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

Proceeding	91205093
Party	Plaintiff Productos Lacteos Tocumbo, S.A. DE C.V.
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Submission	Answer to Counterclaim
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Date	07/10/2012
Attachments	ANSWER TO COUNTERCLAIM 91205093 LA INDITA.pdf ( 3 pages )(144265 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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PRODUCTOS LACTEOS TOCUMBO	)	<b>Opposition No.: 91205093</b>
S.A. DE C.V.,	)	
	)	Application No. 85/378,387
Opposer,	)	
	)	Mark: LA INDITA
vs.	)	
	)	<b>OPPOSER'S ANSWER TO</b>
PALETERIA LA MICHOACANA, LLC,	)	<b>COUNTERCLAIM</b>
	)	
Applicant.	)	

Opposer, Productos Lacteos Tocumbo S.A. de C.V., for its answer to the Counterclaim filed by Paleteria La Michoacana, LLC (hereafter "Applicant"), hereby generally and specifically denies each and every allegation contained in the Applicant's Answer to Notice of Opposition and the Applicant's Counterclaim hereinafter not specifically admitted, modified, or qualified, and strict proof is demanded thereof. Opposer further responds as follows:

COUNTERCLAIM FOR CANCELLATION OF U.S. REGISTRATION NO.: 2,830,401

Opposer denies the prefatory remarks and allegations identified in the first paragraph of Applicant's Counterclaim and further denies that Applicant has any good faith basis for its Counterclaims.

36. Opposer denies the allegations contained in Paragraph 36 of the Counterclaim.

37. Opposer denies the allegations contained in Paragraph 37 of the Counterclaim.

COUNTERCLAIM FOR CANCELLATION OF U.S. REGISTRATION NO.: 3,249,113

Opposer denies the prefatory remarks and allegations identified in the first paragraph of the Applicant's Second Counterclaim and further denies that Applicant has any good faith basis for its Counterclaims.

38. Opposer denies the allegations contained in Paragraph 38 of the Counterclaim.

39. Opposer denies the allegations contained in Paragraph 39 of the Counterclaim.

Opposer further denies that the allegations contained in Paragraph 39 have any relevance or materiality with respect to the issues raised in this proceeding involving the proposed mark LA INDITA and therefore objects to said allegations on such basis.

40. Opposer denies the allegations contained in Paragraph 40 of the Counterclaim. Opposer further denies that the allegations contained in Paragraphs 39 and 40 have any relevance or materiality with respect to the issues raised in this proceeding involving the proposed mark LA INDITA and therefore objects to said allegations on such basis.

41. Opposer denies the allegations contained in Paragraph 41 of the Counterclaim.

42. Opposer denies the allegations contained in Paragraph 42 of the Counterclaim.

#### **AFFIRMATIVE DEFENSES**

1. Applicant's Counterclaim fails to state a claim upon which relief can be Granted to Applicant.

2. Applicant's Counterclaims are barred as the Opposer's Marks as are respectively registered under Registration Nos.: 2,830,401 and 3,249,113 have each been in continuous use in commerce for a period of five (5) years after the date of registration (or date of publication under § 12 (15 U.S.C. § 1062) and are incontestable. Accordingly, the Applicant's Counterclaims are barred under 15 U.S.C. §§1065 and 15 U.S.C. §§1115(b).

3. In light of the Board's Precedential Opinion issued on May 20, 2011, in TTAB Proceeding No. 92047438, (as well as the Board's Order denying Paleteria La Michoacana, Inc.'s Request For Reconsideration dated July 13, 2011), Applicant's Counterclaims are barred under the doctrine of Res Judicata.

4. In light of the Board's Precedential Opinion issued on May 20, 2011, in TTAB Proceeding No. 92047438, (as well as the Board's Order denying Paleteria La Michoacana, Inc.'s Request For Reconsideration dated July 13, 2011), Applicants Counterclaims are

precluded and Applicant is collaterally estopped from relitigating the issues raised in Applicant's Counterclaim brought herein.

5. Applicant's Counterclaim is barred by laches. Applicant has been on actual notice of the Opposer's Marks identified in the Counterclaim since at least as early as June 05, 2007. Applicant's failure to assert any alleged rights to priority, seniority, descriptiveness, or alleged damage regarding Opposer's Marks registered under Registration Nos.: 2,830,401 and 3,249,113 precludes any such allegations herein.

6. Applicant's Counterclaim are barred by the doctrine of unclean hands.

Respectfully submitted,

Anderson & Associates

Dated: July 10, 2012

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#### Certificate of Service

I hereby certify that on the date set forth below, a copy of the foregoing **OPPOSER'S ANSWER TO COUNTERCLAIM** was mailed first-class mail, postage prepaid, to the Attorney for Applicant as addressed to:

Rosemary S. Tarlton  
Morrison & Foerster LLP  
425 Market Street  
San Francisco, California 94105-2482

Dated: July 10, 2012

By: /StephenLAnderson/  
Stephen L. Anderson  
Attorney for Petitioner