

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 27, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Winston A. Rosa*

*v.*

*Rafael Robert Vargas*  
—

Opposition No. 91205076  
against Serial No. 85480930  
—

Winston A. Rosa, *pro se*.

Jon Jekielek of Jekielek & Janis LLP, for Rafael Robert Vargas.  
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Before Bucher, Mermelstein and Bergsman,  
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Rafael Robert Vargas, a U.S. citizen and resident of Miramar, FL (“Applicant”) seeks registration on the Principal Register of the following mark:



The image shows the word "Fulanito" in a highly stylized, golden, cursive font. The letters are thick and have a metallic, 3D appearance with highlights and shadows. The word is underlined with a thick, double-lined golden bar.

for services recited as follows:

arranging and conducting of concerts; audio recording and production; concert booking; entertainment in the nature of live stage performances in the nature of concerts in the field of music by an individual; entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings; entertainment services in the nature of live musical performances; entertainment services in the nature of presenting live musical performances; entertainment services in the nature of recording, production and post-production services in the field of music; entertainment services in the nature of music performances; entertainment services, namely, dance events by a recording artist; entertainment, namely, live music concerts; entertainment, namely, live performances by a musical band; live performances by a musical group; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events, in International Class 41.<sup>1</sup>

Winston A. Rosa (“Opposer”) has opposed this application on the ground that Opposer and Applicant are co-owners of the **FULANITO** mark. *See* Section 1 of the Lanham Act, 15 U.S.C. § 1051 (“The *owner* of a trademark used in commerce may request registration of its trademark ...”) (*emphasis* supplied). Applicant denied the salient allegations of the notice of opposition and asserted that he created this mark

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<sup>1</sup> Application Serial No. 85480930 was filed on November 25, 2011, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as November 20, 1997.

and is the sole owner thereof. During the majority of this opposition proceeding, both parties proceeded *pro se*.<sup>2</sup> Both parties filed trial briefs.

## I. Evidentiary Issues

Before proceeding to the merits of this opposition, we must address a variety of evidentiary issues.

Under the amended trial schedule of August 27, 2012, Opposer's thirty-day trial period was to end on July 24, 2013. Opposer served his notice of taking of testimony of twelve witnesses on applicant on June 6, 2013, but did not file it until July 30, 2013.<sup>3</sup> The notices' attached "Witness List" includes the names of twelve individuals<sup>4</sup> from among whom Opposer apparently intended to take testimony on the evening of July 9, 2013 – a date within Opposer's thirty-day trial period – at the offices of Diamond Reporting in the Bronx, New York. Opposer ultimately only took the testimony of Jose Caba Rosa (Opposer's father), Joseph Rosa (Opposer's

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<sup>2</sup> Opposer filed his original Notice of Opposition on May 8, 2012, and has been operating *pro se* to the present. Applicant filed his answers and other motions *pro se* before hiring his current counsel around August 2013.

<sup>3</sup> 15 TTABVue at 6 of 6. As filed with the Office, they included *prima facie* proof of timely service under Rule 2.119(a).

<sup>4</sup> These twelve names were (1) Jose Arsenio Rosa Caba, a/k/a Arsenio El Maestro De La Rosa (Opposer's father); (2) Aldo Marin (Label Owner/ Producer/Editor with Cutting Records); (3) Jurgen Korduletsch (Owner of Radikal Records); (4) Salvador Martinez (Promoter at SMP Music); (5) Martha Lopez (Billboard Magazine Rep/Sony Music Rep/Musical Rhythms Promotions President); (6) Rafael Reyes (Producer/Artist/Show Promoter); (7) Joselito Jimenez (Club Promoter/Record Label Exec); (8) Robert Lazarga (Discothèque Owner/Dee Jay); (9) Marino Paredes (Original Fulanito Group Member); (10) Joseph K. Rosa (Opposer's brother / Keyboard Player / Musician) (11) Ney Pimentel (Web Site Designer for www.Fulanito.com) and (12) John D. Nardone (Accountant for WinDose Inter., a production company jointly owned by Opposer and Applicant). See 15 TTABVue at 3-5 of 6.

