

ESTTA Tracking number: **ESTTA587539**

Filing date: **02/15/2014**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	AlfredoRomo Dimas
Granted to Date of previous extension	03/26/2014
Address	Mexico #516 Nte, Fracc Jose Luis Macias Rincon de Romos, AGS 20408 MEXICO

Attorney information	Steven J. Eyre Law Office of Steven J. Eyre 3550 Wilshire Blvd Ste 1440 Los Angeles, CA 90010 UNITED STATES stevenjeyre@gmail.com Phone:213.385.6926
----------------------	---

**Applicant Information**

Application No	85771636	Publication date	11/26/2013
Opposition Filing Date	02/15/2014	Opposition Period Ends	03/26/2014
Applicants	Favian Tapia 1441 S Hope St #218 Los Angeles, CA 90015 USX  Delia Tapia 1441 S Hope St #218 Los Angeles, CA 90015 USX		

**Goods/Services Affected by Opposition**

Class 041. First Use: 2009/12/06 First Use In Commerce: 2010/01/09 All goods and services in the class are opposed, namely: Entertainment, namely, live performances by a musical band
---

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration	4229726	Application Date	03/15/2012
-------------------	---------	------------------	------------

No.			
Registration Date	10/23/2012	Foreign Priority Date	NONE
Word Mark	SAMURAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1990/01/02 First Use In Commerce: 1990/01/02 Entertainment, namely, live performances by a musical band		

Related Proceedings	TTAB Cancellation No. 92057596; USDC Central District California CV13-08840 DDP (ASx)
---------------------	---

Attachments	85570615#TMSN.jpeg( bytes ) 2014-02-15-1-Opposition.pdf(247824 bytes )
-------------	---

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/stevenjeyre/
Name	Steven J. Eyre
Date	02/15/2014

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

In re the application of:

Favian Tapia and Delia Tapia  
Application Ser. No. 85/771636  
Filed: November 5, 2012  
Mark: EL ROMANTICO SAMURAY  
Published in the Office Gazette of November  
26, 2013

Alfredo Romo Dimas, Individual

Opposer,

vs.

Favian Tapia and Delia Tapia,

Applicants.

Opposition No.

In the Matter of

Ser. No. 85/771636

**OPPOSITION**

This Opposition is submitted in the matter of Ser No. 85/771636, filed on November 5, 2012 by applicants Favian Tapia and Delia Tapia (hereinafter, "Applicants"), with a mailing address of 1441 S. Hope St, Apt 218, Los Angeles, CA 90015, for the word mark EL ROMANTICO SAMURAY plus design in international classification 041 for "entertainment, namely, live performances by a musical band," with a claimed date of first use of December 6, 2009 and a claimed date of first use in commerce of January 9, 2010.

Opposer Alfredo Romo Dimas, an Individual (hereinafter, "Opposer") whose address is Mexico #516 Nte, Fracc Jose Luis Macias, Rincon de Romos, Aguascalientes 20408, Mexico, is the owner of Registration No. 4,229,726 for the service mark SAMURAY, registered on October 23, 2012 in international classification 041 for "entertainment, namely, live performances by a musical band." In addition, Opposer is the owner and user of the common-law service mark

SAMURAY in commerce in connection with entertainment, namely, live performances by a musical band, since at least as early as January 1990. Opposer is the owner and user of the common-law trademark SAMUARY in commerce connection with goods, namely sound recordings of a musical group, since at least as early as May 5, 1992.

The grounds for opposition to registration of Applicants' mark are as follows:

**I. PRIORITY OF USE AND LIKELIHOOD OF CONFUSION (Lanham Act § 2(d))**

1. Opposer began to use the SAMURAY service mark in commerce in connection with services, namely, live performances by a musical band, since at least as early as January 1990, and the SAMURAY trademark in commerce in connection goods, namely a series of sound recordings of a musical group, at least as early as May 5, 1992. Opposer's use of the SAMURAY service mark and trademark in commerce in connection the goods and services described above has been continuous since the dates of first use, and has not been abandoned.

2. The EL ROMANTICO SAMURAY trademark that Applicants seek to register is substantially identical to petitioner's SAMURAY common-law trademark. In both marks, the term "SAMURAY" is the salient portion of the name. In the design Applicants seek to register, the words "EL ROMANTICO" are minimized, while the word "SAMURAY" predominates. The phrase "EL ROMANTICO" in Applicants' service mark means "the romantic" in Spanish and is descriptive, particularly in the context of the "romantic" style of Regional Mexican music for which Opposer's musical group and sound recordings are known and which Applicants' group performs. Indeed the term "romantico" is used on more than one compilation album of Opposer's music released in connection with Opposer's common-law trademark SAMURAY.

