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

Proceeding	91159871
Party	Defendant Servicios de Franquicia Pardo's S. A. C. Servicios de Franquicia Pardo's S. A. C. Avenida Dos de Mayo 1002 PEX Lima 27,
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Submission	Applicant's Surreply to Opposer's Reply to Applicant's Response To Opposer's Verified Emergency Motion For Leave To Take Oral Deposition For Use In Opposing Motion For Summary Judgment
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mario Diaz)	
)	
Opposer,)	
)	
v.)	Opposition No. 91159871
)	
Servicios De Franquicia Pardo's S.A.C.)	
)	
Applicant.)	

**APPLICANT'S SURREPLY TO OPPOSER'S REPLY TO APPLICANT'S RESPONSE
TO OPPOSER'S VERIFIED EMERGENCY
MOTION FOR LEAVE TO TAKE ORAL DEPOSITION FOR USE IN
OPPOSING MOTION FOR SUMMARY JUDGMENT**

Applicant, Servicios De Franquicia Pardo's S.A.C., through undersigned counsel, respectfully requests that the Board consider this Surreply to Opposer's Reply to Applicant's Response to Opposer's Verified Emergency Motion for Leave to Take Oral Deposition for use in Opposing Motion for Summary Judgment, pursuant to 37 C.F.R. § 2.127(a). Applicant believes this reply is necessary to address the claims made by Opposer in its reply brief.

Opposer, in its reply, alleges that Article 7 of the Pan American Convention ("Convention") requires the owner of a foreign mark to satisfy use requirements in the United States in order to meet the requirements of the Convention. Opposer appears to have construed the language in Article 7 which requires ". . .compliance with the requirements established by the domestic legislation. . ." as necessitating proof of use in commerce in accordance with the Lanham Act, 15 U.S.C. § 1126(d)(4), or proof of a bona fide intent to use. In fact, not only does the Convention not require evidence of use or a bona fide intent to use, it does not even require that the owner of the mark in the Contracting State of origin have an application pending in the other Contracting State.

Specifically, Article 7 provides in its entirety:

Any owner of a mark protected in one of the Contracting States in accordance with its domestic law, who may know that some other person is using or applying to register or deposit an interfering mark in any other of the Contracting States, shall have the right to oppose such use, registration or deposit and shall have the right to employ all legal means, procedure or recourse provided in the country in which such interfering mark is being used or where its registration or deposit is being sought, and upon proof that the person who is using such mark or applying to register or deposit it, had knowledge of the existence and continuous use in any of the Contracting States of the mark on which opposition is based upon goods of the same class, the opposer may claim for himself the preferential right to use such mark in the country where the opposition is made or priority to register or deposit it in such country, upon compliance with the requirements established by the domestic legislation in such country and by this Convention.

General Inter-American Convention for Trademark and Commercial Protection of Washington, Feb. 20, 1929, art. 7, 46 Stat. 2907, 2918, 2 Bevans 751, 754.

Opposer's interpretation of Article 7 or of the Convention generally is not supported by the language of the Article or of the Convention. Moreover, Opposer's interpretation is not supported by any case law or statute. Opposer has cited 15 U.S.C. § 1126(d)(4) and Buti v. Impresa Perosa S.R.L., 139 F.3d 98 (2d Cir. 1998) in his reply. Neither of these references relate to or involve the relief now being sought under the Convention.

15 U.S.C. § 1126(d)(4) prevents the owner of a U.S. registration based on a foreign registration to sue for infringement committed prior to the date of registration unless the registration is based on use in U.S. commerce. Applicant here is not suing for infringement or to stop the use of Opposer at this time. Applicant is simply seeking to assert its rights under the Convention to supersede Opposer as to priority.

Buti, similarly, does not address the application of the Convention, but rather involved a dispute as to whether advertising a mark in the United States constituted use in commerce for purposes of priority under the Lanham Act. Neither of Opposer's cited authorities provides

support for the position that use in U.S. commerce, or a bona fide intent to use in commerce, is required to establish priority in an opposition proceeding under Article 7 of the Convention.

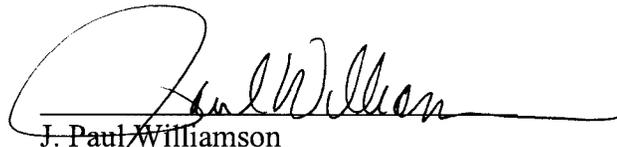
To the contrary, the Board has specifically held that the Convention is independent of the Lanham Act and is an exception to the doctrine of territoriality. See, British American Tobacco Co. v. Philip Morris Inc., 55 USPQ2d 1585 (TTAB 2000), aff'd British-American Tobacco Co. v. Philip Morris Inc., 2001 TTAB LEXIS 167 (TTAB February 27, 2001). Accordingly, Applicant submits that the requested discovery purporting to relate to Applicant's use of the PARDO'S CHICKEN mark in commerce or Applicant's bona fide intent to use the PARDO'S CHICKEN mark is not germane to issues raised by Applicant's Motion for Summary Judgment and Opposer's motion for discovery should therefore be denied.

Respectfully submitted,

SERVICIOS DE FRANQUICIA PARDO'S S.A.C.

Date: February 16, 2005

By:



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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing “Applicant’s Surreply to Opposer’s Reply to Applicant’s Response To Opposer’s Verified Emergency Motion For Leave To Take Oral Deposition For Use In Opposing Motion For Summary Judgment” was served upon Opposer’s attorney this 16th day of February, 2005, by first class mail, postage prepaid, as follows:

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