brother), and Samuel Serraty (Opposer's cousin), and filed these three testimony transcripts with the Office on July 31, 2013.<sup>5</sup>

A. The Testimony of Samuel Serraty

Applicant alleges that Opposer did not provide him with notice of the deposition of Mr. Serraty, and that this testimony should be excluded in its entirety. The name of Samuel Serraty is not among the twelve names on Opposer's "Witness List." Inasmuch as Opposer failed to provide any notice to Applicant that the testimony deposition of Mr. Serraty was to be taken, this testimony<sup>6</sup> and any exhibits attached thereto<sup>7</sup> are deemed inadmissible and have not been considered in reaching our decision herein. By contrast, Applicant does not seek to exclude Opposer's testimony depositions of Jose Arsenio Rosa Caba, a/k/a Arsenio El Maestro De La Rosa (Opposer's father) or Joseph K. Rosa (Opposer's brother).<sup>8</sup>

B. Opposer's Exhibits A through L

Opposer attached to the three transcripts of testimony a series of documents marked as Exhibits A through L, each of which has a comment or description at the top of it.<sup>9</sup> Applicant objects to these documents for two reasons: (i) Opposer

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<sup>5</sup> Although testimony must be taken during a party's assigned testimony period, it need not be filed prior to the close of that period, *See* Trademark Rule 2.125(a) & (c).

<sup>6</sup> 17 TTABVue at 40-60 of 70.

<sup>7</sup> On the other hand, we note that all of the referenced Serraty exhibits were also introduced during the testimony depositions of Messrs. Rosa.

<sup>8</sup> 17 TTABVue at 2-39 of 70.

<sup>9</sup> 17 TTABVue at 61-70 of 70.

failed to provide proof of service; and (ii) Opposer failed to file a Notice of Reliance.

While Applicant acknowledges that Opposer included valid proof of service in connection with the recorded trial testimony of Messrs. Rosa, Applicant argues that there was no separate filing and proof of service with respect to these exhibits. However, inasmuch as the testimony identifies and refers to the attached Exhibits, and the Board's copy includes the exhibits, we must presume that these Exhibits actually accompanied the testimony deposition transcripts of July 9 sent to Applicant via FedEx on July 25, 2013. Otherwise, it was incumbent upon Applicant to raise this issue immediately so that it could have been cured in a timely manner.

As to their admissibility, although Applicant treats all twelve of these exhibits as if they were Internet materials, we note that Exhibits A, B, D, E and K are not Internet pages, and were appropriately authenticated by the deponents. It is correct that the balance of these dozen documents introduced during the testimony of Messrs. Rosa on July 9, 2013 were obtained and printed from the Internet, and were never filed via a Notice of Reliance.

Applicant takes the position in its appeal brief that Opposer must introduce these documents by and through a Notice of Reliance, citing to *Safer, Inc. v. OMS Investment, Inc.* 94 USPQ2d 1031 (TTAB 2010). Applicant is correct that this Board in *Safer* did change its practice regarding Internet evidence, namely holding that a document obtained from the Internet may be admitted into evidence pursuant to a Notice of Reliance

in accordance with 37 CFR 2.122(e) in much the same manner as a printed publication in general circulation. However, *Safer* does not hold that a Notice of Reliance is the *only* way to introduce Internet evidence. Rather, such evidence may also be introduced into evidence through the testimony of a person who can properly authenticate and identify the materials, including the nature, source and date of the materials.

Accordingly, here is a summary of our findings as to admissibility and probative value of the information contained in these documents:

As noted above, Exhibits A, B, D and E are promotional posters about which deponents testified, and they are deemed admissible. Similarly, Exhibit K is a Cease and Desist letter dated June 3, 2010, and sent to Applicant by Opposer's attorney, and is deemed admissible because it involves the records of a regularly conducted activity. Exhibit J is a Library of Congress summary page of Copyright Ownership, [cocatalog.loc.gov/](http://cocatalog.loc.gov/). Although undated, we presume this shows that the Copyright records once contained information showing Applicant's and Opposer's joint authorship of this musical recording, and is admissible because it is a public record. Exhibit L is a copy of an official business record from the State of New Jersey. While this is an undated screen-print, the Business Registration Certificate (issued on March 26, 2013), refers to a partnership between Applicant and Opposer, effective as of January 1, 1998, having the trade name of "WinDose International," and this is admissible because it too is a public record.