3. The EL ROMANTICO SAMURAY service mark that Applicants seek to register is substantially identical to the SAMURAY mark of which Opposer is owner as to be likely, when applied to the proposed services of Applicant, to cause confusion or mistake or deceive

consumers and promoters/impresarios as to the origin of the services of Applicants' group and those of Opposer's musical group "Samuary."

4. Opposer, on information and belief, avers that consumers, and the general public, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicants' proposed services to be marketed under the EL ROMANTICO SAMURAY mark and misled into believing that such services emanate from, or are licensed by or are in some way directly or indirectly associated with the musical group "Samuray" of which Opposer has been the owner for more than two decades.

5. Opposer, upon information and belief, avers that he will be damaged by the registration by Applicants of the EL ROMANTICO SAMUARY service mark, as set forth in Applicants' application for registration, ser. No. 85/771636, in that the mark is substantially identical and confusingly similar to the SAMURAY mark owned by Opposer and will be used in connection with services identical to and/or related to the services of Opposer, or otherwise cause confusion between Applicants' musical group and the "Samuray" musical group of which Opposer is owner, since both groups sell their services in the same channels of trade, i.e. to consumers of Regional Mexican and Spanish-language music in live entertainment, and the promoters/impresarios of such live events.

6. Opposer further avers, on information and belief, that instances of actual confusion have arisen due to Applicants' use of the EL ROMANTICO SAMURAY service mark in that the services of Applicants' group has been advertised using the name and music of Opposer's musical group "Samuray."

7. Opposer's service mark SAMURAY is symbolic of extensive good will and consumer recognition built up by Petitioner over the course of more than two decades.

## II. FALSE SUGGESTION OF CONNECTION

8. Opposer further avers that Applicants' attempt to register the mark EL ROMANTICO SAMURAY is an attempt to suggest a connection with Opposer's musical group, and to convert the reputation, fame and career of Opposer's musical group "Samuray," and Opposer in particular, to Applicants' own benefit through the application for registration of the EL ROMANTICO SAMURAY mark, in violation of Section 2(a) of the Act.

9. More specifically, Opposer avers that the mark SAMURAY points uniquely to Opposer's musical group, and the goods and services of that group (i.e., live performances and sound and audiovisual recordings). The mark that Applicant seeks to register is substantially identical to the SAMURAY mark used by Opposer for over twenty years in that the "romantic" component of Applicant's mark merely describes the type of musical group that Opposer's group is, i.e. a group that plays "romantic" style music in the *romántico* sub-genre of Regional Mexican music.

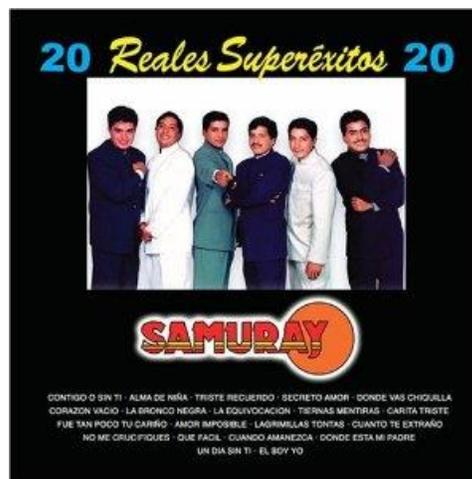
10. Applicants' intent in selecting the service mark EL ROMANTICO SAMURAY as the name of their musical group can be adduced from the selection by them of the related trademark EL ROMANTICO SAMURAY, Reg. No. 3,797,278 (for which a Cancellation proceeding is pending, Canc. No. 92057596) for Applicants' goods, namely sound and audiovisual recordings, particularly when one compares (x) the specimen of use presented by Applicants on January 25, 2010 in connection with their allegation of use of the trademark EL ROMANTICO SAMURAY, to (y) the "greatest hits" album of Opposer's musical group released a couple of years previously. All but two of the tracks on Applicants' 2010 specimen are tracks also listed on Opposer's 2007 greatest hits album, to wit:

Track listing of respondent's 2009 album submitted as specimen of use:  
"EL ROMANTICO SAMURAY: Exitos y Algo Mas" ("Hits and Something More")



