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

Proceeding	92057267
Party	Plaintiff Minitube of America, Inc.
Correspondence Address	MELINDA S GIFTOS WHYTE HIRSCHBOECK DUDEK SC PO BOX 1379 MADISON, WI 53701-1379 UNITED STATES ptomailbox@whdlaw.com, mgiftos@whdlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Melinda S. Giftos
Filer's e-mail	mgiftos@whdlaw.com, ptomailbox@whdlaw.com
Signature	/Melinda S. Giftos/
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Attachments	Opposition to Motion to Suspend.pdf(9749 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.

PETITION TO CANCEL
Mark: ANDROSTAR
U.S. Reg. No. 2,493,812
Reg. Date: October 2, 2001

OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND

On July 29, 2013, Registrant Minitüb GmbH filed a Motion to Suspend the Proceedings in light of the civil action currently proceeding between the parties. Petitioner, Minitube of America, Inc., opposes the Motion to Suspend the Proceedings on the grounds that the claims in the civil action are different from those presented in this Cancellation proceeding and on the grounds that Registrant's motion will only cause undue delay.

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. TBMP § 510.02(a). Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board. *Id.*

In this case, however, the issues in the civil litigation and the Cancellation proceeding at hand are distinguishable. In its Petition to Cancel, Petitioner has alleged that Registrant obtained its registration for the ANDROSTAR mark by fraud and that it has never used the ANDROSTAR trademark in the United States.

In the civil action, Petitioner alleges that Registrant has engaged in patent infringement, false patent marking, trademark infringement, false advertising, fraudulent representations and

unfair competition in the United States relating to a variety of products and trademarks. However, there are no specific allegations that Registrant infringed upon Petitioner's ANDROSTAR mark. Instead, Petitioner informed the Court that this action is pending to provide background for Registrant's activities. Petitioner notified the Court that Registrant had obtained the registration for the ANDROSTAR mark based on fraud by filing false affidavits regarding their use of the mark.

The issues of non-use and fraud are not before the Court for determination of a specific claim regarding the validity of the ANDROSTAR mark. Further, the issues of non-use and fraud are distinguishable from the patent and trademark infringement claims that are alleged in the lawsuit in the District Court. The district court is therefore unlikely to resolve the issues currently before the Board in this Cancellation proceeding. Accordingly, Petitioner respectfully requests that the Board deny Registrant's Motion to Suspend the Proceedings.

Dated August 2, 2013.

Respectfully submitted,

s/Melinda S. Giftos

Melinda S. Giftos

Wisconsin State Bar No. 1056609

mgiftos@whdlaw.com

WHYTE HIRSCHBOECK DUDEK S.C.

PO Box 1379

Madison, WI 53701

(608) 234-6076 (telephone)

(608) 258-7138 (facsimile)

Attorney for Petitioner

MINITUBE OF AMERICA, INC.