

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

In the Matter of Application Serial No. 78/030,875  
Filed on October 16, 2000  
For the mark: **GUADALAJARA HACIENDA**

HMR ACQUISITION COMPANY, INC.,  
D/b/a Hacienda Mexican Restaurants.

Opposer

V.

CASUAL DINING, INC.,

Applicant

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Opposition No. 91155801

05-12-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

**APPLICANT'S ANSWER AND COUNTERCLAIM**

Applicant, Casual Dining, Inc. (hereinafter "Applicant"), having its principal place of business located in Houston, Texas, believes that Opposer, HMR Acquisition Company, Inc., d/b/a Hacienda Mexican Restaurants will not be damaged by the registration of applicant's mark, shown above and as set forth in Applicant's application, and hereby responds to the opposition, and shows the following:

1. Applicant has no basis to admit or deny the allegation of paragraph 1, so it denies same.
2. Admitted.
3. Denied.
4. Denied.
5. Applicant has no basis to admit or deny, so it denies paragraph 5.
6. Admitted.
7. Admitted.
8. Denied.
9. Denied.

WHEREFORE, Applicant respectfully requests that Application Serial No. 78/030,875 be allowed, and this Opposition be denied, and dismissed.

**COUNTERCLAIM**

Casual Dining, Inc., Cancellation Petitioner, having a place of business in Houston, Texas, through its undersigned counsel, believes that it will be damaged by the following registration, which issued less than five (5) years prior to this date, and hereby seeks cancellation of same:

<b><u>MARK</u></b>	<b><u>Reg. No./Reg. Date</u></b>	<b><u>Goods/Services</u></b>
HACIENDA	2,484,222/ 09/04/2001	Restaurant and bar services

and the following registration, under 15 U.S.C. §1064(3):

HACIENDA	1,331,341/ 04/16/1985	Restaurant and bar services
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As grounds for the cancellation, Applicant/Cancellation Petitioner would show:

1. Cancellation Petitioner is a corporation organized and existing under the laws of the State of Texas, and has promoted and provided restaurant and bar services in association its trademarks and service mark "GUADALAJARA" since at least as early 1990, and its mark, for which it seeks registration, "GUADALAJARA HACIENDA" since at least 2000, the year it filed its Intent-To-Use application, and is entitled to the filing date of October 16, 2000 for its entire mark.
2. Cancellation Petitioner is attempting to register its entire mark, under which it does business : **GUADLAJARA HACIENDA**, and Respondent, HMR Acquisition Company, Inc., doing business as Hacienda Mexican Restaurants, has filed an opposition thereto, based on one or more registrations that on their face appear to be invalid, and upon information and belief, one of which was obtained by material misrepresentations, under oath, to the United States Patent and Trademark Office, with the other application stating a first date of use that appears to be false,

making the registrations invalid.

3. Specifically, HMR Acquisition Company, Inc., an Indiana corporation, was created on September 25, 1995, according to the official records of the Indiana Secretary of State. The record is attached hereto as Exhibit "A". It appears on the face of the State of Indiana official document that HMR Acquisition, Inc. could not have used its mark "HACIENDA" prior to September 25, 1995, its date of organization, yet it swore, when filing 75/635,976, on February 8, 1999 (now Registration No. 2,484,222), that HMR first used the mark in commerce 06/14/1978.

4. Registration No. 1,331,341 also alleges a first use date in commerce, for HMR Acquisition, Inc., 06/14/1978, long before the registrant became a legal entity.

5. In addition, HACIENDA is widely used as a common name for Mexican style restaurants in the geographic region in which Registrant maintains its restaurant chain. For example, there is a "LA HACIENDA" Mexican style restaurant in Ocean City, Maryland. A copy of their web site is attached as Exhibit "B".