- 01 – Contigo o Sin Ti
- 02 – Donde Vas Chiquilla
- 03 – Tierna Mentiras
- 04 – Tristes Recuerdos
- 05 – Amor Imposible
- 06 – Alma de Niña
- 07 – Lagrimillas Tontas
- 08 – La Bronco Negra
- 09 – Carita Triste
- 10 – No me Crucifiques
- 11 – Cuanto te Extraño
- 12 – Fue Tan Poco Tu Cariño

The following tracks listed on respondent's specimen are also listed on petitioner's 2007 greatest hits album:  
"SAMURAY: 20 Reales Superéxitos" ("20 Real Superhits")



- Track no. 1
- Track no. 5
- Track no. 9
- Track no. 3
- Track no. 12
- Track no. 2
- Track no. 13
- Track no. 7
- Track no. 10
- Track no. 15
- Track no. 14
- Track no. 11

13 – La Equivocación	Track no. 8
14 – Para Que No Te Vayas	Not listed
15 – Vuela Paloma	Not listed

It is apparent from the Applicants' specimen of use that the intention in selecting the EL ROMANTICO SAMURAY trademark for their sound recordings, and in turn the EL ROMANTICO SAMURAY service mark that Opposer now opposes, was and is to trade on the SAMURAY marks that Opposer has used continuously for over two decades and for which there is substantial recognition in the relevant channels of trade.

11. Opposer avers, on information and belief, that Applicants have utilized their alleged common-law service mark EL ROMANTICO SAMUARY to cause promoters to misidentify Applicants' musical group as Opposer's musical group "Samuray."

### **III. FRAUD**

12. Opposer incorporates the above allegations herein as though fully set forth herein.

13. Applicants' application for registration of the service mark EL ROMANTICO SAMURAY is fraudulent in that in the formal application filed by Applicants under 18 USC 1001, Applicants declare as follows:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 15 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to

the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

14. The above statement by Applicants was and is false. As demonstrated by the specimen submitted by Applicants in connection with their statement of use in their registration of the trademark EL ROMANTICO SAMURAY, Applicants knew that Opposer used the mark SAMURAY in connection with Opposer's goods and services, and Applicants adopted much of the playlist from Opposer's 2007 hits album for use on the 2009 album Applicants submitted as a specimen of use in connection with the registration of the EL ROMANTICO SAMURAY trademark. By the same token, Applicants knew of Opposer's user of the SAMURAY service mark in connection with his Opposer's musical group for well over two decades.

15. The false statements were made by Applicants with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant the registration of the EL ROMANTICO SAMUARY service mark, just as had been done previously in connection with the EL ROMANTICO SAMURAY trademark. The U.S. Patent and Trademark Office relied upon similar false statements in Applicants application for registration of the EL ROMANTICO SAMURAY trademark, and Opposer avers that Applicants had every expectation that the U.S. Patent and Trademark Office would similarly rely upon Applicants' representations in connection with the EL ROMANTICO SAMURAY service mark application.

16. Opposer will be damaged by any registration issued in reliance upon the misrepresentations of Applicants in that Opposer, since at least as early as January 1990 has used the SAMURAY in connection with entertainment, namely, live performances by a musical

band, and Opposer's continued and legal use of the mark will be impaired by the registration of the EL ROMANTICO SAMURAY service mark by Applicants.

17. Opposer, upon information and belief and based upon the above, believes that registration should therefore be refused under sections 2(a), 2(d) and 43(c) of the Act.

WHEREFORE, Opposer believes and avers that he will be damaged by the registration of the mark EL ROMANTICO SAMUARY by Applicants, and prays that application Ser. No. 85/771636 be refused, that no registration be issued thereon to Applicants and that this Opposition be sustained in favor of Opposer.

Dated: February 15, 2014

Respectfully submitted

Alfredo Romo Dimas, an Individual  
Opposer

/stevenjeyre/  
Steven J. Eyre  
Attorney for Petitioner  
Steven J. Eyre, Attorney at Law  
3550 Wilshire Blvd., Ste 1440  
Los Angeles, CA 90010  
Tel. 213.385.6926  
Fax. 213.385.3313  
Email: [stevenjeyre@gmail.com](mailto:stevenjeyre@gmail.com)

### **CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document is being served on Applicants Favian Tapia and Delia Tapia by U.S. Mail deposited today's date, addressed as follows:

Favian Tapia  
Delia Tapia  
1441 S. Hope Street  
Apt 218  
Los Angeles, CA 90015

Dated: February 15, 2014

/stevenjeyre/  
Steven J. Eyre  
Attorney for Petitioner