The remaining documents are Internet materials for which the *pro se* Opposer conducted all the searches on the Internet and was also the interrogator at the depositions. In no case did he focus on detailed identification of the document, the date it was searched and printed, or other details discussed in *Safer*. On the other hand, Applicant did not object to these documents on these bases. In any case, Exhibit G, on its face, showed it was accessed on April 22, 2013, by Winston Rosa with a definite URL on the Amazon.com website. Exhibit I is a screen-print of a facebook.com page said to be posted June 3, 2010, allegedly posted by Applicant on Opposer's Messenger board, but having no other information about the actual date this screen-print was taken. Given that this message was posted on the same date as Opposer's Cease and Desist letter (Exhibit K), it is entirely possible that the Cease and Desist letter prompted this plea to Opposer by Applicant that the parties avoid an expensive legal battle. This document is admissible because of Applicant's statements about the ownership of the "Fulanito" mark. Fed. R. Evid. 801(d)(2).

On the other hand, under the guidance of the *Safer* decision, we find that Exhibits C, F and H are inadmissible under any reading of the facts. While Exhibit C is labeled by Opposer as a promotional banner, it appears to be drawn from the Internet, likely Facebook, having an entry dated February 15, 2012, for an upcoming performance by Opposer on March 17, 2012. Exhibit F refers to a single track of an album attributed to "FULANITO 740" that Opposer allegedly recorded under contract with RADIKAL RECORDS Inc. in 2012, having an image

drawn from an iTunes Store page without URL, date, etc. Finally, Exhibit H purports to be Opposer's first tweet on his new twitter account (@FULANITO) on September 13, 2007, although again there is no URL or date, etc. In each of these cases, the witness was unable to identify or authenticate the source of the document. Moreover, even if these documents had been authenticated, the information contained in them would still be inadmissible as hearsay.

## **II. Applicable Law for Ownership Disputes**

In order to resolve the prototypical dispute over the ownership of a single, indivisible trademark (e.g., when a band breaks up), we are wont to turn to a framework suggested several years ago in a legal periodical "Who owns the mark? A single framework for resolving trademark ownership disputes,"<sup>10</sup> A useful modification of the *Wrist-Rocket*<sup>11</sup> factors is summarized in this article as follows: (a) which party invented and first affixed the mark onto the product/service; (b) which party's name appeared with the trademark on packaging and promotional materials; (c) which party maintained the quality and uniformity of the product, including technical changes; (d) which party does the consuming public believe stands behind the product, e.g., to whom customers direct complaints; (e) which party paid for advertising; and (f) what a party represents to others about the source or origin of the product.

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<sup>10</sup> Pamela S. Chestek, 96 *TRADEMARK REPORTER* 681 (2006).

<sup>11</sup> *Wrist-Rocket Manufacturing Co. v. Saunders*, 379 F. Supp. 902 (D. Neb. 1974), *aff'd in part and rev'd in part*, 516 F.2d 846, *cert. denied*, 423 U.S. 870, 96 S. Ct. 134, 46 L. Ed. 2d 100 (1975).

### III. The Story of “Fulanito”

The preponderance of the evidence in the record points to Opposer’s father – Jose Arsenio Rosa Caba, a/k/a Arsenio El Maestro De La Rosa, a legend on the accordion and an early promoter of Dominican Merengue Tipico music – as the originator of the name “Fulanito.”<sup>12</sup> In any case, Opposer’s father testifies that he founded the group along with Opposer and Applicant in 1997/1998.<sup>13</sup>

A number of other family members and close friends have continued to play a key role in various iterations of the group since then.<sup>14</sup> In addition to the founding three, the record shows other musicians named Joseph K. Rosa (Opposer’s brother and keyboard player); Jose Rafael “Pickles” Fuentes; Samuel “El Gran Matador” Serraty (Opposer’s cousin); Marino Paredes; and Danny Fuentes.