6. There is a chain of "LA HACIENDA" restaurants, owned by the Guzman family, that are located in seven (7) locations in Tennessee and Alabama. Their web site is attached heretofore as Exhibit "C". A search of [www.Google.com](http://www.Google.com) revealed the following Hacienda restaurants: (i) HACIENDA GONZALES, 706 S. Guadalupe Street, San Marcos, Texas; (ii) LA HACIENDA Restaurant, 333 Palisades Avenue, Jersey City, New Jersey; (iii) LA HACIENDA Mexican Restaurant, Port Arthur, Port Neches and Beaumont, Texas; and (iv) LA HACIENDA, 14759 Memorial Drive, Houston, Texas.

7. On information and belief, Registrant knew of one or more of the above-identified Hacienda restaurants when it filed its application to register HACIENDA, and yet failed to identify such users, a serious violation of the duty of candor owed the Patent and Trademark

Office. In addition, most if not all of the above-named HACIENDA restaurants were using the mark HACIENDA well prior to Registrant's use of the mark.

8. Based on the above, cited prior use by others, the false claim of use prior to its organization in 1995, and the extensive use by others throughout the United States, Registrant is not entitled to exclude others, including Petitioner, from using the word Hacienda. In addition, Hacienda may well have become generic for Mexican style restaurants, due to the wide-spread general use of that word in association with restaurants. In Mexico, Hacienda means house, or large ranch, and is generic for restaurants and places for serving food. Merely using the word in the United States, for the same purpose, does not entitle the user to register that mark, alone.

9. For example, the Patent and Trademark has allowed, and registered the mark "JUAN'S HACIENDA", where "Hacienda" has been disclaimed. See the attached PTO printout for Registration No. 2,319,756, Exhibit "D". This is not different than Petitioner's mark: "GUADALAJARA HACIENDA", with the primary identifier being Guadalajara.

WHEREFORE, Petitioner respectfully petitions the Commissioner to cancel the Registrant's registrations "HACIENDA", No. 1,331,341 and 2,484,222.

Respectfully submitted,  
CASUAL DINING, INC.

Date: \_\_\_\_\_

May 12, 2003

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

N. Elton Dry  
DRY & TASSIN, LLP  
3200 Southwest Freeway, Ste 2355  
Houston, TX 77027  
713-223-0500  
713-223-1476 Facsimile  
Attorneys For Applicant/Petitioner

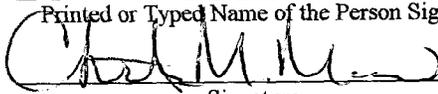
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above Answer and Counterclaim have been served on Alexander D. Forman, of ICE MILLER, at their address of record, by placing the above instrument in the U. S Mail, postage prepaid, First Class, on this May 12 -, 2003.

  
\_\_\_\_\_  
N. Elton Dry

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Services as ~~First Class~~ <sup>Express</sup> mail, postage prepaid, in an envelope addressed to Assistant Commissioner for Trademarks, Trademark Trial And Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on this 12th day of May, 2003.

Christine M. Mamerow  
Printed or Typed Name of the Person Signing the Certificate  
  
\_\_\_\_\_  
Signature  
5-12-2003  
\_\_\_\_\_  
Date of Signature



A

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INDIANA  
**SECRETARY OF STATE**  
**TODD ROKITA**

Name Searched On:  
**HMR Acquisition Company, Inc. (Legal)**

**Current Information**

Entity Legal Name:  
**HMR ACQUISITION COMPANY, INC.**

Entity Address:  
**1501 N. IRONWOOD DR. , SOUTH BEND, IN 46635**

**General Entity Information:**

Control Number: **1995091114**

Status: **Active**

Entity Type: **For-Profit Domestic Corporation**

Entity Creation Date: **9/25/1995**

Entity Date to Expire:

Entity Inactive Date:

**Other Names for this Entity:**

Date	Name (Type)
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / Howard County )
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / Tippecanoe County )
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / St. Joseph County )
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / Elkhart County )
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / LaPorte County )
9/25/1995	HACIENDA MEXICAN RESTAURANTS (Assumed / Vanderburgh County )

