytes) BCC Petition Ex B to Response to Motion to Suspend.pdf (2 pages)(71608 bytes) Marrero Motion for voluntary dismissal FINAL.pdf (18 pages)(90215 bytes)

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

Cancellation No. 92047910

ROBERTO NOBLE,

Petitioner,

vs.

ESTEFAN ENTERPRISES, INC.,

Registrant.

_____/

REGISTRANT EEI'S RESPONSE TO NOBLE'S
MOTION TO SUSPEND PROCEEDINGS

Registrant, Estefan Enterprises, Inc. ("EEI"), hereby files its response in opposition to Noble's Motion to Suspend and states as follows:

Seven (7) months after filing the instant cancellation proceeding, Noble has suddenly brought to the Board's attention the pendency of the *Marrero* action -- an action filed by the same counsel in November, 2006 on behalf of Noble's purported licensee, Marrero Enterprises of Palm Beach, Inc., in the United States District Court for the Southern District of Florida. At the time Noble filed the instant cancellation proceeding, the *Marrero* action had already been pending for nine (9) months, yet no notice of pendency of related action was filed when this proceeding was instituted by Noble despite the fact that the *Marrero* action was clearly known ¶¶ 8 and 9 of to Noble.

First and foremost, contrary to Noble's representation, there is no cancellation proceeding pending in the *Marrero* action. See Complaint attached as Exhibit A to Noble's Motion to Suspend. The *Marrero* action involves a claim by Marrero "solely for a declaratory judgment of non-infringement" between COCO BONGO as a trademark

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and EEI's BONGOS CUBAN CAFE trademark (see ¶ 3 of Complaint for Declaratory Relief attached as Exhibit A to Noble's Motion to Suspend) and a counterclaim asserted by EEI against Marrero and Noble for infringement of EEI's BONGOS CUBAN CAFE mark (see Counterclaim attached as Exhibit B to Noble's Motion to Suspend). As the Board can see from the Declaratory Complaint, there is no claim for cancellation in the *Marrero* action. In fact, now that the *Marrero* action has been pending almost a year and a half and the Court's deadline of April 30, 2007 to amend pleadings has long passed (see Exhibit A hereto), Noble and Marrero have sought leave to amend the Declaratory Complaint to include a claim for cancellation (see Motion for Leave at ¶¶ 8 and 9 attached hereto as Exhibit B). That motion has not even been briefed, let alone granted, and it is unlikely to be given the Court's deadline for amendments and the fact that the proposed amendments are not based on anything new. The point being that there is no claim for cancellation pending in the *Marrero* action as misrepresented to the Board.

This action would be entirely superfluous if the issues raised herein were already to be determined in the *Marrero* action, as Noble now claims. Curiously, Noble does not attempt to explain this obvious inconsistency in his Motion to Suspend. What is also curious, is the timing of Noble's Motion to Suspend. The *Marrero* action was filed a year and a half ago, purportedly to protect Marrero's right to use "Coco Bongo" as the name of its nightclub. Ten months thereafter, Marrero changed the name of its nightclub, thereby mooting the *Marrero* action. Now that EEI has filed a Motion for Voluntary Dismissal to end the *Marrero* litigation based on the name change (see Exhibit C hereto), Noble suddenly seeks to have this proceeding and a ruling on EEI's fully briefed and pending Motion to Dismiss delayed.

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EEI has filed a dispositive Motion to Dismiss,[1] which has been fully briefed since January 7, 2008 based on the procedural deficiencies of Noble's cancellation proceeding, namely, that any claim that EEI's mark is merely descriptive has long since been waived by Noble's failure to assert that claim as a compulsory counterclaim in the ongoing Consolidated Proceedings No. 91121980 between the parties, and is barred by the 5-year statute of limitations for such claims. In addition, EEI's Motion to Dismiss as to the fraud claim is based on the fact that there was no petition or counterclaim to cancel EEI's mark filed by anyone either at the time of the incontestability declaration filed on January 31, 2007 or at any time during the five years after registration as evidenced by Noble's own description of pending actions set forth in his petition herein.

The filing of this Motion to Suspend was clearly intended to prevent the Board from ruling on EEI's Motion to Dismiss. Pursuant to TBMP § 510.02:

> [i]f there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.

This case is an even more compelling example of an attempt to evade a dispositive ruling than the example set forth in the Board's Rule, where the so-called "similar action" was already pending at the time this case was filed, yet no notice of pendency was filed until many months thereafter and only after a dispositive motion was filed and fully briefed.

[1] On November 15, 2007, the Board suspended these proceedings pending disposition of EEI's motion to dismiss pursuant to Trademark Rule 2.127(d). Per the Board's Order, "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration." Therefore, for this reason alone, the Board should not consider Noble's Motion to Suspend.

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The issue of whether this cancellation proceeding is, therefore, properly brought before the Board, as set forth in EEI's pending Motion to Dismiss is not before the Court in the *Marrero* action. Noble was recently joined as a necessary party to the *Marrero* action and has not yet filed an answer. EEI does not want this proceeding hanging like a cloud over its registration until such time as the *Marrero* case is determined.

There is no cancellation claim pending in the *Marrero* action and unlike the *Marrero* action, Noble's cancellation proceeding herein does not involve the issue of likelihood of confusion. Indeed, there are no allegations of any damage caused by EEI's registration to Noble to even support a cancellation pleading. Therefore, it is futile for the Board to suspend the proceedings herein and defer ruling on EEI's dispositive Motion to Dismiss until the determination of the *Marrero* action.

As Noble has indicated in its Motion to Suspend, the Board has recently suspended Consolidated Proceedings No. 91121980 pending the outcome of the *Marrero* action which EEI brought to the Board's attention. Unlike here, the Consolidated Proceedings and the *Marrero* action raise the same issues, namely the likelihood of confusion between the parties' respective marks.

WHEREFORE, Registrant, Estefan Enterprises, Inc., respectfully requests that the Board deny Noble's Motion to Suspend Proceedings.

Respectfully submitted,

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