All of the following Fulanito album covers – with the notable exception of Applicant’s 2007 release (supplied with a red star below)<sup>15</sup> – uniformly demonstrate the fact that the Fulanito ensemble is consistently represented as four, five or six men (and all wearing matching suits and fedoras), in original releases<sup>16</sup> and remixes/re-releases,<sup>17</sup> dating from 1997 to 2010:

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<sup>12</sup> In his brief, Opposer suggests that *Fulanito* is a slang expression sometimes used by Latinos to describe an unknown person, e.g., not unlike the English language expression “*John Doe*.”

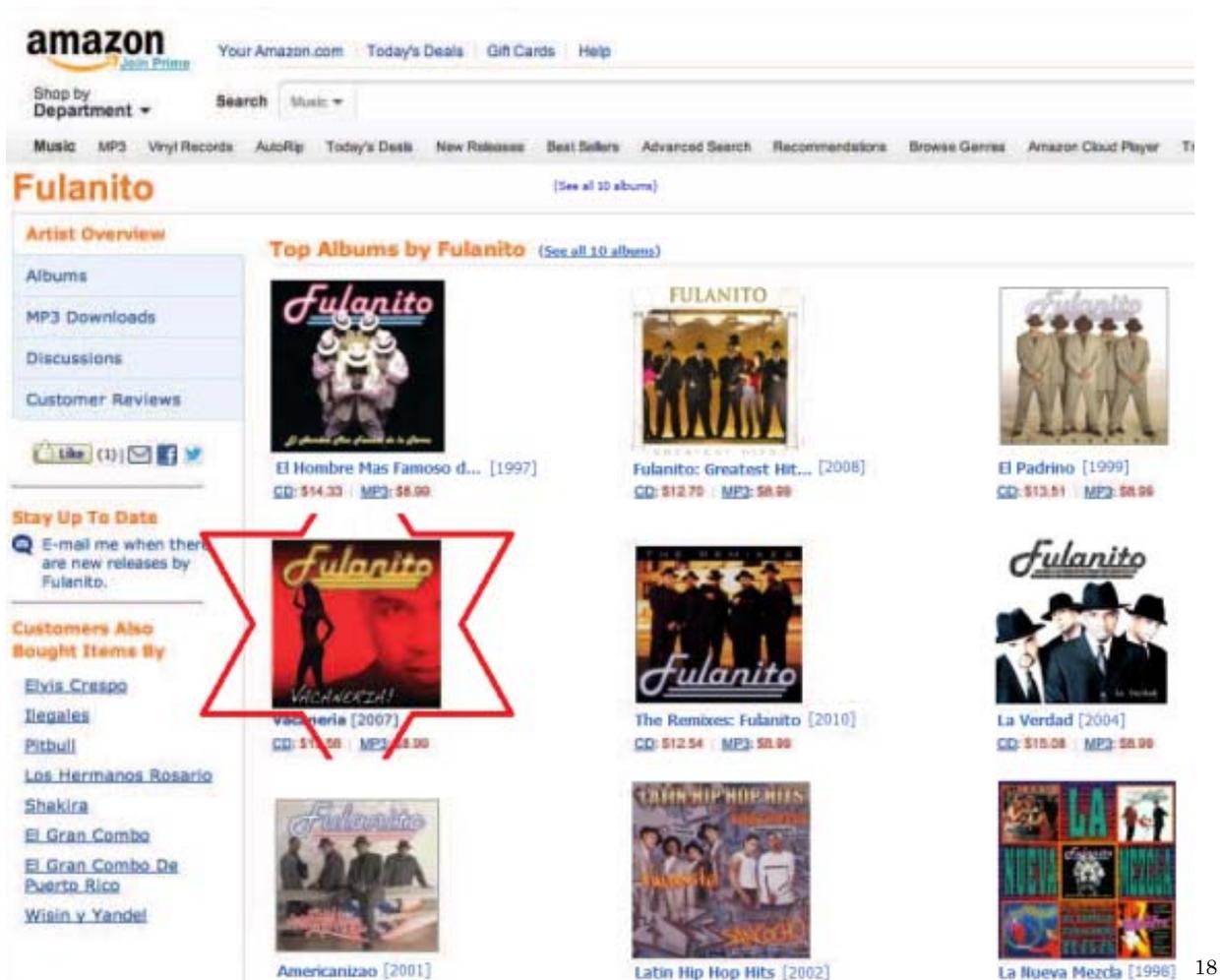
<sup>13</sup> C. Rosa testimony at 4, 17 TTABVue 5 of 70.

