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

Proceeding	92057267
Party	Defendant Minitub GMBH
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Submission	Motion to Suspend for Civil Action
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Signature	/James H. Johnson, Jr./
Date	07/29/2013
Attachments	Motion to Suspend - ANDROSTAR.pdf(4640319 bytes)

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

Minitube of America, Inc.,

Petitioner,

v.

Minitub GmbH,

Registrant.

E-FILING

Cancellation No. : 92057267
In re Registration No. : 2,493,812
For the Mark : ANDROSTAR
Registered on : October 2, 2001

REGISTRANT'S MOTION TO SUSPEND PROCEEDINGS

In the matter of the above-identified Cancellation No. 92057267, Minitub GmbH ("Registrant") hereby moves the Trademark Trial and Appeal Board to suspend the cancellation proceeding against Registrant pursuant to 37 C.F.R. § 2.117(a) in light of a civil action now pending between the parties.

SUMMARY OF FACTS

On June 14, 2013, Petitioner filed a civil action against Registrant in the United States District Court for the Eastern District of Wisconsin. The civil action asserts claims of common law trademark infringement and federal and state law unfair competition. The civil action is docketed as Civil Action No. 2:13-cv-00685 AEG, and a file-stamped copy of the Complaint is attached hereto as Exhibit A.

ARGUMENT

Pursuant to Trademark Rule 2.117(a), the Trademark Trial and Appeal Board may suspend proceedings pending before the Board when the parties are involved in a civil action that

may have a bearing upon the Board proceeding. Indeed, the Board will ordinarily suspend proceedings when a civil action for trademark infringement is pending between the parties. *See TBMP* § 510.02(a) (citing, *inter alia*, *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974)).

The civil action now pending before the United States District Court for the Eastern District of Wisconsin involves issues in common with the instant opposition proceeding. Specifically, Petitioner alleges in the federal complaint that the mark at issue in this cancellation proceeding, ANDROSTAR, belongs to Petitioner. Petitioner further alleges that Registrant's use of the mark amounts to infringement, false advertising under the Lanham Act, false marketing under Wisconsin statutory law and unfair competition under common law. All of these claims rely on a finding that Petitioner, not the Registrant, is the proper owner of the ANDROSTAR mark (which it is not). Petitioner's allegations of priority and claims for trademark infringement overlap with and have a clear bearing upon Petitioner's allegations in the cancellation proceeding, and the United States District Court's decision in the civil action may be binding upon the Trademark Trial and Appeal Board. *See e.g. Danskin, Inc. v. Dan River, Inc.*, 182 USPQ 370, 372 (CCPA 1974) (affirming the Board's decision granting summary judgment based upon disposition of a prior civil action).

WHEREFORE, Registrant respectfully requests that the Trademark Trial and Appeal Board order a suspension of the instant cancellation proceeding pending the outcome of the civil action in United States District Court for the Eastern District of Wisconsin.

Respectfully submitted,

SUTHERLAND ASBILL & BRENNAN LLP

Date: July 29, 2013,

By: /James H. Johnson/
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PROOF OF SERVICE
[F.R.C.P. Rule 5, F.R.A.P. 25]

I declare that I am employed in Atlanta, Georgia; I am over the age of 18 and am not a party to the above identified action; my business address is 999 Peachtree St., NE, Atlanta, GA 30309-3996. On the date set forth below, I served a true and accurate copy of the document(s) entitled: **REGISTRANT'S MOTION TO SUSPEND PROCEEDINGS** on the party(ies) in this action by placing said copy(ies) in a sealed envelope each addressed as follows:

Thomas P. Heneghan
Whyte Hirschboeck Dudek S.C.
P.O. Box 1379
Madison, Wisconsin 53701

[By First Class Mail] I am readily familiar with Sutherland Asbill & Brennan LLP's practice for collecting and processing documents for mailing with the United States Postal Service. On the date listed herein, following ordinary business practice, I served the within document(s), by placing a true copy thereof, enclosed in a sealed envelope, with postage thereon fully prepaid, for collection and mailing with the United States Postal Service where it would be deposited with the United States Postal Service that same day in the ordinary course of business.

[By Overnight Courier] I caused each envelope to be delivered by a commercial carrier service for overnight delivery to the offices of the addressee(s).

[By Hand] I directed each envelope to the party(ies) so designated on the service list to be delivered by courier this date.

[By Facsimile Transmission] I caused said document to be sent by facsimile transmission to the fax number indicated for the party(ies) listed above.

[By Electronic Transmission] I caused said document to be sent by electronic transmission to the e-mail address(es) indicated for the party(ies) listed above.

I declare under penalty of perjury that the foregoing is true and correct and that this declaration was executed this date at Atlanta, Ga.

Dated: July 29, 2013

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