

ESTTA Tracking number: **ESTTA137013**

Filing date: **04/23/2007**

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

Proceeding	91121980
Party	Defendant ROBERT NOBLE & BONGO, S.A., DE C.V. ROBERT NOBLE & BONGO, S.A., DE C.V. ,
Correspondence Address	MICHAEL I. SANTUCCI SILVERMAN SANTUCCI, LLP 500 WEST CYPRESS CREEK ROAD, SUITE 500 FORT LAUDERDALE, FL 33309 UNITED STATES MIS@500Law.com
Submission	Other Motions/Papers
Filer's Name	Michael I. Santucci, Esq.
Filer's e-mail	mis@500law.com, sandra@500law.com
Signature	/Michael I. Santucci, Esq/
Date	04/23/2007
Attachments	Response to Motion to Preclude Discovery.pdf (9 pages)(128051 bytes) Exhibits to Def. Resp to MT Preclude Documents.pdf (21 pages)(649254 bytes))

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

ESTEFAN ENTERPRISES, INC.

Petitioner/Opposer,

Opposition No.: 91121980
Cancellation No.: 92042251

vs.

BONGO, S.A. de C.V. and ROBERTO NOBLE,

Registrant/Applicant.

**DEFENDANTS' RESPONSE TO EEI'S MOTION TO PRECLUDE LATE PRODUCED
DOCUMENTS FROM USE AT TRIAL¹**

COMES NOW, BONGO, S.A. de C.V. ("BSA") and its successor-in-interest, Registrant/Applicant ROBERTO NOBLE ("NOBLE")(collectively "Defendants"), by and through the undersigned counsel, and hereby respond to, and respectfully request the Board to deny Petitioner/Opposer ESTEFAN ENTERPRISES, INC.'s ("Plaintiff") Motion to Preclude Late Produced Documents from Use at Trial ("Motion to Preclude" and "Motion")(Opposition Docket #110).

INTRODUCTION

On March 21, 2007, the Board suspended these proceedings pending resolution of Plaintiff's Motion for Leave to File Second Amended Petition to Cancel (*Dkt#103*) and Motion to Preclude Testimony (*Dkt#104*) and held that: "*Any paper filed during the pendency of these motions which is not relevant thereto will be given no consideration.*" Two (2) weeks later, on April 3, 2007, Plaintiff nonetheless filed a Motion to Preclude Late Produced Documents (*Dkt#110*). Plaintiff was either unaware of the suspension, willfully disregarded same, or in some way believes that its Motion is relevant to the motion for leave and/or previously filed motion to preclude. To date, Plaintiff has not withdrawn its Motion to Preclude Late Produced Documents

¹ Defendant is operating under the undersigned's understanding relative to page limits as set forth in its Unopposed Motion for Clarification and/or Motion for Leave to File Twelve (12) Page Response (*Dkt#111*), and reasserts the requests for relief set forth therein for purposes of this Response.

from Use at Trial (*Dkt#110*), despite its counsel's admitted review of the TTAB Docket sometime between April 5th and April 16, 2007 (see *Exhibit "G"* hereto). In an abundance of caution, in the event this Board reads, considers or adjudicates the Motion to Preclude (*Dkt#110*), Defendant hereby files the herein Response and Exhibits thereto in opposition to said Motion, and in support of its request that said motion be denied with prejudice, and that Plaintiff be further sanctioned for its unauthorized and substantively frivolous Motion to Preclude which has further complicated and delayed these proceedings.

STATEMENT OF MATERIAL FACTS

On May 2, 2000, U.S. Registration Number 2,347,247 for the mark **COCO BONGO** issued under § 44 (e) of the Lanham Act without opposition. On February 13, 2001, Plaintiff filed a Notice of Opposition to Application Serial Number 75/767,732. (*Opposition Docket #1*). More than three (3) years later, Plaintiff filed its Petition to Cancel Registration Number 2,347,247 in the subject action on June 20, 2003. (*Cancellation, Docket #1*). The Petition to Cancel, and Notice of Opposition, were consolidated on April 13, 2004. (*Opposition Docket #24*). On April 24, 2005, all of the interest in the subject marks, registration and application were assigned to NOBLE. BSA no longer has an interest in these proceedings.² The assignment was recorded with the U.S.P.T.O. back on May 10, 2005. Plaintiff served its *first* set of written discovery requests on NOBLE on Friday, August 25, 2007, and were not received until *a day or two prior to the scheduled close of discovery*. On September 13, 2006, this Board suspended these consolidated proceedings pending resolution of various motions including Defendants' Motion for Protective Order relative to the last-minute discovery requests.

On September 19, 2006, Marrero Enterprises of Palm Beach, Inc. ("Marrero"), the owner of a Florida nightclub assigned all right title and interest to the marks COCO, BONGO, BONGOS, COCO BONGOS and COCO BONGO to NOBLE. NOBLE, by counsel, received the fully executed assignment documents on September 25, 2006. On January 11, 2007, this Board

² BSA is neither an applicant, nor a registrant in these proceedings, and has not been for almost two years.

lifted the suspension and ordered that the parties serve various documents and other discovery responses on each other by February 12, 2007. The assignment from Marrero, as well as the agreement between Marrero and NOBLE (Bates #1055-1056 and 1066-1081) were produced by Defendant NOBLE to Plaintiff well in advance of the Board's deadline, on January 18, 2007.³

Last week, Defendant NOBLE executed a final agreement with a major hotel chain in Las Vegas for its newest location for its show and nightclub in Las Vegas, Nevada. In answers to the first set of interrogatories served on him and at his recent deposition, NOBLE testified as to the steps he and/or his agents and affiliates have taken in connection with the Las Vegas project in compliance with the Board's January 11, 2007 Order. NOBLE went beyond the requirements of the Board's Order and disclosed drafts of these contracts with the hotel chain to Plaintiff at his recent deposition. NOBLE intends to produce more documents to Plaintiff in these proceedings as they become available, and as future documents are generated relative to his new and ongoing projects relative to his **COCO BONGO** marks if Plaintiff continues to question his use of, and intentions relative to, his **COCO BONGO** marks in the United States.

