

ESTTA Tracking number: **ESTTA590910**

Filing date: **03/05/2014**

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

Proceeding	91205076
Party	Defendant Rafael Robert Vargas
Correspondence Address	JON JEKIELEK JEKIELEK & JANIS LLP 153 WEST 27TH STREET, SUITE 204 NEW YORK, NY 10001 UNITED STATES jon@jj-lawyers.com
Submission	Brief on Merits for Defendant
Filer's Name	Jon D. Jekielek, Esq.
Filer's e-mail	jon@jj-lawyers.com
Signature	/Jon D. Jekielek/
Date	03/05/2014
Attachments	Applicant's Trial Brief.pdf(562581 bytes)

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

U.S. Application Serial No.: 85480930
Mark: FULANITO
Filed: November 25, 2011
Published: May 8, 2012

-----X
WINSTON ROSA,
Opposer,

-against-

Opposition No.: 91205076

RAFAEL ROBERT VARGAS,
Applicant.

-----X

APPLICANT’S TRIAL BRIEF

Pursuant to 37 C.F.R. §§ 2.126 and 2.128, Applicant, Rafael Robert Vargas (“Applicant” or “Vargas”) timely submits Applicant’s Trial Brief in support of its defense to this Opposition proceeding that has been brought by Winston Rosa (“Opposer”).

TABLE OF CONTENTS

I.	INTRODUCTION.....	3
II.	DESCRIPTION OF THE RECORD.....	4
III.	EVIDENTIARY ISSUES.....	4
	A. Deposition of Sam Serraty.....	4
	B. Purported Service of Exhibits A- L.....	5
	i. Failure to File Proof of Service.....	5
	ii. Failure to Serve Notice of Reliance.....	6
IV.	STATEMENT OF ISSUES.....	7

V. FACTS.....7

VI. ARGUMENT.....8

VII. CONCLUSION.....12

TABLE OF AUTHORITIES

CASE LAW

Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.,
13 USPQ2d 1307 (TTAB 1989);6

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992).....8

Safer, Inc. v. OMS Investment, Inc. 94 USPQ2d 1031 (TTAB 2010).....8

FEDERAL STATUTES

15 U.S.C § 1052(d).....3

FEDERAL REGULATIONS

37 CFR § 2.119(b).....4,6

37 CFR § 2.122(e).....6

37 CFR 2.123(c)4

37 C.F.R. § 2.128.....5

I. INTRODUCTION

At issue in this Opposition proceeding is whether the Applicant is the owner of the “Fulanito” trademark (the “Mark”). The Opposer submits that the Applicant is not the owner, but rather that the Applicant is a co-owner of the Mark, along with the Opposer as a member of the band “Fulanito” and in connection with their joint ownership of the company Windose International. The Opposer’s basis for opposition the registration of the Mark is that (a) the Opposer is a fifty (50%) owner of the Mark; (b) that if the Applicant is allowed to register the mark the public will be confused; (c) there have been four to five members in the band “Fulanito” in the past; and (d) the Opposer will suffer harm due to the fact that he will not be able to use the Mark for his own purposes. In his trial brief the Opposer goes on to accuse the Applicant of committing fraud as a result of his attempt to register the Mark in his individual capacity. All of the above reasons do not amount to a statutory ground for opposition of Applicant’s registration, but are could be considered to support the Opposer’s opposition of the registration based on 15 U.S.C § 1052(d), a likelihood of confusion.

The Opposer has failed to meet its burden of proof that the applicant is not entitled to register its mark on the grounds that its registration will cause a likelihood of confusion, as the Opposer has failed to show, by a preponderance of the evidence that prior rights through ownership of a registration, prior use of an unregistered mark or a trade name, or earlier use analogous to a trademark. As a result thereof, the Opposer’s opposition to the Applicant’s registration should be denied.