<sup>14</sup> *Id.* at 4-9; J. Rosa testimony at 4-12, 17 TTABVue at 18-26 of 70.

<sup>15</sup> “Vacaneria” (2007).

<sup>16</sup> “El Hombre Mas Famoso de la Tierra” (1997); “La Nueva Mezcla” (1998); “El Padrino” (1999); “Americanizao”(2001); “Latin Hip Hop Hits” (2002); and “La Verdad” (2004).

<sup>17</sup> “Fulanito: Greatest Hits” (2008); and “The Remixes: Fulanito” (2010)



Even before the Fulanito group, Opposer and Applicant were founding members of bands known as “2 in a Room” and “740 Boyz.”<sup>19</sup> At roughly the same time as the beginnings of Fulanito, Opposer and Applicant also formed their own musical production company known as “WinDose” – taken from a combination of Opposer’s (Winston’s) nickname of “Big Win,” and Applicant’s stage name, Rafael “Dose” Vargas.<sup>20</sup> The copyright registration reveals that Fulanito’s 1997 recording of “El

<sup>18</sup> J. Rosa testimony at 11-12, and Exhibit G, 17 TTABVue at 25-26, 66 of 70.

<sup>19</sup> C. Rosa testimony at 5, J. Rosa testimony at 3-4, 17 TTABVue 6, 17-18 of 70.

<sup>20</sup> J. Rosa testimony at 4-5, 18-19, Exhibit L, 17 TTABVue 18-19, 32-33, 70 of 70.

Hombre Mas Famoso de la Tierra” credited authorship to Rafael Vargas (performance) and Winston Rosa (recording). In fact, Applicant as lead singer and Opposer as a performing musician who later did the engineering and production of the musical recordings seemed to be the general division of labor until Applicant decided to leave the group. Since going solo around 2004, Applicant has apparently performed and recorded fairly successfully as a solo act, calling himself “Fulanito.”<sup>21</sup> As is often the case in such splits, Opposer continued to appear in concert (always along with other family members and friends), also performing as “Fulanito.” As to the style of presentation of the word “Fulanito,” we note that both Opposer and Applicant, together for years, and separately since 2004, have actually used, and continue to claim rights in, exactly the same marquee style of lettering, presented in a variety of neon or contrasting colors:



<sup>21</sup> C. Rosa testimony at 5, J. Rosa testimony at 3-4, 17 TTABVue 6, 17-18 of 70.

<sup>22</sup> The first album (1997) of Fulanito (the unknown, “John Doe”), is ironically entitled “El Hombre Mas Famoso de la Tierra.”

<sup>23</sup> Album cover from the group’s latest remix, “The Remixes: Fulanito” (2010).



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Then according to testimony of record, Opposer's attorney at that time, Wallace E.J. Collins, III, sent a "Cease and Desist" letter (Exhibit K) to Applicant on June 3,

<sup>24</sup> Partial album cover from "Americanizao" (2001).

<sup>25</sup> Partial album cover from "El Padrino" (1999).

<sup>26</sup> Opposer's later filed application was Application Serial No. 85561870 filed on March 6, 2012; abandoned September 9, 2013, for failing to respond to Office Action, following a refusal under § 2(d) based upon Applicant's involved application and other informalities.