RESPONSE AND ARGUMENT

1. Plaintiff has not in any way objected to the use of the subject documents at trial because on their relevance or materiality. Defendants will therefore not address these issues, but hereby reserve the right to explain why the questioned documents are material and relevant if the Board so requires.

2. In its Motion to Preclude Late Produced Documents from Use at Trial (*Dkt. #110, p. 4*), Plaintiff alleges that after receiving documents Bates Nos. 1–470 on January 20, 2005, it never received any documents from Defendants until documents Bates Nos. 1055–1065 were produced on January 22, 2007, which was when Plaintiff first mentioned that its recollection was that a large gap in the Bates numbering existed. (For the Board's convenience, a table of the

³ See email from the undersigned to Karen Stetson accompanying Bates Nos. 1055-1081 attached as .pdf files attached as *Exhibit "K"* hereto.

questioned documents was prepared by the undersigned firm, and is attached hereto as *Exhibit “A.”* It summarizes the respective parties’ positions relative to the production of each grouping or numerical series of Bates numbered documents).

3. Contrary to Plaintiff’s recollection, Documents Bates Nos. 471–1054 were produced to Plaintiff in 2005. First, Plaintiff inspected the documents in Cancun on or about September 3, 2005. After counsel returned to the United States, the documents were copied, Bates numbered, and produced by Defendant BSA to Plaintiff. The e-mail to Plaintiff, dated September 7, 2005, demonstrates these facts, which were never disputed by Plaintiff until very recently. (See *Exhibit “B”* attached hereto).⁴

4. Defendants even attached many of those questioned documents to the Declaration of Isaac Halabe filed with their Memorandum of Law in Opposition to Motion for Summary Judgment on September 30, 2005 (*Dkt #47, 48, and 49*), as part of Exhibits B, C, D, and E thereto (Bates No. 473–477, 481–482, 505–506, 508–531, 542–638). The documents attached to the Declaration were Bates numbered as indicated above, and Plaintiff did not mention any gaps in numbering at that time, as it has now for the first time after the close of discovery.

5. The documents Bates Nos. 1039–1054 were produced to Plaintiff on September 15, 2005. (See letter dated September 15, 2005, attached hereto as *Exhibit “C”*.)

6. In its Motion to Preclude, Plaintiff alleges that it did not receive the documents until “...on March 13, 2007, documents bearing bates numbers 471 through 1083 were suddenly produced.” However, Plaintiff itself attached document Bates No. 1044 to its Supplement to Motion for Summary Judgment dated September 27th, 2005 (*Docket #46*) as Plaintiff’s Exhibit “B,” bearing Defendants’ Bates No. 1044. Plaintiff would not have been able to attach this Bates numbered document, if the document, so numbered, had not been already produced by that time. (See Plaintiff’s Exhibit “B,” attached hereto as *Exhibit “D”*).

⁴ A settlement communication was retracted from this exhibit.

7. The Plaintiff has even stated in its Supplement to its Motion for Summary Judgment on p. 5, that “EEI has procured additional evidence at Registrant’s Cancun nightclub...” referring to its own Exhibit “B” thereto, but also indirectly to all documents produced as per the above-mentioned e-mail (See, *Exhibit “B”*). Plaintiff’s use of, and reference to, some of these questioned documents long ago, if nothing else, calls into question the credibility of Plaintiff’s entire cry of foul as to the alleged “late” production of documents.

8. In Paragraph 9 of Plaintiff’s Motion, Plaintiff conveniently omitted the fact that the many of the documents were generated by third parties and were not in Defendants’ possession until the week they were produced to Plaintiff (i.e. - after the deposition of NOBLE)(e.g. – Bates Nos. 1529-1603, 1610-1634 and 1645-1652). The documents of Bates Nos. 1055-1056; 1493-1494 are a license agreement and assignment which did not exist prior to August 2006 and September 2006 respectively. As the undersigned stated in his email to Plaintiff’s counsel, COCO BONGO is a living, breathing business and brand. New, relevant documents will be generated as events occur, as the brand grows and as circumstances change.

9. Contrary to Plaintiff’s express statement to the contrary⁵ the undersigned absolutely made offers to Plaintiff’s counsel to inspect the documents being produced, including originals, in advance of deposition, and in advance of the documents being copied both in the United States and in Mexico. (See emails to Karen Stetson dated September 7, 2005 and February 12, 2007 attached hereto as *Exhibits “B”* and *“E”* respectively). Plaintiff failed to seize these opportunities in the U.S. and Mexico. In Mexico in March of 2007, Plaintiff’s counsel did not arrive at Defendants’ offices early to inspect documents as agreed and scheduled. Instead, Plaintiff’s counsel arrived at the March 1st deposition shortly before its scheduled time and brought two attorneys with her to inspect the documents during the deposition, instead of before the deposition as agreed. (See *Exhibit “F”* hereto). Any claims of prejudice in not having an opportunity to inspect documents prior to NOBLE’s deposition are the fault of Plaintiff’s lack of

⁵ Paragraph 5 of Plaintiff’s Motion to Preclude (Dkt#110).

diligence and are factually false. Upon conclusion of the deposition, the undersigned left the very large oversized box of documents and books for Plaintiff's counsel, and attempted to walk counsel into other parts of the office and business to inspect documents, fliers, signs, displays and other items which could not have been moved into the deposition room. However, all three (3) of Plaintiff's attorneys quickly hurried out of the building and chose not to inspect, examine or photograph the additional documents and items. Plaintiff's statements as to which documents and things were produced in Mexico lack credibility and personal knowledge.