II. DESCRIPTION OF THE RECORD

The discovery period opened on October 27, 2012 and closed on April 25, 2013. The last date for Plaintiff's rebuttal period ended on November 6, 2013. (See Order dates August 27, 2012). The record in this case consists of:

- 1) Opposer's trial testimony deposition of Jose Arsenio Rosa Caba a.k.a. Arsenio El Maestro De La Rosa and all exhibits annexed thereto;
- 2) Opposer's trial testimony depositions of Joseph Rosa and all exhibits thereto;
- 3) Opposer's trial testimony depositions of Samuel Serraty and all exhibits thereto.
- 4) Documents submitted by the Opposer marked as Exhibit's A-L

III. EVIDENTIARY DISPUTES

A. DEPOSITION OF SAMUEL SERRATY

As a result of technical issues, counsel for the Applicant was unaware of this deposition at the time a previous motion to strike was file with respect to the deposition of Caba Rosa. The entire file did not download and counsel was unaware that this testimony was on record, therefore, this limited procedural application is being raised at this time.

On June 6, 2013 the Opposer served upon the Applicant a document stylized as a "Witness List for USPTO Opposition No. 9120576." See Documents 14 and 15. This list did not include or identify Samuel Serraty as a potential witness in connection with the Opposition proceeding now before the TTAB. Pursuant to 37 CFR 2.123(c), bbefore the

depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs.

As the Opposer did not provide any such notice to the Applicant in connection with its deposition of Mr. Serraty, Mr. Serraty's recorded testimony, in its entirety and any and all exhibits annexed thereto are inadmissible and should not be part of the record and/or considered by the TTAB when making its decision as to the outcome of this opposition proceeding.

B. EXHIBITS A-L PURPORTEDLY SERVED ON MAY 8, 2012

As there are no motions in limine in connection with a TTAB proceeding, the Applicant raises these issues with respect to pages 61-70 of Document 17 on this brief.

i. Failure to Provide Proof of Service.

When filing its recorded trial testimony, on July 31, the Opposer also filed a series of documents marked as Exhibit A – L, each of which has a comment or description at the top of it. The Opposer also submits a screen shot of an email that states at the top of it in his handwriting “Proof of Service of Exhibits was sent to defendant via email” See document 17, page 61. It is difficult to ascertain the date these documents were allegedly served upon the Defendant, but it appears they were filed in May 8, 2012, although there they do not appear in the Opposition History along with the Opposer's original Opposition filed on May 8, 2012. While there is a proof of service filed by the Opposer in

connection with the recorded trial testimony (See Document 16) taken by the Opposer, there is no additional proof of service filed with respect to the Exhibits these documents.

Every paper filed in the United States Patent and Trademark Office in connection with the opposition, (including the notice of opposition effective November 1, 2007), must be served on the other party. Proof of such service must be made before the document will be considered by the Board. A statement signed by the attorney or authorized representative on the document or attached to the document, stating the date and manner of service will be accepted as *prima facie* proof of service. [37 CFR §2.119]. Furthermore, email is not an accepted form of service unless consented to in writing by and between the parties. Therefore, as no proof of service which meets the criteria set forth by the rules of procedure applicable to TTAB proceedings has been filed by the Opposer, and it is apparent that any purported service was done by and through email, Exhibits A-L are not admissible as part of the trial record.

ii. Failure to File Notice of Reliance

To the extent that the Board does find that Exhibits A-L, as provided for above, were properly served upon the Applicant, these documents nevertheless cannot be made a part of the Opposer's trial record unless they were admitted into evidence by and through the filing of a Notice of Reliance. 37 CFR § 2.122. It is clear from a review of Exhibit's A-L that these documents were obtained and printed off of the Internet. In *Safer, Inc. v. OMS Investment, Inc.* 94 USPQ2d 1031 (TTAB 2010) , the Board chanted its practice regarding Internet evidence, holding that a document obtained from the Internet may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with 37 CFR 2.122(e). Here, the

Opposer, took no formal approach to introducing Exhibits A-L, pages 61-70 of Document 17, including but not limited to a by filing a Notice of Reliance. As there were no initial disclosures served by the Opposer and no discovery conducted during the discovery period, the Opposer must introduce these documents by and through a Notice of Reliance. As a result of the foregoing, Exhibits A-L should not be made a part of the trial record and should not be considered by the Board when making its decision on this matter.

