

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

In the Matter of Registration No. 2,105,538  
Registration date: October 13, 1997  
For the Mark: CONCHITAS  
For: corn chips



05-04-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Conchita Foods, Inc.  
Petitioner,

v.

Cancellation No. 92032853

Fritas Encanto de Monterrey, S.A. de C.V.  
Registrant.

\_\_\_\_\_)

PETITIONER'S MOTION FOR SANCTIONS

COMES NOW Petitioner, **Conchita Foods, Inc.** (hereinafter "Petitioner"), by and through their counsel, **SANCHELIMA & ASSOCIATES, P.A.**, hereby files its Motion for Sanctions pursuant to Trademark Rule 2.120(g) and in accordance with Rule 37(b)(2) of the Federal Rules of Civil Procedure.

On January 22, 2004, the Board issued an order granting Petitioner's motion to compel Respondent to supplement discovery responses and allowed Respondent until 30 days from January 22, 2004, (February 13, 2004) to serve responses on Petitioner. Please refer to Board's Order dated January 22, 2004, attached herewith as Exhibit "A".

On March 17, 2004, Petitioner sent a letter to Respondent's former counsel, Rick Rodriguez, Esq., allowing him an additional 10 days to comply with the Board's Order, dated January 22, 2004, to avoid filing this motion for sanctions and to advance this proceeding. Petitioner never received a reply to this letter. Please refer to Petitioner's letter dated March 17, 2004, attached herewith as Exhibit "B".

A month and a half after responses were due, Julian Castro, Esq., Respondent's new counsel, informed Petitioner that Rick Rodriguez, Esq., was no longer in the case. Please refer to the March 30, 2004 letter, attached herewith as Exhibit "C". Furthermore, the letter states that Mr. Castro will be contacting Petitioner to further discuss the over-due responses.

On March 31, 2004, Petitioner replies to respondent's March 30, 2004, letter by advising that Petitioner was never notified of any address or attorney changes in this proceeding. Please refer to the March 31, 2004, letter, attached herewith as Exhibit "D". Petitioner was never served with a copy of the Appointment of New Attorney or any document that would reflect such a change. In addition to this, Petitioner allowed Respondent an additional 10 days to comply with the outstanding discovery requests.

Respondent, up and until this date, has not complied with its discovery duties, pursuant to Trademark Rule 2.120, 37 C.F.R. § 2.120 and The Federal Rules of Civil Procedures.

Petitioner has made a good faith effort to resolve the outstanding discovery issues, to no avail. At no point in time has correspondence been returned to the sender, which therefore implies that Respondent's long history of attorneys, have been receiving the appropriate correspondence sent by Petitioner. These requests and demands have been ignored.

WHEREFORE, in view of Respondent's gross neglect with respect to this proceeding, and the fact that Petitioner has incurred unjustifiable legal expenses a result of this delay, Petitioner respectfully requests this Board to sustain Petitioner's Petition for Cancellation by granting judgment in its favor and to cancel the registration for the mark CONCHITAS, Reg. No. 2,105,538.

**CERTIFICATE OF SERVICE**

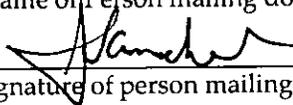
I HEREBY CERTIFY that a true and correct copy of Petitioner's Motion for Discovery Sanctions was mailed via First Class U.S. mail, to: Gonzalez, Hoblit Ferguson Att: *Julian Castro, Esq.*, One Riverwalk Place, 700 N. St. Mary's Street, Suite 1800, San Antonio, Texas 78205, Attorney for Registrant, on this 30<sup>th</sup> day of April, 2004.

SANCHELIMA & ASSOCIATES, P.A.  
Counsel for the Petitioner  
235 S.W. Le Jeune Road  
Miami, FL 33134-1762  
Telephone: (305) 447-1617  
Telecopier: (305) 445-8484

By:   
\_\_\_\_\_  
Jesus Sanchelima  
(Fla. Bar No. 231207)

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service, pursuant to 37 C.F.R. § 1.10, in an envelope addressed to the Assistant Commissioner of Trademarks, BOX: TTAB/FEE, 2900 Crystal Drive, Arlington, VA 22203-3513 on the above-referenced date.

By: Maribel Elias, paralegal  
Name of Person mailing document  
  
\_\_\_\_\_  
Signature of person mailing documents  
4/30/04  
\_\_\_\_\_  
Date

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

GOODMAN

Mailed: January 22, 2004

Cancellation No. 92032853

CONCHITA FOODS, INC.

v.

FRITAS ENCANTO DE MONTERREY,  
S.A. DE C.V

Before Simms, Cissel and Drost, Administrative Trademark  
Judges.

By the Board:

This case now comes up on petitioner's motions to  
compel filed May 5, 2003, and June 30, 2003; respondent's  
"amended answer"<sup>1</sup> or alternative motion to dismiss, filed  
August 6, 2003; and petitioner's consented motion to extend  
dates, filed August 7, 2003.

Petitioner's motion to extend is granted.

We now turn to respondent's motion to dismiss.

In support of its motion to dismiss, respondent argues  
that the petition to cancel should be dismissed because  
petitioner did not timely file the petition to cancel.