10. Another glaring fact also renders highly questionable, Plaintiff's counsel's continued complaints regarding her firm's allegations of not receiving documents and pleadings. Plaintiff's counsel has however been taking such complaints much further, and has repeatedly made accusations of wrongdoing on the part of the undersigned firm, has even implied that the undersigned has intentionally not mailed documents and pleadings, and has obtained several good faith extensions of time and concessions as a result of these claims of never receiving mailings. (See, *Exhibit "G"* attached hereto). However, recent discoveries point heavily to a finding that any failure by Plaintiff to receive mailed documents, if even true, are the fault of no one but Plaintiff's own counsel. As the two separate attached U.S.P.T.O. records⁶ show, Plaintiff's counsel has failed to properly maintain a valid post office box, which she relies upon as her sole mailing address in these proceedings. (See, *Exhibits "H" and "I"* attached hereto). Evident therefrom, the U.S. Post Office showed that Plaintiff's counsel's post office box was closed at least as of March 24, 2007, and was unable to return at least two pieces of mail to sender. One can only imagine how many other claims by Plaintiff of not receiving documents throughout these proceedings can be explained by the closure, failure to maintain, or failure to pay bills to the company which operates the post office box.

11. Most recently, on April 16, 2007, Plaintiff's counsel claimed to have never received Defendants' Response to Plaintiff's Motion to Preclude Late Disclosed Witnesses

⁶ Dkt #108 in these proceedings, and Dkt # 9, in TTAB Opposition #91174160.

(*Dkt#112*). (See, email from Karen Stetson attached as *Exhibit "G"* hereto). However, attorney Stetson certainly had notice of the Response (which was served on April 5th) as early as April 9th, when she makes comments relative thereto in her email to the undersigned (see, *Exhibit "J"* attached hereto). However, a full week later, on April 16, 2007, Ms. Stetson alleged for the first time, that she did not receive the Response by mail as per the Certificate of Service. Plaintiff's claims of not having received documents simply cannot be trusted.

12. Finally, all of Plaintiff's general arguments relative to the timing of production of the subject documents have been rendered moot by its own filing of its battery of questionably timed motions on the eve of its trial period.⁷ The recent suspension of these proceedings has helped to cause yet another rescheduling of NOBLE's licensed opening of COCO BONGO in Las Vegas, which has just last week been rescheduled for February of 2008. Plaintiff's Motion to Preclude Late Produced Documents, at this time, has the effect of a further delay of these proceedings and/or is a desperate attempt to preclude key documents, such as the recent assignment of rights from Marrero, and other evidence of NOBLE's use or license of the subject marks in the United States. In Paragraph 10 of its Motion, Plaintiff claims prejudice resulting from the fact that the discovery period has closed. However, Plaintiff itself can be blamed for the alleged prejudice for its decision to wait until days before the close of discovery to first seek documents from Defendant NOBLE. Although Plaintiff keeps describing NOBLE's Motion for Protective Order (*Dkt#94*) as "baseless," that motion forecasted the very problems about which Plaintiff has been complaining in its numerous recent motions. Even if produced the day the

⁷ The recent discovery that Plaintiff's counsel's post office box was closed when this Board mailed the order suspending these proceedings creates a question of whether Plaintiff or its counsel was even aware of the suspension at the time it filed its Motion to Preclude Late Disclosed Documents which was filed despite the suspension order issued two (2) weeks prior thereto. Plaintiff's motive to file yet another motion which in its possible view would have the probable effect of suspension of proceedings can be questioned then even as to its Motion to Preclude Late Disclosed Documents (*Dkt#110*). Even prior to the suspension, Plaintiff did not schedule a single testimony deposition. The arguments relative to Plaintiff's motive for filing its various motions recently set forth in Defendants' Response to Motion to Preclude Late Disclosed Witnesses (*Dkt#112*) are hereby incorporated by reference herein).

Request to Produce was received, there would be no time to arrange for depositions of any new witnesses.

WHEREFORE, Defendants BSA and Registrant/Applicant NOBLE respectfully request the Board deny Plaintiff's Motion to Preclude Late Disclosed Documents From Use At Trial in its entirety with prejudice and further sanction Plaintiff for its frivolous and unauthorized application to this Board despite prior admonitions. Furthermore Defendants request that any reply hereto attempted by Plaintiff (which is its common practice), be stricken and ignored unless leave is sought for good cause shown.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing document was served on Karen L. Stetson, Esquire, by regular mail to P.O. Box 403023, Miami, Florida 33140 on this 23rd day of April, 2007.

