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Filing date: **04/17/2007**

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

Proceeding	91168198
Party	Plaintiff Farmamedica, S.A.Farmamedica, S.A. Farmamedica, S.A. Farmamedica, S.A. Farmamedica, S.A. 2-A Calle 34-16Zona 7 Guatemala City, 000000 GUATEMALA
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Submission	Motion to Suspend for Civil Action
Filer's Name	Edward M. Joffe
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Signature	/s/Edward M. Joffe
Date	04/17/2007
Attachments	Opposer's Motion for Suspension_04-12-07.pdf (3 pages)(24732 bytes) Opposer's Memo in Support for Suspension_04-12-07.pdf (5 pages)(32194 bytes)

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

OPPOSITION No.: 91168198
SERIAL No.: 78415472

FARMAMEDICA, S.A.

OPPOSER

v.

ALFARO DE MARON, ANA ELOISA DE MARON

APPLICANT

OPPOSER'S UNOPPOSED MOTION FOR SUSPENSION

Opposer, Farmamedica, S.A., hereby moves for suspension of the above-captioned proceeding pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510. On April 13, 2007, Farmamedica filed an Amended Complaint against Applicant Maron, in the United States District Court for the Southern District of Florida, entitled Farmamedica, S.A. v. Ana Eloisa Alfaro de Maron d/b/a Combisa Laboratorios – Case No. 07-20944-CIV-JORDAN.

As more fully set forth in the accompanying Memorandum of Law, which is specifically incorporated herein by reference, the Civil Action will dispose of all issues currently pending before the Trademark Trial and Appeal Board in the opposition proceeding.

Counsel for defendant is not opposed to this Motion.

Accordingly, Farmamedica respectfully requests that the Board suspend the opposition pending final disposition of the Civil Action.

Dated: April 17, 2007

Respectfully submitted,

By: /s/ Edward M. Joffe
Edward M. Joffe, Esq.
Attorney for Plaintiff
Farmamedica, S.A.

SANDLER, TRAVIS & ROSENBERG, P.A.
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Miami, Florida 33126
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CERTIFICATE OF TRANSMISSION

I HEREBY CERTIFY that this *Opposer's Unopposed Motion for Suspension* is being transmitted for electronic filing in the Trademark Trial and Appeal Board in the United States Patent and Trademark Office this 17th day of April, 2007.

/s/ Edward M. Joffe
Edward M. Joffe

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and complete copy of the foregoing *Opposer's Motion for Suspension* has been served on Amaury Cruz, Esq. by emailing and mailing said copy on April 17, 2007 to:

Amaury Cruz, Esq.
1111 Lincoln Road, Ste 400
Miami Beach, FL 33139
Email: lex@lexarian.com

/s/ Edward M. Joffe
Edward M. Joffe

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SERIAL No.: 78415472

FARMAMEDICA, S.A.

OPPOSER

v.

ALFARO DE MARON, ANA ELOISA DE MARON

APPLICANT

OPPOSER'S MEMORANDUM OF LAW IN SUPPORT OF
ITS UNOPPOSED MOTION FOR SUSPENSION

Opposer, Farmamedica, S.A., hereby files this Memorandum of Law in Support of its Unopposed Motion for Suspension pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. §510.

I. PROCEDURAL BACKGROUND

The opposition was filed on December 21, 2005. Farmamedica is also pursuing a parallel claim in the U.S. District Court against applicant. Since an adjudication in the U.S. District Court will resolve the same issues that are before this Board, Opposer moves to suspend this proceeding.

II. ARGUMENT

The Board has the authority to suspend an inter parties proceeding before it when the parties thereto are engaged in a pending civil action that may effectively dispose of the issues

before the Board, pursuant to 37 C.F.R. § 2.117(a):

[w]henever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action....which may have bearing on the case, proceedings before the Board may be suspended until termination of the civil action...

See, also T.B.M.P. § 510. Requests for suspension are commonly filed because of a civil action pending between parties in a Federal District Court and the Board will typically suspend proceedings in the case before it if the final determination of the civil action will have bearing on the issues before the Board. T.B.M.P. §510.02(a). While not automatic, it is standard procedure for the Board to suspend administrative proceedings pending the outcome of civil litigation between the same parties involving issues related to the administrative proceeding. See, 5J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:47 (4th ed. 2004).

For example, in The Other Telephone Company v. Connecticut National Telephone Company, Inc., 181 U.S.P.Q. 125, 126-7 (T.T.A.B. 1974), the Board suspended an opposition proceeding until final disposition of a civil action between the parties because a review of the federal complaint revealed that its disposition would directly affect resolution of the issue of likelihood of confusion, the same issue before the Board.

Similarly, in Tokaido v. Honda Associates Inc., 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973), the Board granted the respondent's motion to suspend the cancellation proceeding pending disposition of a civil action because the civil action might be dispositive of the issues raised in

the cancellation proceeding. The Board's review of the complaint revealed that the relief sought by the respondent in the civil action would have a bearing on the issues before the Board and, therefore, it was the "better policy" to suspend the cancellation proceedings until the civil action was concluded. Id. at 862.

Moreover, to the extent the civil action involves issues in common with the issues before the Board, the decision of the Federal District Court is often binding on the Board. In Tokaido, the Board noted that while a decision by the District Court would be binding upon the U.S.P.T.O., a decision by the Board would only be advisory in respect of the disposition of the civil action. Id. For the same reason, in Whopper-Burger, Inc. v. Burger King Corporation, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971), the Board held that the outcome of the civil action would have a direct bearing on the question of the rights of the parties to the cancellation proceeding and might completely resolve all of the issues and suspended the cancellation proceeding. Id. at 807.

In this case, the issues raised in the Civil Action will dispose of all the issues in this cancellation proceeding. In its opposition Farmamedica alleges that there is a likelihood of confusion between its use of the mark VITAL FUERTE in connection with applicant's mark VITAL FORTE.

Farmamedica's Complaint in the Civil Action seeks, inter alia, (1) an injunction against Applicant's use of VITAL FORTE or any other confusingly similar mark in connection with dietary supplements on grounds of likelihood of confusion, (2) an order declaring that Farmamedica is the senior user of VITAL FUERTE names and marks, and that Applicant's base of its VITAL SUPER FORTE mark and Design infringes Farmamedica's VITAL

FUERTE names and marks, and (3) an order directing the common of Trademarks not to approve Maron's Application. Accordingly, it is clear that the issues in the Civil Action will directly impact the resolution of the issues of likelihood of confusion and seniority that are the subjects of this opposition preceding and this proceeding should be suspended pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.

III. CONCLUSION

For the foregoing reason, Farmamedica respectfully request that the Board suspend the above captioned opposition pending final disposition of the Civil Action.

Dated: April 17, 2007

Respectfully submitted,

By: /s/ Edward M. Joffe
Edward M. Joffe, Esq.
Attorney for Plaintiff
Farmamedica, S.A.

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/s/ Edward M. Joffe
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Amaury Cruz, Esq.
1111 Lincoln Road, Ste 400
Miami Beach, FL 33139
Email: lex@lexarian.com

/s/ Edward M. Joffe
Edward M. Joffe

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