



2003 by Respondent against Petitioner in the United States District Court for the Central District of California, specifically, Case No. SA CV 03-1242 CJC (MLGR) (the "Civil Action").

In its Opposition, Petitioner argues at length for the stay of the Civil Action, instead of the suspension of the Cancellation Proceeding. Petitioner cites numerous cases in support of its argument that the District Court may order a stay of its own proceedings. However, these cases are irrelevant to Respondent's Motion to Suspend, as the Trademark Trial and Appeal Board (the "Board") lacks the power to stay the Civil Action. Furthermore, since the filing of Petitioner's Opposition, the District Court has denied Petitioner's *ex parte* application to stay the Civil Action, finding that "there is no 'good cause' to justify the relief requested."

Attached hereto as Exhibit A is a copy of the District Court's order. Petitioner's protracted discussion of the District Court's power to stay its proceedings in the Opposition, thus is a blatant attempt to distract the Board from the fact that a decision in the Civil Action will be dispositive of the issues before the Board, and as a result, good cause exists to suspend this opposition proceeding in favor of the Civil Action pursuant to 37 C.F.R. §2.117(a).

Petitioner admits in its Opposition that the Board "will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the [Board]." See Petitioner's Opposition, p. 19. The cases cited to by Petitioner where the Board did not suspend proceedings were those in which the Board was about to issue a decision at the time the motions to suspend were brought before it. See E.I. DuPont v. De Nemours & Co. v. G. C. Murphy Co., 199 U.S.P.Q. 807 (T.T.A.B. 1978) (motion to suspend denied where motion made after the trial periods had expired and after the briefs at

the final hearing were received); see also Ortho Pharmaceutical Corp. v. The Hudson Pharmaceutical Corp., 178 U.S.P.Q. 429 (T.T.A.B. 1973) (motion to suspend denied at late date in the proceedings). Here, neither party will be prejudiced by suspending the Cancellation Proceedings because it is still very early in the action.

Finally, Petitioner notes that the Board typically requires that an issue be joined, in one or both proceedings, before the Board will consider a motion to suspend. However, according to TBMP §510.02(a), this requirement "is made only in those cases where there is no stipulation to suspend and it is not possible for the Board to ascertain, prior to the filing of an answer in one or both proceedings, whether the final determination of the other proceeding will have a bearing on the issues before the Board." Here, an answer has been filed in the Civil Action. However, if the Board believes that Respondent's answer in the instant Cancellation Proceeding would assist the Board in making a decision as to whether the District Court can dispose of the issues pending before the Board, Respondent will file an answer.

For all the foregoing reasons, Respondent respectfully requests that the Board issue an order suspending all further proceedings in Cancellation No. 92042849 pending disposition of Case No. SA CV 03-1242 CJC (MLGR) pending in the United States District Court for the Central District of California.

Dated: March 18, 2004

By: \_\_\_\_\_



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**CERTIFICATE OF SERVICE**

The undersigned hereby declares that on March 18, 2004, a **RESPONDENT'S REPLY BRIEF TO PETITIONER'S OPPOSITION TO THE MOTION TO SUSPEND CANCELLATION PROCEEDING PENDING DISPOSITION OF CIVIL ACTION** is being deposited with the United States Postal Service as *First Class Mail*, postage prepaid, in an envelope addressed to:

Ira Cohen, Esq.  
Silver, Garvett & Henkel, P.A.  
1110 Brickell Avenue, Suite 900  
Miami, Florida 33131

Mr. Arnie Krause  
Five Y Clothing, Inc.  
9500 N.W. 108th Avenue  
Miami, Florida 33178

I declare under penalty of perjury that the foregoing is true and correct.



Simone Robinson

*Handwritten initials/signature*

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. SA CV 03-1242-CJC (MLGx)

Date: March 12, 2004

Title: Paul Frank Industries, Inc. -v- Kmart Corp., et al.

PRESENT:

THE HONORABLE CORMAC J. CARNEY

Debra Beard  
Courtroom Clerk

Not Present  
Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:  
Not Present

ATTORNEYS PRESENT FOR DEFENDANTS:  
Not Present

PROCEEDING: IN CHAMBERS

The Court has received defendants Kmart Corp. and Five Y Clothing, Inc.'s ex parte application for: (1) Order staying Action Pending Resolution of Inter Partes Cancellation Proceeding, etc. filed March 8, 2004.

Defendants' ex parte application is DENIED. There is no "good cause" to justify the relief requested. Defendants can proceed by way of a regularly noticed motion.

The Clerk shall serve a copy of this minute order on counsel for all parties in this action.

DOCKETED ON CM  
MAR 12 2004  
BY [Signature] 040

29  
[Signature]

MINUTES FORM 11DB  
CIVIL - GEN

Initials of Deputy Clerk

*ttab*

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EV272829870US

March 18, 2004

64221-0003

VIA USPS EXPRESS MAIL

Commissioner for Trademarks  
Box TTAB  
2900 Crystal Drive  
Arlington, Virginia 22202



03-19-2004

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

Re: Cancellation Proceeding No. 92042849

Dear Commissioner:

Enclosed please find Respondent's Reply Brief to Petitioner's Opposition to the Motion to Suspend Cancellation Proceeding Pending Disposition of Civil Action. Upon receipt please return the enclosed stamped postcard.

Sincerely,

MELISSA B. BLOOM  
Jeffer, Mangels, Butler & Marmaro LLP

MXB:sr1  
Enclosures  
cc: Rod S. Berman, Esq. (w/o encls.)