Law Offices of
SILVERMAN SANTUCCI, LLP
Attorneys for Registrant
500 West Cypress Creek Road, Suite 500
Fort Lauderdale, Florida 33309
Phone: (954) 351-7474/Fax: (954) 351-7475
MIS@500Law.com

By: s/Michael I. Santucci
Michael I. Santucci, Esquire
Florida Bar Number: 0105260

Exhibits:

Exhibit "A" - Table of the questioned documents prepared by the undersigned firm;

Exhibit "B" - E-mail to Plaintiff dated September 7, 2005;

Exhibit "C" - Letter dated September 15, 2005, regarding documents Bates Nos. 1039 – 1054;

Exhibit "D" - Plaintiff's Exhibit "B" to its Supplement to Motion for Summary Judgment dated September 27th, 2005 (*Docket #46*);

Exhibit "E" – E-mail to Karen Stetson dated February 12, 2007;

Exhibit "F" – E-mail from Michael Santucci dated March 1, 2007;

Exhibit "G" - E-mail from Karen Stetson dated April 16, 2007;

Exhibits "H" and *"I"* - U.S.P.T.O. records of Plaintiff's undeliverable;

Exhibit "J" – E-Mail from Karen Stetson dated April 9, 2007;

Exhibit "K" – E-mail from Michael Santucci dated January 18, 2007.

<u>DOCS. BATES #</u>	<u>DEFENDANTS' POSITION</u>	<u>PLAINTIFF'S POSITION</u>
1 – 469 ✓	Produced on January 20, 2005 with a cover letter responsive to Plaintiff's First Request for Production of Documents to Defendant.	Produced in response to EEI's initial document requests on 1/20/05 (as per EEI'S Motion to Preclude Documents, ¶1)
470 ✓	DVD – See E-mail to Stetson dated 9/9/05, which clarifies the Bates No. for a DVD sent to Stetson.	Produced on January 20, 2005 (as per EEI'S Motion to Preclude Documents, ¶11a).
471 – 1065	<p>473 – 477 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit B and Exhibit C.</p> <p>481 – 482 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit B and Exhibit C.</p> <p>505 – 506 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit B and Exhibit C.</p> <p>508 – 520 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit D.</p> <p>521 – 531 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit B, Exhibit C, and Exhibit E.</p> <p>542 – 638 - Attached to Declaration of Issac Halabe in support of BSA's Memo of Law in Opposition to Motion for Summary Judgment dated 9-30-05 as Exhibit B, Exhibit C</p> <p>1039 – 1054 - Produced 9/15/05 as per letter.</p> <p>1044 – Attached to EEI's Supplement to Motion for Summary Judgment dated September 27, 2005 as Exhibit B.</p>	Produced on 3/13/07 (as per EEI'S Motion to Preclude Documents, ¶8).

EXHIBIT "A"

1055 - 1065	<p>E-mailed to Plaintiff on 1/18/07 (Meredith Frank's email copy bounced back); Mailed to Plaintiff on 1/22/07 with a letter.</p> <p>1055-1056 – September 19, 2007 Assignment from Marrero.</p> <p>1057-1065 – August 24, 2006 Agreement between NOBLE and Coco Bongos, LLC</p>	<p>Produced on 1/22/07 (as per EEI'S Motion to Preclude Documents, ¶11 a).</p> <p>Produced in advance of Noble's Deposition (as per EEI'S Motion to Preclude Documents, ¶5).</p>
1066 - 1238	<p>E-mailed to Plaintiff on 1/18/07 (Meredith Frank's email copy bounced back); Mailed to Plaintiff on 1/22/07 with a letter. Again mailed to Plaintiff on 2/26/07 with a letter, responsive to latest RTP.</p> <p>1066-1081 – August, 2006 License Agreement with Marrero</p>	<p>Produced in advance of Noble's Deposition (as per EEI'S Motion to Preclude Documents, ¶5).</p>
1239 – 1418 ✓	<p>Mailed to Plaintiff on 3/8/07 with a letter, responsive to latest RTP. Produced in Mexico for inspection on March 1, 2007 by agreement.</p> <p>1345-1349 is a contract which did not exist at least until its date of January 16, 2007.</p> <p>1350-1418 - Made available for inspection and copying with other documents and items during the week of February 12, 2007 at the undersigned's Fort Lauderdale office.</p>	<p>Produced on 3/8/07 (as per EEI'S Motion to Preclude Documents, ¶8)</p>
1420 – 1492 ✓	<p>Mailed to Plaintiff on 3/12/07 with a letter. Produced in Mexico for inspection on March 1, 2007 by agreement.</p>	<p>Produced on 3/12/07 (as per EEI'S Motion to Preclude Documents, ¶8)</p>

1493 – 1644 ✓	<p>Faxed to Plaintiff on 3/22/07.</p> <p>1529-1603 were in the possession of 3rd parties until the week they were produced.</p> <p>1604-1609 – Already disclosed to Plaintiff and of public record with the USPTO long before Request to Produce to NOBLE. Made available for inspection and copying with other documents and items during the week of February 12, 2007 at the undersigned's Fort Lauderdale office.</p> <p>1610-1634 were in the possession 3rd parties (Marrero) until the week they were produced.</p> <p>1635-1644 – Already disclosed to Plaintiff and of public record with the USPTO long before Request to Produce to NOBLE. Made available for inspection and copying with other documents and items during the week of February 12, 2007 at the undersigned's Fort Lauderdale office.</p>	Produced on 3/22/07 (as per EEI'S Motion to Preclude Documents, ¶8)
1645 – 1652 ✓	Mailed and faxed to Plaintiff on 3/29/07 with a letter. In the possession of 3 rd parties (Marrero) until March 28, 2007.	Produced on 3/29/07 (as per EEI'S Motion to Preclude Documents, ¶8)
1653	No such document produced yet.	