IV. STATEMENT OF ISSUES

Whether Opposer has met the burden of proof necessary to prove that it is the owner of the Mark through (a) ownership of a registration; (b) through prior use of an unregistered mark or a trade name; (c) or earlier use analogous to a trademark?

V. FACTS

In or around 1995, the Applicant, Opposer wrote and performed songs together, with the agreement that the Applicant would be the lead singer. In 1997 when a record deal was reached with Cutting Records, the Applicant created the name "Fulanito", which was approved by the record label and the Opposer for use in connection with the album released by Cutting Records in 1997. No one else was involved in the creation of the use of the Mark in commerce. At no time did the Applicant assign the Mark or any interest therein to the Opposer. The Applicant has continued to use the Mark in commerce from inception to date and remains the lawful owner.

**VI. ARGUMENT The Opposer Has Failed to Show by a
Preponderance of the Evidence that he is
the Owner of Mark Through its Prior Use**

The Opposer, in the position of plaintiff, has the burden to prove that the applicant is not entitled to register its mark. The burden of proof is generally "a preponderance of the evidence" in *inter partes* cases. *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992).

In the instant matter, the Opposer must offer proof that supports its claim that it is a Fifty (50%) Percent owner in and to the mark. As the Opposer cannot offer a prior registration, a written assignment or other documents which provides ownership in and to the Mark, he has provided testimonial evidence of three of his family members, his father, brother and cousin. There is no dispute that the Mark was originated in or around 1997. There is also no dispute that both the Applicant and Opposer were members of the band Fulano De Tal, which changed its name to Fulanito. Where the dispute lies is in who created the Mark and began using it in commerce. The Applicant submits that he was always and is the lawful owner of the Mark, and that any and all other members of the performing group were contracted as works for hire and/or independent contractors. The members of the group, other than the Applicant were interchangeable and the Applicant has continued to use the Mark as a solo artist since in or around 2004.

The evidence offered by the Opposer offer to support its claim of ownership is not sufficient. In fact, it acts to the contrary. In its Notice of Opposition, the Opposer claims he is a 50% owner of the Mark, but then in his trial brief, the Opposer's states that his father, Caba Rosa first came up with the name Fulanito. Caba Rosa offers conflicting

testimony, stating that he and his son, Winston Rosa, first came up with the name Fulanito. Furthermore, a review of the rest of Caba Rosa's testimony supports the Applicant's claims for registration, he provides no actual testimony that the Opposer was actually using the Mark in commerce prior to the Applicant, rather he confirms that the Applicant was an original member of Fulanito. At best, the testimony of Caba Rosas shows a contemporaneous/concurrent use of the Mark by the Opposer and Applicant, however as it is the same mark that is at issue here, the burden of proof is on the Opposer to show evidence of its prior use. Additionally Exhibits presented to Caba Rosa are all related to a time period well after the Mark had been created and do not go to ownership of the Mark, and therefore should not be considered by the Board in making its determination as to ownership.

With respect to the testimony provided by Joseph Rosa, first and foremost, he is the older brother of Winston Rosa and he is not a member of, nor ever was a member of Fulanito. Joseph Rosa's testifies that "he started working for Windose International in 1998." See Page 4, Lines 2-3. However, Fulanito was created and being used in commerce as early as 1997 as supported by the copyright certificate annexed to Joseph Rosa's deposition transcript as Exhibit J, which states clearly and unequivocally that the Fulanito album "El Hombre Mas Amoso De La Tierra was published at the end of 1997. This is significant as it takes months to create an album and it shows that Fulanito was established in 1997. It can be deduced from these facts that hat Joseph Rosa, as stated by was not working with Fulanito at the time of its inception, and he does not have any personal knowledge as to who created the name Fulanito, or what the Applicant and

Opposer agreed to with respect to the name Fulanito and the ownership of that intellectual property.