3/21/2000	HACIENDA MEXICAN RESTAURANTS (Assumed / BARTHOLOMEW County )
3/22/2000	HACIENDA MEXICAN RESTAURANTS (Assumed / KOSCIUSKO County )
5/30/2000	HACIENDA MEXICAN RESTAURANTS (Assumed / ALLEN County )

Registered Agent(name, address, city, state, zip):

**DEAN A. GOODWIN**  
**1501 N. IRONWOOD DR.**  
**SOUTH BEND, IN 46635**

Principals(name, address, city, state, zip - when provided)

**B. Robert Kill**  
**President**  
**16635 Timber Ct.**  
**NEW BUFFALO, MI 49117**

**TAMARA BOETSMA**  
**Secretary**  
**2106 PARKVIEW PL**  
**SOUTH BEND, IN 46616**

Transactions:

<b>Date Filed</b>	<b>Effective Date</b>	<b>Type</b>
9/25/1995	9/25/1995	Articles of Incorporation
12/21/1995	12/21/1995	Restatement of Articles of Incorporation
6/19/1996	6/19/1996	Certificate of Assumed Business Name
6/19/1996	6/19/1996	Certificate of Assumed Business Name
6/19/1996	6/19/1996	Certificate of Assumed Business Name
6/19/1996	6/19/1996	Certificate of Assumed Business Name
6/19/1996	6/19/1996	Certificate of Assumed Business Name
6/19/1996	6/19/1996	Certificate of Assumed Business Name
12/22/1999	12/22/1999	Articles of Amendment
3/21/2000	3/21/2000	Certificate of Assumed Business

		Name
3/22/2000	3/22/2000	Certificate of Assumed Business Name
5/30/2000	5/30/2000	Certificate of Assumed Business Name
3/6/2001	3/6/2001	Restatement of Articles of Incorporation

**Corporate Reports:****Years Paid**

1997 1999 2001

**Years Due**

None

**Additional Services Available:**

	Generate an official Certificate of Existence/Authorization. There is a fee of \$20.00 for <i>accessIndiana</i> subscribers and a fee of \$23.10 for credit card users. <a href="#">Example Certificate</a>
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**NEW SEARCH**

*All the entity information captured by the Indiana Secretary of State, pursuant to law, is displayed on the Internet. For further information, please call our office at 317-232-6576. Copies of actual corporate documents can also be [ordered online](#).*

*If you encounter technical difficulties while using these services, please contact the [accessIndiana Webmaster](#)*

# LA HACIENDA

## Mexican Food and Spirits

8003 Coastal Hwy. - 80th Street and Coastal Hwy.  
Ocean City, Maryland 21842

**1 (800) 297-8081 or  
(410) 524-8080**

also FAX (410) 524-8847 or email  
[hacienda@intercom.net](mailto:hacienda@intercom.net)

*We specially prepare your favorite Beef, Chicken  
and Seafood Mexican Dinners and Steaks*

OPEN 5:00 P.M. - VISA - MASTERCARD - AMERICAN EXPRESS



B

**Business Opportunities, own your own restaurant, we can show you  
how.**

**Call us at 800-297-8081.**

At La Hacienda in Ocean City, Maryland, we specialize in delicious Mexican cuisine, freshly prepared and brought sizzling hot to your table! Our menu features a wonderful selection of appetizers along with delectable fajitas, burritos, enchiladas, tortillas and traditional combinations. Our extensive drink menu features our La Ha Rita and the coolest drinks from South of the Border. And don't forget to check out our OFF SEASON Specials! We're conveniently located on the bayside of 80th Street and Coastal Highway in Ocean City, Maryland - come partake of our feast!



**TRY OUR  
LA HA  
RITA**

**Cuervo Gold and**

**Beauchant Napoleon**

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# Guzman Group Co.

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C



Camino Real

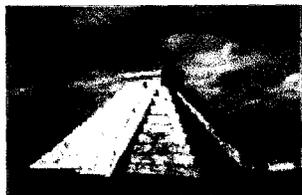


La Hacienda



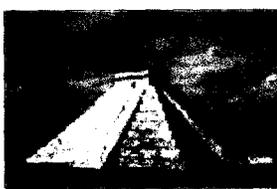
Las Chivas

The Guzman family prides itself in providing Tennessee and Alabama with the best Mexican restaurants in America. We offer dine-in, carry out, lunch specials, cocktails, live entertainment, and catering. With conveniently have seven locations in Tennessee and currently one in Alabama to meet your dinning needs.



