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

Proceeding	91214091
Party	Defendant David Reynoso Urzua A/K/A David Reynozo
Correspondence Address	WENDY PETERSON NOT JUST PATENTS LLC PO BOX 18716 MINNEAPOLIS, MN 55418 UNITED STATES wsp@NJPLS.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Wendy Peterson
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Signature	/Wendy Peterson/
Date	04/15/2014
Attachments	Motion to Counterclaim and Counterclaim to Cancel Reserva De El Jaguar.pdf(55324 bytes )

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

Opposition No. 91214091

Opposition No. 91214147

**Villanueva Holding Company LLC**

**v.**

**David Reynozo**

**MOTION TO COUNTERCLAIM TO CANCEL RN 4495282**

1. The Applicant filed the Answer for this proceeding on January 9, 2014.
2. Applicant could not have filed the counterclaim with the Answer or within 21 days after filing its Answer because the mark in question had not yet registered.
3. RN 4495282 issued on Mar. 11, 2014 during a suspension of this proceeding during which time the parties unsuccessfully discussed settlement.
4. The suspension was lifted on April 11, 2014, the first day that the counterclaim could have been filed.
5. On April 14, 2014, Applicant promptly filed the counterclaim three days after the first possible day that a counterclaim in the proceeding could have been filed.

6. Applicant apologizes for not spelling out these facts in a motion provided with the counterclaim.
7. Applicant asks that the counterclaim be reinstated as being timely under the circumstances as filing this counterclaim with the Answer or within 21 days was not possible.
8. The mark is question registered just over a month ago and has not even been pleaded into the record by Opposer as a registration.
9. Applicant asks that the Board apply Fed. R. Civ. P. 13(f) “when justice requires” standard if necessary in order to avoid the procedural and timing upset that will occur if Applicant is forced to file a separate Petition to Cancel this mark and then ask to consolidate that proceeding with these two already consolidated proceedings.

Submitted By: /Wendy Peterson/

Date: April 15, 2014

Wendy Peterson, Attorney for Applicant, David Reynozo

**CERTIFICATE OF SERVICE**

I hereby certify that on April 15, 2014, the foregoing was served upon Villanueva Holding Company LLC's attorney by email as agreed by parties:

ipdocketing@strasburger.com, john.tang@strasburger.com,  
michelle.brockway@strasburger.com, teresa.wrye@strasburger.com

By: /Wendy Peterson/

Date: April 15, 2014

Wendy Peterson, Attorney for Applicant, David Reynozo

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Opposition No. 91214091

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**Villanueva Holding Company LLC**

**v.**

**David Reynozo**

**COUNTERCLAIM TO CANCEL RN 4495282**

1. Applicant has standing to bring this counterclaim as the respondent in these proceedings.
2. NOT THE OWNER. Villanueva Holding Company LLC (“Villanueva”) is not the owner of the mark RESERVA DE EL JAGUAR. This is a case where the subsidiary filed the application, an assignment was made to the parent but the subsidiary retained the rights as the true owner of all right, title and interest in the mark. On information and belief, Mexcor is and was always truly the owner of the mark.
  - a. On January 6, 2012, Mexcor filed the application for the mark.
  - b. On November 2, 2013, an assignment was filed alleged assigning all of the goodwill for this application from Mexcor to Villanueva.

- c. On December 19, 2013, a Statement of Use was filed by Mitzi Ferranti (the compliance officer for Mexcor) identifying the owner of the mark as Mexcor Inc.
  - d. TTB records support that Mexcor is and always has been the owner of the mark. Mitzi Ferranti had previously submitted the paperwork to the TTB (US Department of the Treasury Alcohol and Tobacco Tax and Trade Bureau) making a sworn statement that Mexcor is the owner of the TTB registration for CHAQUIRA RESERVA DE EL JAGUAR and that the labels being submitted were the true labels being used on the bottle.
3. Nonuse. On information and belief, Villanueva had not sold any tequila under the mark RESERVA DE EL JAGUAR at the time of the application (Jan. 06, 2012) or at the time of the Statement of Use (Dec. 19, 2013) or at the time specified in the Statement of Use (Mar. 11, 2013).
- a. On information and belief, use claimed by Villanueva in the trademark application in the US are sales of tequila under the names BEADED JAGUAR and CHAQUIRA that were made by Mexcor.
  - b. No sales have been made in the U.S. under RESERVA DE EL JAGUAR other than token sales.
  - c. Any sales have been made by Mexcor and not by Villanueva.
4. Fraud on the USPTO. The specimen filed with the Statement of Use for RESERVA DE EL JAGUAR shows neither of the labels that are approved by the TTB that are the only labels that can be lawfully used in the U.S. The label filed with the USPTO cannot be legally used on the bottle in the US and was filed only for the purpose of obtaining a registration with the USPTO.