<sup>27</sup> Applicant's solo album cover for "Vacaneria" (2007).

<sup>28</sup> Opposer's publicity poster from June 2008, a performing group without Applicant.

<sup>29</sup> Opposer's promotional banner from March 2012, a performing group without Applicant that reuses images of group as shown on 1997 album, "El Hombre Mas Famoso de la Tierra."

<sup>30</sup> Applicant's special form drawing in the involved application.

2010, in connection with Applicant’s alleged infringement of the Fulanito trademark and service mark.<sup>31</sup> That same day, Applicant responded with a computerized message asking Opposer to “holler @ me” so that they could “come up with a resolution to this problem.” Applicant went on to say that he “never denied [Opposer’s] involvement in Fulanito



**Opposer, Win**

[since] its inception and never will.” He ends with a plea: “Let’s talk about it and see if we can put an end to the animosity between us and avoid a useless[] and expensive legal battle.” (Exhibit I).<sup>32</sup>



**Applicant, Dose**

The record makes it clear that the dueling parties herein are ex-brothers-in-law and former partners in business, performing and producing musical recordings. Opposer and his extended family represented a lineage of Latin American composers, musicians and singers who have performed Spanish-language songs for generations. Applicant, who married Opposer’s sister decades ago, brought to the family group an ability to perform well in the English language, and then beginning in the mid- to late-90s, in the Spanish language.

Although there is no written agreement in the record formalizing the Fulanito musical group, as discussed above, the three persons at its core from 1997 to 2004

<sup>31</sup> J. Rosa testimony at 15-18, Exhibit K, 17 TTABVue at 30-32, 69 of 70.

<sup>32</sup> J. Rosa testimony at 13-14, Exhibit I, 17 TTABVue at 27-28, 67 of 70.

were (1) Opposer's father and a musician in his own right, Jose Arsenio Rosa Caba, a/k/a Arsenio El Maestro De La Rosa; (2) Opposer, Winston A. "Big Win" Rosa; and (3) Applicant, Rafael Robert "Dose" Vargas.

The sole legal entity relevant to this proceeding, that also made possible the public performances of the group and the mass production of musical recordings (e.g., CDs, and then MP3 digital downloads), was WinDose International, an equal partnership between Opposer and Applicant. However, it is not clear that WinDose, as a juridical entity, had any formal claim on the musical group's name and mark. On the other hand, between 1997 and 2004, Opposer and Applicant, as two individuals, shared equally in the costs of the Fulanito musical group. These two persons were the ones responsible for the quality and uniformity of the group's performances and recordings. Consistent with this history, Opposer, in his brief, acknowledges that he had always conceived of a 50:50 shared ownership with Applicant of the Fulanito mark. This also seems to be consonant with Applicant's conciliatory Facebook message of June 3, 2010.

Accordingly, we hold that neither Opposer nor Applicant had exclusive rights in the Fulanito mark in connection with any goods or services before this family musical group was dubbed "Fulanito." Given the pivotal role that Opposer's birth family played in the formation and history of this musical group, the absence from Applicant's performances and albums of all the members of the De La Rosa family would suggest a very different musical experience. Finally, we agree with Opposer that after years of multiple De La Rosa family members appearing together on

album covers and in public concerts, always wearing matching suits and fedoras, it seems likely that most consumers of Fulanito's public performances and musical recordings would anticipate that Fulanito would be a small group of men, but never a solo act.

“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.” *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007); *see also*, 15 U.S.C. § 1051(a); *Huang v. Tzu Wei Chen Food Co., Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); Trademark Rule 2.71(d). Accordingly, given the interests of all the known stakeholders as outlined above, and the overall context of this dispute, we find from this rather limited record that Applicant was *not the sole owner* of this mark as of the filing date of the involved use-based application. At best for Applicant, he was a co-owner of the mark with Opposer, and possibly others, who have not provided their consent to Applicant's registration of the mark. Hence, the involved application is void *ab initio*.

**Decision:** The opposition is hereby sustained and registration of Applicant's mark is refused under Section 1(a) of the Lanham Act.