Furthermore, Joseph Rosa does not provide any specific testimony as to who created the mark Fulanito, nor does he provide any testimony that goes to proof of ownership of the Mark. When asked by the Opposer who is accredited with first using the name Fulanito, he responded with uncertainty that it as “I would say Winston Rosa and Jose Arsenio Rosa”. See Page 5, Lines 22-23. He did not recall where he heard this information, stating that he heard it at “parties or gatherings.” See Page 5, Line 25.

Finally, with respect to the testimony of Samuel Serraty, who is the cousin and employee of the Opposer, it is also irrelevant to the issues before the Board. Mr. Serraty testifies that he started working for Windose in 1999. See Page 3, Lines 17-20. He merely confirms something that is undisputed, Rafael Vargas was a member of Fulanito in 199 and makes an inference that Mr. Vargas was an owner of Windose. The Applicant does not dispute these facts. Mr. Serraty has no personal knowledge as to who created the Mark or who used in first in commerce. Again, he testifies vaguely that he heard Winston Rosa created the name Fulanito at “parties”. See Page 5, Lines 17-2. Additionally, Mr. Serraty testifies that he met up with the Opposer in 1998, which is when he first learned of Fulanito. *Id.* r. Serraty was not there when Fulanito was created in 1997 and had no knowledge of the facts and circumstances surrounding its creation.

The majority of the witnesses’ testimony before the Board states that Fulanito was created by the Opposer and deals with the use of the Fulanito mark well after its creation. However, none of these individuals were in the group Fulanito, employed by its members or even involved with the group in 1997, when Fulanito was formed and therefore their

testimony does not prove the Opposer is the creator, owner or that he had an ownership interest in the Mark. Additionally, an examination of the Exhibits and record shows clearly that both parties have been and are using the Mark in commerce. There is no dispute that the Mark was being used in commerce, by both parties since 1997, and the record (if considered by the Court) shows the use of the Mark by both the Applicant and Opposer. However, as there is no written agreement between the parties which clearly states that the issue before the Board is that of ownership, and there is only one owner, the creator of the Mark, Rafael Vargas.

Finally, with respect to two of the Exhibit's offered into evidence by the Opposer, Exhibit I is not proof of ownership or creation, rather that the Opposer was a member of Fulanito from the start, which is not disputed by the Applicant. Applicant does not state that Opposer owns the mark or that it belongs to the band, he was making an attempt to resolve a dispute without having to incur the cost and expense of litigation. With respect to Exhibit J, this is merely evidence that both Applicant and Opposer recorded music under the name Fulanito together in 1997. This again is not disputed, but it does not speak to the creation or ownership of the Mark.

CONCLUSION

Based on the foregoing, fact and law, the Board should deny the Opposer's opposition to the Applicant's registration of the Mark in its entirety and allow the Applicant to proceed with the registration of the Mark.

Dated: New York, NY
March 5, 2014

Respectfully submitted,

JEKIELEK & JANIS, LLP

By: 

Jon D. Jekielek, Esq.
153 West 27th Street, Ste. 204
New York, New York 10001
Tel: (212) 686-7008
Fax: (646) 657-3265
Jon@jj-lawyers.com

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the document entitled APPLICANT'S TRIAL BRIEF was sent on March 5, 2014 by e-mail and first class mail the Opposer, Winston Rosa, at the following address:

✓
Certified (JDS) 3/5/14

Mr. Winston Rosa
2190 Boston Road
Apartment 3-J
Bronx, NY 10462

Dated: March 5, 2014

JEKIELEK & JANIS, LLP

By: 

Jon D. Jekielek, Esq.
153 West 27th Street, Ste. 204
New York, New York 10001
Tel: (212) 686-7008
Fax: (646) 657-3265
Jon@jj-lawyers.com

Attorneys for Applicant