Joanna Lubczanska

From: Karen L Stetson [kls@kstetsonlaw.com]
Sent: Wednesday, September 07, 2005 6:58 PM
To: Michael I. Santucci; 'Meredith Frank'
Cc: Joanna Lubczanska
Subject: RE: Coco Bongo

Thanks for your continued graciousness. [REDACTED]

[REDACTED] As to the odd shaped document, can you refresh my memory as to what that is? I know we can't do it this week, and we may be in trial next week, but we'll let you know.

Karen

-----Original Message-----

From: Michael I. Santucci [mailto:mis@500law.com]
Sent: Wednesday, September 07, 2005 6:37 PM
To: Karen Stetson; Meredith Frank
Cc: Joanna Lubczanska
Subject: Coco Bongo

Hopefully, you have both arrived back safe and sound without much of a sunburn.

My staff is still Bates stamping and copying the documents we produced at breakfast in Cancun. I expect your copies should be ready by Friday. In addition, remember that I said there were some original documents which are in my office which we were not able to conveniently copy because of their size or odd shape. Perhaps one, or both of you could come up to our Fort Lauderdale office to inspect same and pick up the copies. If we can time it right, I will be happy to take you both to lunch. I am available for a late lunch Friday, or Tuesday from noon until 3:00. I will be at a mediation in Orlando on Monday.

Please let me know if I should expect a realistic counter-proposal shortly, or whether I should finish our response to your motion for summary judgment.

Sincerely,

Michael I. Santucci, Esq.
mis@500Law.com

SILVERMAN SANTUCCI, LLP
www.500law.com

FLORIDA OFFICE:
500 West Cypress Creek Road
Suite 500
Pinnacle Building
Fort Lauderdale, Florida 33309
PH: 954.351.7474

EXHIBIT "B"

 SILVERMAN SANTUCCI, LLP

September 15, 2005

FLORIDA OFFICE:

500 W. Cypress Creek Road
Suite 500
Fort Lauderdale, FL 33309
Tel: 954.351.7474
Fax: 954.351.7475

VIA FIRST CLASS MAIL

Karen Stetson, Esq.
Law Offices of Karen L. Stetson, Esq.
PO Box 403023
Miami, Florida 33140

NEW JERSEY OFFICE:

One Gateway Center
Suite 2600
Newark, New Jersey 07102
Tel: 888 889-5865
Fax: 888 889-5866

RE: Estefan/Coco Bongo
Our File No. 7376.001

Dear Ms. Stetson:

Kindly find enclosed Bates Nos. 001039 through 001054 for your review and record.

Thank you for your attention to this matter.

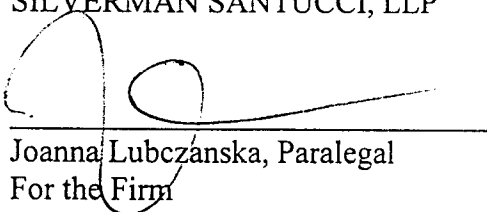
ATTORNEYS:

Melvin K. Silverman*
Michael I. Santucci
S. Tracy Long †
Aaron M. Cohen †*
Philip A. Duvalsaint
Joseph V. Priore
David A. Hoffman

Sincerely yours,

SILVERMAN SANTUCCI, LLP

By:


Joanna Lubczanska, Paralegal
For the Firm

PATENT AGENT:

Yi Li, Ph.D.

