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

Proceeding	91205093
Party	Defendant Paleteria La Michoacana, LLC
Correspondence Address	ROSEMARY S TARLTON MORRISON & FOERSTER LLP 425 MARKET STREET, 30TH FLOOR SAN FRANCISCO, CA 94105-2482 UNITED STATES rtarlton@mofo.com, jliou@mofo.com, lsimpson@mofo.com
Submission	Opposition/Response to Motion
Filer's Name	Rosemary S. Tarlton
Filer's e-mail	rtarlton@mofo.com, jliou@mofo.com, lsimpson@mofo.com
Signature	/Rosemary S. Tarlton/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRODUCTOS LACTEOS TOCUMBO, S.A. DE
C.V.,

Opposer,

vs.

PALETERIA LA MICHOACANA, LLC,

Applicant.

Opposition No. 91205093

Application No.: 85/378,387

Mark: LA INDITA

**APPLICANT'S NOTICE OF NON-OPPOSITION TO OPPOSER'S MOTION TO
CONSOLIDATE AND SUSPEND PENDING INTER PARTES PROCEEDINGS**

On August 3, 2012, Opposer Productos Lacteos Tocumbo, S.A. de C.V. ("Opposer") in the above-captioned proceeding filed a motion before the Trademark Trial and Appeal Board ("TTAB") to consolidate Opposition Proceeding Nos. 91205093, 91205049, 91205466, and 91205468. Concurrently, Opposer filed a motion to suspend Opposition Proceeding Nos. 91205093 and 91205049 pending disposition of the action in United States District Court for the District of Columbia, Case No. 11-cv-01623 ("District Court Action"), in which Paleteria La Michoacana, Inc. and Applicant Paleteria La Michoacana, LLC ("Applicant") seek judicial review and reversal of the TTAB's decision to cancel U.S. Registration No. 3,210,304 in Cancellation Proceeding No. 92047438.¹ Although Opposer did not formally file a motion to suspend Opposition Proceeding Nos. 91205466 and 91205468, Opposer has requested that the Board suspend and consolidate all four pending *inter partes* proceedings in its motion papers in

¹ U.S. Registration No. 3,210,304 for the mark LA INDITA MICHOACANA with an Indian girl design was assigned by registrant Paleteria La Michoacana, Inc. to Paleteria La Michoacana, LLC during the pendency of Cancellation Proceeding No. 92047438.

Opposition Proceeding Nos. 91205093 and 91205049 and during the Board-moderated phone conference on August 6, 2012.

While Applicant disagrees with many of the untrue factual assertions and characterizations of the District Court Action contained in Opposer's motions, after reviewing the law relating to suspension and consolidation, Applicant can agree to consolidate and suspend Opposition Proceeding Nos. 91205049, 91205466, and 91205468 on the grounds that litigation over the subject marks in each of these proceedings—Applicant's LA INDITA MICHOACANA and mountain girl design mark in Proceeding No. 91205049, Opposer's LA MICHOACANA word mark in Proceeding No. 91205466, and Opposer's LA MICHOACANA NATURAL and butterfly design mark in Proceeding No. 91205468—raises a common question of whether the term MICHOACANA in each subject mark is descriptive of a certain style of ice cream products. This question will be addressed in the District Court Action, where Applicant has appealed the TTAB's finding that the LA INDITA MICHOACANA and Indian girl design mark in Registration No. 3,210,304 and Opposer's LA MICHOACANA, LA MICHOACANA NATURAL, and LA MICHOACANA NATURAL and butterfly design marks—all used in connection with ice cream—are confusingly similar in appearance, sound, meaning, and commercial impression *to the extent* that each mark contains the word "Michoacana."

With respect to Opposition Proceeding No. 91205093, which involves Applicant's LA INDITA word mark, Applicant consents to suspension and consolidation of this proceeding with Proceeding Nos. 91205049, 91205466, and 91205468 albeit on grounds different from those stated by Opposer. Contrary to Opposer's suggestion, the TTAB made no findings of fact or law in Cancellation Proceeding No. 92047438 regarding LA INDITA as a stand-alone term, unconnected to other words or designs. In fact, the TTAB stated clearly that its finding of

likelihood of confusion centered on (a) the overlapping MICHOACANA term in the LA INDITA MICHOACANA design mark and Opposer's MICHOACANA-based marks, and (b) the similarity of the designs in the LA INDITA MICHOACANA and Indian design mark and Opposer's Indian girl design mark. Therefore, the unresolved issues in the pending appeal have no effect on the registrability of Applicant's LA INDITA word mark. Suspension and consolidation of this particular proceeding with the other actions is appropriate only to the extent that Applicant has asserted compulsory cancellation counterclaims in Proceeding No. 91205093 against Opposer's registrations for its LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and butterfly design marks, which have been inexplicably cited against Applicant's LA INDITA application even though the word "la" is the only basis of similarity between the marks, and such counterclaims are based in part on the failure of the MICHOACAN term to function as trademark.

For the foregoing reasons, Applicant agrees to suspend and consolidate Opposition Proceeding Nos. 91205093, 91205049, 91205466, and 91205468 given that the common question of whether MICHOACAN or MICHOACANA is a protectable designation is an issue that will be addressed in the District Court Action and therefore meets the low threshold for consolidation and suspension under TTAB precedent. In agreeing to suspend and consolidate these four proceedings, Applicant in no way concedes that its LA INDITA word mark and LA INDITA MICHOACANA and mountain girl design mark are similar with respect to each other or to Opposer's LA MICHOACANA word mark and LA MICHOACANA NATURAL and design mark.

Respectfully submitted,

Dated: August 23, 2012

By:



Rosemary S. Farlton
Attorney for Applicant
Paletería La Michoacana, LLC

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6810
Facsimile: (415) 268-7522

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on August 23, 2012, I served copies of:

APPLICANT'S NOTICE OF NON-OPPOSITION TO OPPOSER'S MOTION TO CONSOLIDATE AND SUSPEND PENDING INTER PARTIES PROCEEDINGS

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Stephen L. Anderson
Anderson & Associates
27247 Madison Avenue, Suite 121
Temecula, CA 92590

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 23rd day of August, 2012.

Lorna Simpson
(typed)



(signature)