

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

MARIO DIAZ

Opposer,

v.

Opposition N° 91159871

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

Serial N° 76/467468

Applicant.

**ANSWER TO NOTICE OF OPPOSITION,
AND AFFIRMATIVE DEFENSES**

Applicant, Servicios de Franquicia Pardo's S. A. C., a Peruvian corporation, domiciled at Avenida Dos de Mayo 1002, San Isidro, Lima, Peru, South America, hereby timely files its Answer to Opposition And Affirmative Defenses in response to the Notice of Opposition filed by Opposer. Applicant answers the specific allegations contained in Opposer's Notice of Opposition as follows:

Defenses

1. Applicant admits the allegation contained in paragraph 1 of the Opposition, that it has filed an application to register a service mark under international class 043, based on a foreign registration and it was published for

opposition on February 24, 2004 in the *Official Gazette*.

2. Applicant alleges that it is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 2 of the Opposition, and denies it.

3. Applicant denies the allegation contained in paragraph 3 of the Opposition.

4. Applicant alleges that it is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 4 of the Opposition, and denies it.

5. Applicant alleges that it is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 5 of the Opposition, and denies it.

6. Paragraph 6 is a statement regarding the filing of the Opposition to which no answer is necessary. To the extent that any response to this paragraph is required, Applicant admits partially the allegation made in paragraph 6 of the Opposition as to regards that the marks in sound are identical; and, denies the balance of the allegation.

7. Paragraph 7 is a statement regarding the filing of the Opposition to which

no answer is necessary. To the extent that any response to this paragraph is required, Applicant lacks sufficient information to either admit or deny the allegations in paragraph 7 and therefore denies those allegations.

8. Applicant alleges that it is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 8 of the opposition, and denies it.

Affirmative Defenses

As its affirmative defense to the Notice of Opposition, Applicant alleges as follows:

First Affirmative Defense

Applicant has been the sole owner of the Trademark "Pardo's Chicken" since 1998, when the Republic of Peru authorized the assignment of its legally binding Registration. Since then, Applicant has registered such trademark in Bolivia, Chile, Ecuador, Colombia, Mexico, Panama and Spain. On basis of its registration in Peru is that the Applicant filed its application before the USPTO.

Second Affirmative Defense

Opposer, is a male, full of age, and, as declared by him in his application for an identical trademark like the one owned by Applicant, is a Peruvian individual. That is to say, he was born in Peru. Therefore, he is familiar with the Peruvian Trademark "Pardo's Chicken" and its immense presence in the local market. The trademark in

Peru has been used since 1986 in "Pardo's Chicken" restaurants and its advertising campaigns.

Third Affirmative Defense

Opposer filed an application to register the trademark "Pardo's Chicken" in November 2002 and the mark that he filed was identical to the one owned by Applicant in Peru and elsewhere. Weeks after Opposer filed his application for registering under class 043 (restaurants) the trademark "Pardo's Chicken" under his name, the styled in the mark was deleted and applied in "standard character form." This proves that Opposer knew for a fact of the existence of the Peruvian trademark or else he would not have made said change.

When Opposer filed his application (Serial Number 76467713) the mark was described as "stylized form."

Fourth Affirmative Defense

On or about November 2002, two letters were sent to Opposer by regular mail, one addressed to his home address (same as address used by him in his applications to the USPTO) and the second to the current business in Miami. The letter sent to his home address was received and the second was returned to Applicant, the one sent to his business address. This envelope will be provided as evidence to the Court.

Applicant's intention with these letters was to try to avoid any confrontation and try to reach an amicable solution.

Fifth Affirmative Defense

Opposer cannot allege lack of knowledge or good faith because, since 2002, Applicant has been trying to contact Opposer in order to avoid any future misunderstanding. Also, on or about July 2003, two letters were sent via - registered mail, return receipt requested - . Only one was returned, the one sent to his home address.

Sixth Affirmative Defense

Applicant has been using the trademark for more than five years outside United States of America, and has begun an advertising campaign all over the country.

Seventh Affirmative Defense

Applicant has been using the trademark "Pardo's Chicken" in the United States of America since the year 2000. When Applicant launched an Internet advertising campaign, which included web site presence, from servers located inside The United States of America. Since then, the trademark has been used permanently on the Internet.

Eight Affirmative Defense

Opposer seems to own a small restaurant in which he is using the "Pardo's Chicken" trademark, a restaurant which has not been in operation for long. Definitely not long enough as to claim damages, since Opposer knew that Applicant has been trying to prevent events like this to occur.

Ninth Affirmative Defense

If Opposer changes the name of its restaurant, no harm will be done since it is a small business. Apparently, with few weeks of operations. However, the Applicant, cannot accept the use of its international trademark by third parties which are not properly entitled to use it and that do not follow the requirements and the regulated licensing terms of the business.

Tenth Affirmative Defense

Applicant believes that no damage can be claimed when whomever claims it has been well aware of the issues related to the matter.

Eleventh Affirmative Defense

Applicant's prestigious reputation is very well known all over Latin America where its name (trademark) is sought after by sound businessmen and investment companies. Applicant has spent close to twenty years in building a strong and solid brand awareness around the "Pardo's Chicken" trademark and cannot allow the brand to be jeopardized because of a third party action.

Twelfth Affirmative Defense

Opposer, a Peruvian individual, is well aware of the high value and market presence of the "Pardo's Chicken" trademark. He is also aware of its brand recognition among the Peruvian communities within The United States of

America. The Opposer in question is seeking the registration of a mark that cannot be registered in his name (individually), if we apply the common law. If we apply the current regulations, his application for registration and his Opposition have to be denied because the trademark has an owner, an owner who has applied for the recognition of its trademark under Federal Law, § 44(e) (15 U.S.C. § 1126) since The United States of America and The Republic of Peru are signatories of the same Treaty.

WHEREFORE, Applicant requests that this Opposition proceeding be dismissed and that its application for registration be allowed to proceed.

Respectfully submitted,

Dated: April 30, 2004

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



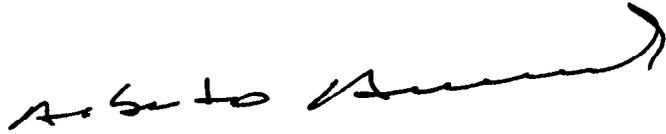
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Domestic Correspondent for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the Servicios de Franquicia Pardo's S. A. C. Answer to Notice and Affirmative Defenses was served by First Class Mail, postage prepaid, on this 30th day of April 2004, on the following:

Edward M. Joffe, Esq.
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ATTORNEYS FOR OPPOSER



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05-03-2004

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BOX TTAB

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

TRANSMITTAL

Please find Applicant's timely file Answer to Notice of Opposition and
Affirmative Defenses in the above- matter.

Respectfully submitted,

Dated: April 30, 2004

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