/jl

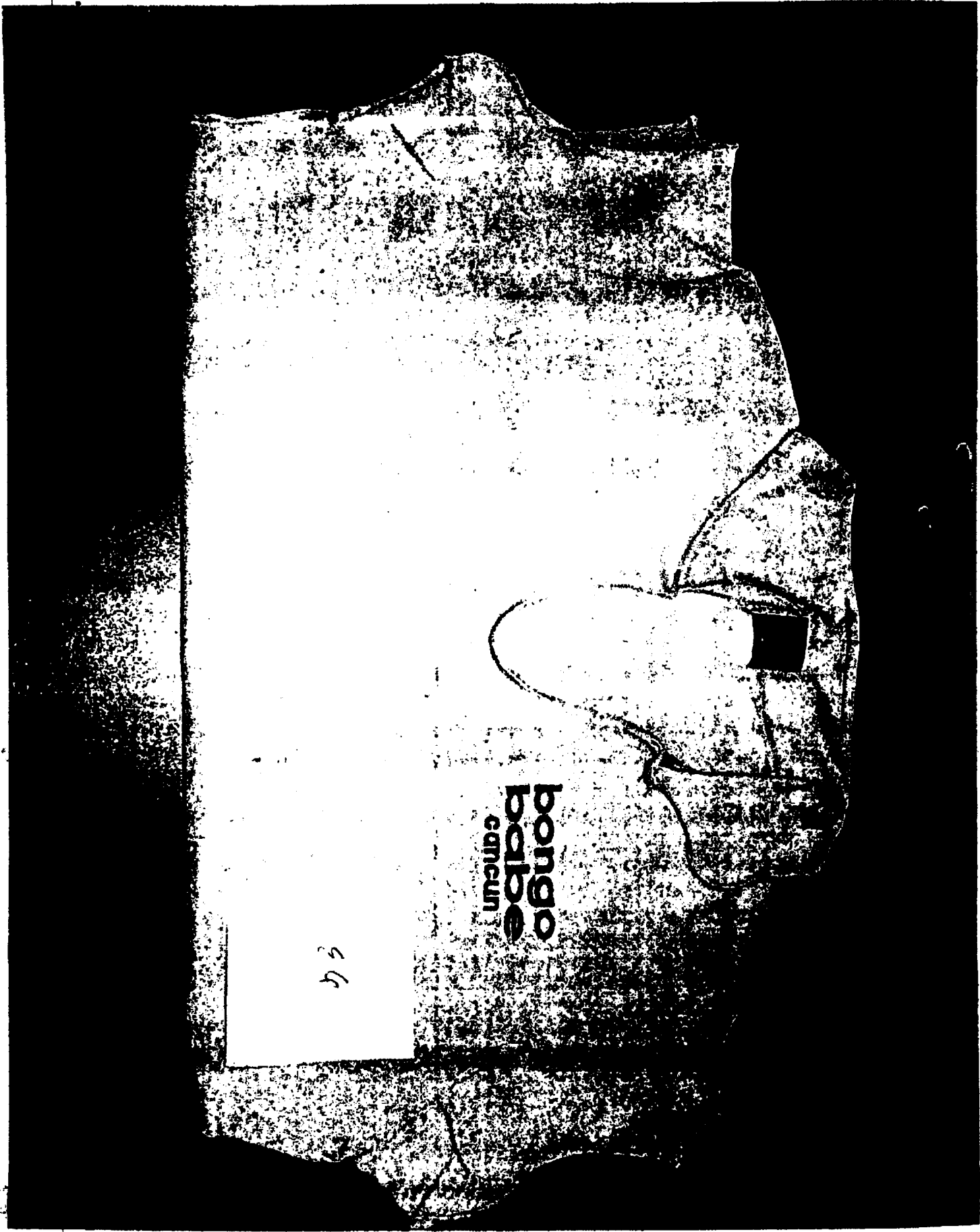
Enclosures

* Registered Patent Attorney
Admitted in New Jersey and
the U.S. Patent and
Trademark Office Only

† Also admitted in PA
‡ Also admitted in NJ
• Also admitted in NY
• Also admitted in DC

EXHIBIT B

EXHIBIT "D"



From: Michael I. Santucci
Sent: Monday, February 12, 2007 4:56 PM
To: 'kls@kstetsonlaw.com'
Subject: Compliance with TTAB Order
Importance: High

If I recall correctly, my belief that additional documents exist regarding adoption of the mark was based upon a letter from counsel to your client. This letter could have been used in the deposition of your corporate representative or a deposition from the Caruso case. At the moment, I don't have time to comb through the transcripts and attachments.

Regarding the privilege log, how many documents are we talking about. I definitely would like the privilege log to contain references to all communications between in-house counsel and EEI. Regarding your question of whether the log should contain references to communications with your firm which directly relate to this opposition/cancellation action, we will consider some limitation if you could give us an idea as to volume and character of documents. However, I am inclined at the time, to request a full privilege log under the rules to support your objections, or a waiver of some or all of them. An example of one of my concerns about agreeing to a limitation is that relevant internal communications will remain unidentified simply because an attorney was included in the "cc:" line of an email.

How much time do you need to comply with the TTAB Order? We will consider a short extension given your health. I feel your pain. I had it last month. However, we will ask that the extension apply to our clients as well for its formal written responses. However, note that we have already produced some of the responsive documents, new ones were received by my office today which are immediately available for inspection at our Fort Lauderdale office (we could also have them copied if you prefer); and still other documents will be produced for inspection and copying in Cancun later this month when we are all there as we discussed.

Please advise.

Sincerely,

Michael I. Santucci, Esq.
mis@500Law.com

SILVERMAN SANTUCCI, LLP
Attorneys At Law
www.500law.com

MAIN OFFICE:
500 West Cypress Creek Road

EXHIBIT "E"

From: Michael I. Santucci
Sent: Thursday, March 01, 2007 1:09 PM
To: kls@kstetsonlaw.com
Subject: RE: Document Production

OK - I just don't think you are going to be able to review every document before 1:30 though. I want you to have enough time.

We will look for you around 1:00. I will grab a sandwich in the plaza in the meantime.

Michael

From: Karen L. Stetson [mailto:kls@kstetsonlaw.com]
Sent: Wed 2/7/2007 11:58 PM
To: Michael I. Santucci
Subject: Re: Document Production

I thought you understood we were not coming e3ly. We'll probaly be there a feew mins before 1. Sorry for the confusion

Karen L. Stetson, Esq.

Sent via BlackBerry from Cingular Wireless

-----Original Message-----

From: "Michael I. Santucci" <mis@500law.com>
Date: Thu, 1 Mar 2007 12:49:14
To: "Meredith Frank" <meramy@gmail.com>
Cc: <kls@kstetsonlaw.com>, <maf@kstetsonlaw.com>
Subject: Document Production

Meredith:

We have been here since 10:15 Cancun time waiting to start the document production. It is almost noon, and I have not heard from you. Do you have any idea when you will be coming to start your inspection? I would like to plan for lunch since I expect we will be going straight through the deposition without a lunch break.

There are documents I need to show you and Karen confidentially, and things to discuss in connection therewith. As I said last night, you need to give yourself a decent amount of time to review the documents before the deposition begins at 1:30.

Please advise. You can respond by email, or call our client's office and ask for me.

Sincerely,

Michael I. Santucci, Esq.

