

Exhibits

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

In the matter of
Trademark Registration Number 1,934,369

KCS-MIAMI, INC.)
Petitioners)

Cancellation No. 92,040,135

v.)

KENNETH C. GERWIT.)
Registrant.)

_____)

BOX TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**MOTION FOR EXTENSION OF TIME TO FILE RESPONSES
TO DISCOVERY OR, IN THE ALTERNATIVE, TO STAY PROCEEDINGS
PENDING RESOLUTION OF COURT ACTION AND SUPPORTING BRIEF**

Registrant in the above-identified cancellation proceeding, by and through its undersigned counsel, hereby moves to stay this proceeding pending the Southern District Court of Florida's ruling on Petitioner's Complaint against Registrant, and Registrant's counterclaim thereto, filed on February 20, 2002 and March 27, 2002 respectively (Case No. 02-CIV-20543, Southern District of Florida). The Counterclaim was subsequently amended by Registrant on April 16, 2002. In the alternative to staying this proceeding, the Registrant requests, that the Board, at a minimum stay discovery for a period of time not less than forty (40) days in order to

provide the Court sufficient time to reach a determination as to Petitioner's Motion for a Preliminary Injunction against Petitioner (Petitioner gave consent to a 15 day extension). In support of its motion, Registrant states as follows:

1. On November 28, 2001, Petitioner filed a Notice of Cancellation against Registrant in connection with its trademark registration for the trademark "BARBARA GERWIT."

2. The Notice of Cancellation alleged abandonment of the BARBARA GERWIT trademark.

3. Petitioner seeks cancellation of the BARBARA GERWIT trademark in order to proceed with its registration of the "THERAPY BY BARBARA GERWIT" trademark application, filed on February 8, 2001, with the United States Patent and Trademark Office.

4. Petitioner's application was barred due to the pre-existing BARBARA GERWIT mark as well as due to another pre-existing mark, THREAD THERAPY.

5. On February 2, 2002, Petitioner filed a Complaint against Registrant in the Southern District of Florida, alleging federal trademark infringement of its common law trademark rights, federal unfair competition, common law trademark infringement, common law unfair competition, violation of Florida Deceptive and Unfair Trade Practices Act and Tortious Interference with Business Relationships and seeking temporary and permanent injunctive relief.

See Exhibit A All claims against Registrant are dependent upon the Court finding that Registrant has no defendable or enforceable rights to its BARBARA GERWIT federal trademark registration as a result of its abandonment thereof.

6. On March 27, 2002, Registrant filed a Counterclaim against Petitioner alleging trademark infringement of its federally registered trademark, unfair competition and dilution, violation of Florida Deceptive and Unfair Trade Practices Act, Florida Statutory Unfair Competition, violation of Florida Dilution Statute, Common Law Trademark Infringement and Unfair Competition, Breach of Oral Contract and Defamation of Title. See Exhibit B. On April 16, 2002, the counterclaim was amended to add additional claims against counter-defendants.

7. All of the matters currently before the Southern District of Florida involve the validity and strength of Registrant's federal trademark rights that are being challenged in the subject cancellation action.

8. On April 22, 2002, a hearing was held on Petitioner's Motion for a Preliminary Injunction. These proceedings are still on going and the hearing is likely to be concluded in the next three weeks. In addition, both parties have already exchanged discovery in connection with currently pending civil litigation.

9. Pursuant to Trademark Rule 2.117(a), whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to appealing 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.

10. Because the issues before the District Court are nearly exclusively dependent upon a holding of the validity of Registrant's federal trademark registration, suspension of this proceeding is appropriate. Moreover, any decision of the District Court in connection with the parties' respective rights to the trademark at issue will be binding upon the Board in this present

action *Goya Foods, Inc. v. Tropicana Products, Inc.*, 846 F. 2d 848 (2nd Cir. 1988); and *TBMP Section 510.02(a)*. After the Court has had a chance to rule on the pending litigation, the TTAB can lift the stay and consider whether further action is necessary or appropriate. *T. E. Williams Pharms. of Ark., Inc. v. Trend Pharms., Inc.*, 2000 TTAB LEXIS 297 (Trademark Trial & App. Bd. Apr. 28, 2000)

11. There will be substantial discovery in the Court action involving warehouses full of documents. This discovery will be duplicated between the two actions and the burden in time and expense to the parties will be substantial.