- a. The specimen was falsely provided as being a legitimate label.
  - b. The specimen is a material element of an application.
  - c. Submitting the fraudulent specimen was an intentional act of the part of Mexcor to try to beat Applicant's first use in the U.S. Mitzi Ferranti, the person who submitted the specimen of use, is the same person who had previously submitted the paperwork to the TTB (US Department of the Treasury Alcohol and Tobacco Tax and Trade Bureau) making a sworn statement that the labels being submitted were the true labels being used on the bottle. Mitzi routinely handles both of these functions for Mexcor and would be well aware of which labels were false labels.
5. Merely Descriptive. RESERVA DE EL JAGUAR is only part of the name under which the tequila made by Opposer is sold. The TTB labels list the product as CHAQUIRA RESERVA DE EL JAGUAR which translates to BEADED JAGUAR. The specimen of use also shows CHAQUIRA RESERVA DE EL JAGUAR on the label and on the shipping container.
- a. CHAQUIRA RESERVA DE EL JAGUAR or BEADED JAGUAR is descriptive of the bottle in which the tequila is sold in.
  - b. The picture of the bottle in the specimen submitted with the Statement of Use is a picture of a beaded jaguar head.
  - c. At the time of the filing of the Notice of Opposition only one seller, a distributor named Specs, advertises that they sell this brand of Mexcor's tequila and it is sold as BEADED JAGUAR.
6. Fraud on the USPTO. The applications for CHAQUIRA and RESERVA DE EL JAGUAR were filed separately and by different parties both at 8950 Railwood Drive Houston

TEXAS 77078, in order to avoid a merely descriptive refusal for the tequila sold as BEADED JAGUAR or CHAQUIRA RESERVA DE EL JAGUAR.

- a. 89950 RAILWOOD DRIVE HOUSTON TEXAS 77078 is the address for Mexcor, Villanueva Holding, JAIME JOSE, COIRA VILLANUEVA, and others but all the IC 33 products sold by these parties are marketed and sold by Mexcor.
- b. An application for CHAQUIRA RESERVA DE EL JAGUAR would likely be refused for being merely descriptive and would not have been registered on the Principal Register if it was revealed that the container for this tequila is a bottle that would be described as a BEADED JAGUAR head.
- c. An application for CHAQUIRA RESERVA DE EL JAGUAR would likely be refused for being merely descriptive and would not have been registered on the Principal Register if it was revealed that the bottles of this tequila were being sold as BEADED JAGUAR.
- d. Mexcor and Villanueva intentionally separated the name into two parts and applied as two different marks by two different parties in order to perpetuate fraud on the USPTO in order to secure a registration.
- e. The specimens of use for both registrations show the same bottles.
- f. The first use dates for both registrations is the same day.
- g. The labels for both registrations show both names.
- h. Both applications list false translations for their portion of the mark to avoid disclosing that the product is known as BEADED JAGUAR.

The registration of RESERVA DE EL JAGUAR should be cancelled for the foregoing reasons.

Submitted By: /Wendy Peterson/

Date: April 15, 2014

Wendy Peterson, Attorney for Applicant, David Reynozo

**CERTIFICATE OF SERVICE**

I hereby certify that on April 15, 2014, the foregoing was served upon Villanueva Holding Company LLC's attorney by email as agreed by parties:

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