EXHIBIT "1 F"

4/23/2007

<<mailto:mis@500Law.com>> mis@500Law.com

<<mailto:mis@lifelonglegal.com>>

SILVERMAN SANTUCCI, LLP

Attorneys At Law

www.500law.com: <<http://mail.500law.com/exchweb/bin/redirect.asp?URL=http://www.500law.com/>>

MAINFOFFICE:

500 West Cypress Creek Road
Suite 500
Pinnacle Building
Fort Lauderdale, Florida 33309
PH: 954.351.7474
FX: 954.351.7475

NEW JERSEY OFFICE:

One Gateway Center

Suite 2600

Newark, New Jersey 07102

PH: 973.645.9494

FX: 954.492.0087

WEST PALM BEACH OFFICE:

777 South Flagler Drive
Suite 800 - West Tower
West Palm Beach, Florida 33401

PH: (561) 659-3020

FX: (561) 515-6001

INFORMATION CONTAINED IN THIS EMAIL IS ATTORNEY PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPY OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE, RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE EMAIL ADDRESS, AND DESTROY THIS EMAIL MESSAGE. THANK YOU.

From: Meredith Frank [<mailto:meramy@gmail.com>]

4/23/2007

Sent: Wed 2/28/2007 4:21 PM
To: Michael I. Santucci
Cc: kls@kstetsonlaw.com; maf@kstetsonlaw.com
Subject: Mexico

Michael,

What are the arrangements for tomorrow's document production? As we discussed, we want to go to Coco Bongo in the morning prior to the depo so we can review the documents. What time will someone be at Coco Bongo so we can review the documents? How do we get in and who do we ask for? Also, have you determined the quantity of the documents so we can determine out how long we need to review the documents? We are staying at the Ritz. My cell is (305) 2134675. How can we reach you?

Meredith

From: kls@kstetsonlaw.com [mailto:kls@kstetsonlaw.com]
Sent: Monday, April 16, 2007 3:50 PM
To: Michael I. Santucci
Subject: RE: Mailing Problem

Michael:

Once again, we have not received a pleading which you have filed with the TTAB and indicated in your certificate of service that you have mailed to us. We never received your response to our motion to preclude witnesses and only found out about its existence upon a review of the docket before the TTAB. This is the 7th or 8th time this has happened, each time you claim it is unintentional. We have repeatedly asked that all filings be either e-mailed to us by pdf or faxed to us in addition to mailing since there seems to be some problem on YOUR end regarding filing. Please advise – this is getting ridiculous.

Karen

From: Michael I. Santucci [mailto:mis@500law.com]
Sent: Friday, March 30, 2007 4:12 PM
To: kls@kstetsonlaw.com
Subject: Mailing Problem

Karen:

Both of the legal assistants who work on the Estefan/Noble matters double checked, and said that their records show that they mailed the latest document to the correct address. I don't understand the problem. The most I can say is that I will have to take you at your word this time again and if you need a few extra days to respond or reply to the document, I will be more than happy to agree. Sincerely,

Michael I. Santucci, Esq.
mis@500Law.com

SILVERMAN SANTUCCI, LLP
Attorneys At Law
www.500law.com

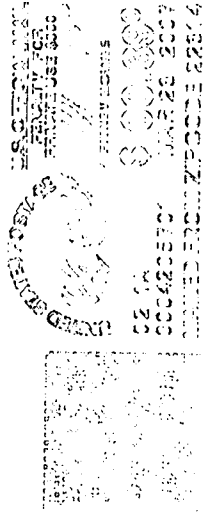
MAIN OFFICE:
500 West Cypress Creek Road
Suite 500
Pinnacle Building
Fort Lauderdale, Florida 33309
PH: 954.351.7474
FX: 954.351.7475

EXHIBIT "G"

United States Patent and Trademark Office
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
If Undeliverable Return in Ten Days

OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER



91174160

KAREN L. STETSON, ESQ.
P.O. BOX 403023
MIAMI, FL 33140

201 NO 1 A05 I 00 03/24/07
RETURN TO SENDER
STETSON, KAREN
BOX CLOSED
UNABLE TO FORWARD
RETURN TO SENDER

33140#192518021

EXHIBIT "H"

TTAB

UNITED STATES PATENT
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MARK OFFICE

Mailed: March 22, 2007

Opposition No. 91174160

76/511,045

Estefan Enterprises, Inc.

v.

Roberto Noble

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Opposer's motion, filed February 23, 2007, to extend its time until March 9, 2007 to respond to applicant's discovery requests is granted. March 9th having now passed, the Board presumes opposer acted in the time it requested. In the event opposer was waiting for a determination of its motion before serving its responses, in accordance with the decision not to grant opposer's motion to consolidate, discussed below, the time for opposer to serve discovery responses is otherwise suspended.

Opposer's motion, filed March 7, 2007, to consolidate the instant opposition with Opposition No. 91121980 and Cancellation No. 92045221, already consolidated with Opposition No. 91121980 as the parent, is denied.

Although consolidated Opposition No. 91121980 is currently suspended, testimony opened once in that case. After almost six years of pendency for the parent case, discovery finally closed on September 1, 2006. The Board is not inclined to reopen



03-26-2007

U.S. Patent & TMO/TM Mail Rcpt Dt #30

• Opposition No. 91174160

discovery in the consolidated proceeding, as would be the practice should the present opposition proceeding be joined thereto. Moreover, the Board is acutely aware of the parties' conduct in the consolidated proceeding and will not be lenient in this case should the parties engage in similar conduct or ignore the schedule set. The parties are reminded that consolidation is discretionary with the Board and the Board has the inherent authority to schedule the disposition of cases on its docket. See TBMP §§510.01 and 511 (2d ed. rev. 2004).