12. Petitioner's pending motion for preliminary injunction creates a real and present danger that it will force Registrant to stop using his mark and therefore force a tacit abandonment where none was intended by Registrant.

Alternative request for 40 day extension of time

13. In the alternative to staying this action, Registrant requests that the Trademark Trial and Appeal Board at a minimum stay discovery for a period of at least forty (40) days. Permitting discovery to proceed between the parties would necessarily duplicate the efforts undertaken in connection with the pending civil action and would add to the expense of both parties, unduly adding to the injury incurred against the prevailing party. It is anticipated that within forty (40) days the District Court will decide the merits of Petitioner's Motion for a Preliminary Injunction against Registrant.

14. This constitutes a second extension of time. The previous extension was for twenty(20) days.

15. The documents in this case run into the tens of thousands and cover over 8 years of operation.

16. The documents are stored in a warehouse which has no electricity or air conditioning.

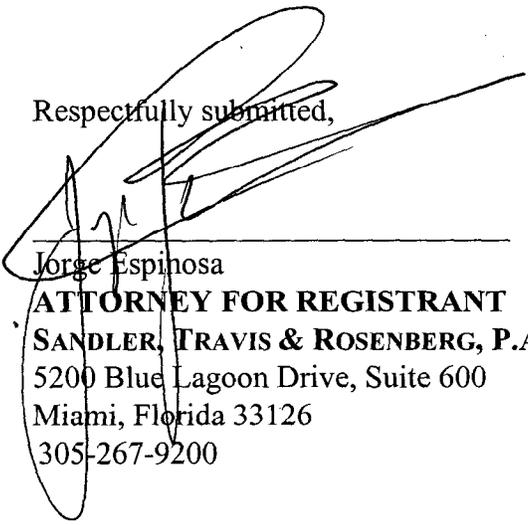
17. The review of the documents necessary for discovery is very difficult and time consuming.

18. A stay of this action, or alternatively a stay of discovery, will not prejudice Petitioner. Petitioner's rights to pursue its trademark application are not dependent upon cancellation of Registrant's mark, especially since there is another registration owned by a third party which has also been cited as a bar to registration of Petitioner's application. Staying this action , or at a minimum staying discovery, is appropriate under the circumstances presented here.

19. Registrant obtained the consent of opposing counsel for an extension of 15 days but not to the full extension requested in this motion and not to the stay.

WHEREFORE, Registrant Ken Gerwit requests that the Trademark Trial and Appeal Board stay this proceeding pending the Southern District Court's final determination as to Petitioner's Complaint against Registrant and Registrant's Counterclaim against Petition. In the alternative, Registrant respectfully requests that discovery be stayed for a period of time at least as long as forty (40) days.

Respectfully submitted,



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TTAB

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* NOT ADMITTED IN FL
▼ BOARD CERTIFIED INTERNATIONAL LAW

May 1, 2002



05-02-2002

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Clerk of the Court
United States Patent and Trademark Office
Trademark Trial and Appeal Board
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TRADEMARK TRIAL AND
APPEAL BOARD
02 MAY -9 AM 8:23

**RE: IN THE MATTER OF TRADEMARK REGISTRATION No.: 1,934,369
KCS-MIAMI, INC. PETITIONERS V. KENNETH C. GERWIT, REGISTRANT
CANCELLATION No.: 92,040,135
OUR FILE No. 018145**

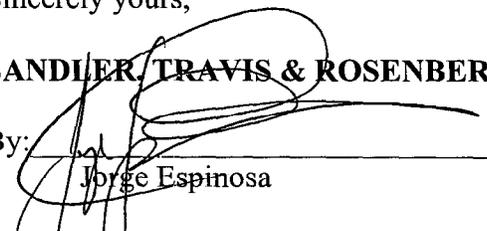
Dear Sir or Madame:

We are enclosing for filing in this action Registrant's Motion for Extension of Time to File Responses to Discovery or, in the alternative, To Stay Proceedings Pending Resolution of Court Action and Supporting Brief.

Should you have any questions, please do not hesitate to contact the undersigned.

Sincerely yours,

SANDLER, TRAVIS & ROSENBERG, P.A.

By: 
Jorge Espinosa

Enclosures

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