**1 Location**

**Camino Real**  
548 Alexander Plaza  
Franklin, TN 37064  
Phone: (615) 790-3104



**6 Locations**

**La Hacienda #1**  
119 Nashville Hwy  
Suite 117 Columbia, TN  
38401 Phone: (931)  
380-1565



**1 Location**

4021 Nolensville Road  
Nashville, TN 37211  
Phone: (615) 831-3595

**La Hacienda #2**  
153 Cox Creek Pkwy  
South Florence, AL  
35630  
Phone: (256) 764-3532

**La Hacienda #3**  
501 Hillsboro  
Road Franklin, TN  
37064 Phone: (615)  
591-9590

**La Hacienda #4**  
2020 Locus Street  
Lawrenceburg, TN  
38464 Phone: (931) 762-  
0045

**La Hacienda #5**  
1903 Shady Brook Dr.  
Columbia, TN  
38401 Phone: (615)  
840-5988

**La Hacienda**  
#6 2504  
Hospitality Lane  
Columbia, TN  
38401 Phone: (931)  
487-9000

**Office:**

1811 Carters Creek  
Franklin, TN  
37064 Ph. (615)  
591-0380 Fax (615)  
591-4007

**We Proudly**  
**Accept:**



**We Offer:**

- Dine-In
- Carry Out
- Lunch Specials
- Cocktails
- Live Entertainment
- Catering

**La Hacienda**  
**#7 3670 Bell**  
**Road Nashville,**  
**TN 37214 Phone: (615)**  
**902-6060**

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**Typed Drawing**

**Word Mark** JUAN'S HACIENDA  
**Goods and Services** IC 042. US 100 101. G & S: bar and restaurant services. FIRST USE: 19980000. FIRST USE IN COMMERCE: 19980000  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 75409180  
**Filing Date** December 22, 1997  
**Filed ITU** FILED AS ITU  
**Published for Opposition** January 12, 1999  
**Registration Number** 2319756  
**Registration Date** February 15, 2000  
**Owner** (REGISTRANT) Madni, Anwar J. INDIVIDUAL UNITED STATES 7503 Aberdon Road Dallas TEXAS 75252  
**Attorney of Record** JOHN S EGBERT  
**Prior Registrations** 2174854  
**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HACIENDA" APART FROM THE MARK AS SHOWN  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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TTAB

**DRY & TASSIN, L.L.P.**

*Attorneys-at-Law*

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Houston, Texas 77027

office@drylaw.com  
713-223-0500

Fax: 713-223-1476

N. Elton Dry†  
Kristin K. Tassin†  
*†Admitted Texas and Louisiana*  
Intellectual Property Law

Mailing Address:  
P. O. Box 421479  
Houston, TX 77242-1479

May 12, 2003

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

BOX TTAB-FEE  
Commissioner For Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513



05-12-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Re: Answer To Opposition to Trademark Application Ser. No. 78/030,875

Dear Madam/Sir:

Enclosed please find an Answer and Counterclaim for Cancellation for filing in Opposition Number 91155801, in duplicate. Also enclosed is a check in the amount of three hundred dollars (\$300.00) pursuant to 37 C.F.R. 2.16 (a) in payment for the filing fee for the Cancellation.

06/10/2003 SWILSON1 00000144 78030875  
01 FC:6402 300.00 OP

I hereby certify that this correspondence is being deposited with the United States Postal Service as <sup>first class mail</sup> in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. May 12, 2003  
(Date of Deposit)

Christine M. Mamerow  
(Printed or typed name of the person Signing the Certificate)

(Christine M. Mamerow)  
Signature

5-12-2003  
Date of Signature

03 JUN 12 11 05 AM