Except as indicated below, proceedings herein are suspended pending disposition of consolidated proceeding Opposition No. 91121980. See Trademark Rule 2.117(a); and TBMP §510.02(a) (2d ed. rev. 2004) ("... the Board may, also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved.")

In accordance with the institution order dated November 27, 2006, applicant's answer herein was due on January 6, 2007. Insofar as January 6th was a Saturday, applicant's answer was actually due on Monday, January 8, 2007. See Trademark Rule 2.196. Applicant filed his answer on January 11, 2007 with no explanation why the answer was late.

In view thereof, notice of default is entered against applicant. See Fed. R. Civ. P. 55(a).

• Opposition No. 91174160

Applicant is allowed until **thirty days** from the mailing date of this order to show cause why judgment by default should not be entered against applicant in accordance with Fed. R. Civ. P. 55(b).

United States Patent and Trademark Office
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA, 22313-1451
If Undeliverable Return in Ten Days
OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER

91121980

KAREN L. STETSON, ESQ.
P.O. BOX 403023
MIAMI, FL 33140

229190491021
33140#1023 1021



201 NO 1 A05 I 00 03/24/07
STETSON, KAREN
RETURN TO SENDER
BOX CLOSED
UNABLE TO FORWARD
RETURN TO SENDER

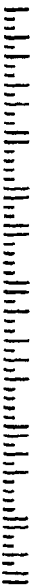


EXHIBIT " 1 "

TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 21, 2007

Opposition No. 91121980
Cancellation No. 92042551

75/767,732

ESTEFAN ENTERPRISES, INC.

v.

ROBERT NOBLE & BONGO, S.A.,
DE C.V.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the Board's order dated January 11, 2007, plaintiff's first testimony period is set to close on April 15, 2007.¹ On March 8, 2007, plaintiff filed a motion for leave to file a second amended petition to cancel, alleging fraud in defendant's filing of its Sections 8 and 15 affidavits on August 26, 2007. On March 12, 2007, plaintiff filed a motion to preclude the testimony of certain witnesses for defendant on the basis that they were disclosed late. Proceedings herein are suspended pending disposition of the motion such motions. Any paper filed during the pendency of these motions which is not relevant thereto will be given no consideration. See Trademark Rule 2.117(c).

¹ Thus, the testimony period opened on March 17, 2007.



03-26-2007

U.S. Patent & TMO/TM Mail Rpt Dt #30

Opposition No. 91121980 and Cancellation No. 92045221

The parties are reminded that the Board is cognizant of its previous admonitions regarding the parties' conduct thus far in this proceeding. In the event the Board determines these motions were brought for purposes of delay, or if the parties brief these motions in manner that is determined dilatory, sanctions may be imposed.

From: kls@kstetsonlaw.com [mailto:cls@kstetsonlaw.com]

Sent: Monday, April 09, 2007 11:05 AM

To: Michael I. Santucci

Subject: Estefan/Noble

Michael:

We will be moving to strike your response to our motion to preclude witnesses on the following bases:

1. I did not join you in your request to exceed the page limit set by the Board – I told you that since the Rules do not provide for a reply, the Board obviously meant responses within its Order. I never agreed that it was “unreasonable” to be limited to a 5-page limitation.
2. I did say that if you needed to, you could ask for clarification, but I assumed you would do that BEFORE filing the response, not simultaneous with the response. The way you've done it, without getting permission first, is merely a way of circumventing the Board's order.
3. Moreover, although you acknowledge my threat to seek sanctions if you attach e-mails which include anything about settlement, you nevertheless did so.

I assume you will not be agreeing to this motion, but nevertheless let me know your position by day's end.

Karen

EXHIBIT “J”

4/23/2007

Michael I. Santucci

From: Michael I. Santucci
Sent: Thursday, January 18, 2007 5:53 PM
To: maf@klstetsonlaw.com; kls@stetsonlaw.com
Cc: Sandra Perez; Joanna Lubczanska
Subject: Estefan v. Noble - Consolidated TTAB Matter .001
Attachments: 1055-1056.pdf; 1066-1081.pdf; 1057-1065.pdf

Counsel:

As my assistant advised, I will be in Miami today and tomorrow for some Bar events. I thought that would give us an opportunity to review the recent TTAB order so we can discuss compliance so as to avoid any potential problems or misunderstandings in this regard. I will seek dates for the deposition of Roberto Noble right away. Right now, the weeks of February 12th and 19th look good for me.

Attached are some newer documents which I believe might be responsive to your requests to produce (Bates#1055-1081). Notwithstanding, Noble intends to rely upon them in one way or another. I also believe that I eventually will have to produce them within the context of the Marrero litigation. I also expect to be producing more documents before the recently set deadline to respond to your most recent Request to Produce in the consolidated TTAB matter.

We might want to discuss some ideas to share in discovery for the two cases. I believe my clients in both matters would be receptive.

Sincerely,

Michael I. Santucci, Esq.
mis@500Law.com

SILVERMAN SANTUCCI, LLP
Attorneys At Law
www.500law.com

MAIN OFFICE:
500 West Cypress Creek Road
Suite 500
Pinnacle Building
Fort Lauderdale, Florida 33309
PH: 954.351.7474
FX: 954.351.7475

NEW JERSEY OFFICE:
One Gateway Center
Suite 2600
Newark, New Jersey 07102
PH: 973.645.9494
FX: 954.492.0087

EXHIBIT "K"

4/3/2007