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

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

[redacted]

02-14-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #64

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

The Opposer, MARIO DIAZ, through undersigned counsel, respectfully requests that the Board exercise its discretion pursuant to 37 C.F.R. § 2.127(a) to consider this 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. In support of this Reply Opposer states the following:

The discovery requested is relevant to the Motion for Summary Judgment

Contrary to Applicant's position, its bona fide intent, or lack thereof, to use the mark in the United States is a genuine issue of material fact relevant to deciding its motion for summary judgment.

Article 7 of the IAC provides for priority of a foreign mark over a domestic user of an interfering mark when the domestic user had knowledge of the existence and continuous use of a foreign mark for a common class of goods **provided** that the registrant of the foreign mark can show **compliance with the requirements established by the domestic legislation of the country where the interfering mark is being used**. A foreign applicant seeking to register in

the U.S. a mark duly registered in a foreign country of origin must allege in the application a bona fide intention to use the mark in commerce, although the use shall not be required before registration. 15 U.S.C. § 1126(e). However, one of the requirements of U.S. law for the establishment of a trademark and any action thereupon is actual "use in commerce". See, 15 U.S.C. § 1126(d)(4), ("nothing in this subsection (subsection (d), entitled Right of Priority) shall entitle the owner of a registration granted under this section to sue for acts committed prior to the date on which his mark was registered in this country unless the registration is based on use in commerce."); Buti v. Impressa Perosa S.R.L., 139 F.3d 98 (2d Cir. 1998)(Lanham Act authorizes trademark registration only for marks that are "used in commerce")

In the context of restaurant services, "use in commerce" is defined by Section 45 of the Lanham Act as "bonafide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark...[A] mark shall be deemed to be in use in commerce...on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce." 15 U.S.C. § 1127. However, mere advertising of a restaurant trademark in the United States, standing alone, even though the restaurant trademark owner may be doing business under the mark in a foreign country, does not constitute use in commerce within the meaning of the Lanham Act absent proof that the trademark owner offered any restaurant services in the United States.. See, e.g., United Drug co. v. Theodore Rectanus Co., 248 U.S. 90,97, 39 S.Ct. 48, 50-51, 63 L.Ed.141 (1918); Buti, supra at 103; Linville v. Rivard, 41 U.S.P.Q. 1731, 1735-37, 1996 WL 795315 (TTAB 1997); Mother's Restaurants Inc. v. Mother's Other Kitchen, Inc., 218 U.S.P.Q. 1046, 1983 WL 51992 (TTAB 1983); Techex Ltd. v. Dvorkovitz, 220 U.S.P.Q. 81, 83, 1983 WL 51872 (TTAB 1983).

As such, under Article 7 of the Pan American Convention, as implemented by Section 44 of the Lanham Act, Opposer submits that the Applicant's bona fide intent to use the mark in the United States is a genuine, material fact which may defeat summary judgment. Applicant raised this issue in Mr. Wu's affidavit attached to its motion for summary judgment. Applicant is not permitted to register a mark merely to reserve it without a bona fide intent to use it in United States commerce. Opposer's motion to take discovery for use in preparing an opposition to Applicant's motion for summary judgment should be granted.

In addition, Opposer submits that an oral telephonic deposition should be allowed. The nonmoving party will not suffer any financial hardship. If Mr. Wu is not comfortable communicating in English, a translator will be required whether the deposition is taken orally or by written questions. Opposer will pay for the translator. Opposer's motion to take oral deposition of Mr. Wu should be granted.

Respectfully submitted,

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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed and Via Federal Express to: Assistant Commissioner for Trademarks, US Patent and Trademark Office, Madison East, Concourse Level, RM. C55, 600 Dulaney Street, Alexandria, VA 22314.

Date of Deposit: February 10, 2005

Name of Applicant, Assignee,
or Registered Representative: Robert J. Becerra

Signature: _____

Date of Signature: February 10, 2005

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February 10, 2005

VIA U.S. MAIL and FEDERAL EXPRESS

Assistant Commissioner for Trademarks
US Patent and Trademark Office
Madison East, Concourse Level, Rm. C55
600 Dulaney Street
Alexandria, VA 22314

RE: Pardo's Chicken, Inc. v. Servicios de Franquicia Pardo's SAC and Pardo's Chicken Corp.
CASE NO. 03-020220 CA (24)
Opposition No. 91159871

Dear Sir or Madam:

We are enclosing one original and two copies for filing in this action, of Opposer's Reply to Applicant's Response to Opposer's Verified Emergency Motion for Summary Judgment.

We also enclose an additional copy of this document, which we ask that you stamp "filed" and return to us in the envelope provided.

Sincerely,

SANDLER, TRAVIS & ROSENBERG, P.A.

By: Emily Rodriguez
Emily Rodríguez, Legal Assistant

/er
Enclosures
cc: Counsel of Record (via Federal Express)

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