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<sup>1</sup> Respondent has not filed a signed amended answer with its  
motion; has not made any arguments regarding amending its answer;  
and the motion itself is not a proper answer under Fed. R. Civ.  
P. 8. Therefore, we construe respondent's motion as one for  
dismissal only.

Exhibit  
"A"

Cancellation No. 92032853

Respondent asserts that the involved registration, Registration No. 2105538<sup>2</sup>, was registered on October 14, 1997; that petitioner filed the petition to cancel "as stamped by the TTAB" without filing fee on August 8, 2002<sup>3</sup>; that the filing fee was not paid until October 22, 2002; that according to statute, the new filing date for the petition to cancel is October 22, 2002, the date the filing fee was paid; that petitioner had five years to file the petition to cancel or until October 14, 2002, and therefore, the petition to cancel is untimely and should be dismissed.

In response, petitioner argues that its petition to cancel was acknowledged as received by USPTO on September 6, 2002 and is timely; that to the extent respondent's motion is an attempt to amend its answer, it should be stricken for noncompliance with the rules, which require a signed copy of

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<sup>2</sup> Presently, no Section 8 affidavit of continued use has been filed by registrant. See Trademark Rule 2.160(a)(i). Under Section 8(a) of the Trademark Act, the owner of a registration must file an affidavit or declaration of continued use or excusable nonuse on or after the fifth anniversary and no later than the sixth anniversary of the date of registration or date of publication under Section 12(c) of the Act. Under Section 8(c)(1) of the Trademark Act, an owner may file the affidavit or declaration of use within a grace period of six months after the expiration of the deadline set forth in Section 8(a) of the Act, accompanied by an additional grace period surcharge. The pendency of the petition to cancel does not obviate a registrant's fulfillment of the Section 8 requirements by filing the prescribed declaration or affidavit. See, e.g., *Abraham Seed v. John One Ten*, 1 USPQ2d 1230, 1232, n. 7 (TTAB 1986).

<sup>3</sup> Board records indicate that the petition to cancel was filed with the USPTO on August 2, 2002.

Cancellation No. 92032853

the proposed pleading and leave of the party or the Board; and that respondent's argument with regard to dismissal due to incontestability fails because the petition to cancel is based on the ground of abandonment under Section 14(3) which can be filed at any time.

Respondent filed its answer on March 4, 2003 and filed its motion to dismiss on August 6, 2003. Because the motion to dismiss was filed after respondent filed its answer, we construe respondent's motion as one for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c).

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings. See 5A Wright and Miller, *Federal Practice and Procedure: Civil 2d* Section 1367 (2d ed. 2003); TBMP Section 504.02.

Inasmuch as respondent is essentially arguing that petitioner has failed to state a claim, the standard we apply to respondent's motion is the same as that set forth in Fed.R.Civ.P. 12(b)(6). *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990). Therefore, we shall consider whether petitioner has alleged such facts as would, if proven, show that petitioner has standing to petition for cancellation of the registered mark and that a statutory ground for cancelling such registration exists. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Cancellation No. 92032853

After consideration of the petition to cancel, we find that petitioner has adequately alleged standing.

We now turn to consideration of whether the grounds for cancellation state a claim.

With regard to the ground of likelihood of confusion, we find this ground is not an available ground for cancellation inasmuch as the filing date of the petition to cancel is after the fifth year anniversary of the involved registration.

As respondent correctly argued, the filing date of a petition to cancel is the date of receipt of the petition in the USPTO and the required fee. In this case, the fifth year anniversary for the registration was October 14, 2002, and although petitioner filed the petition to cancel on August 2, 2002, petitioner did not pay the filing fee for the petition to cancel until October 22, 2002. Therefore, October 22, 2002 is the filing date for the petition to cancel, and the ground of likelihood of confusion under Section 2(d) is unavailable.<sup>4</sup> See e.g., *Texas Instruments*

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<sup>4</sup> Section 14(3) states in part that a petition to cancel may be filed "[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 USC §1054] or of subsection (a), (b), or (c) of section 2 [15 USC §1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used."

Cancellation No. 92032853

*Inc. v. Conklin Instruments Corp.*, 161 USPQ 740, 741 (TTAB 1969) ("[S]ubsequently filed complaint by petitioner was untimely" even when preceded by a timely unverified petition).

In view thereof, petitioner's allegations regarding likelihood of confusion are stricken from the petition to cancel.

With regard to the remaining ground for cancellation, abandonment, we find that the claim of abandonment is adequately pled, and as petitioner correctly argues, this ground for cancellation may be brought at any time. In view thereof, respondent's motion to dismiss is denied with respect to the ground of abandonment.

We now turn to petitioner's motions to compel.

Petitioner filed a motion to compel on May 5, 2003 due to respondent's failure to provide responses to its discovery requests. Respondent served its partial discovery responses on May 23, 2003. Thereafter, petitioner filed another motion to compel on June 30, 2003 complaining about the completeness of respondent's discovery responses.

Respondent has not filed a response thereto.

In view of the later filed motion to compel, we consider the only remaining issue with respect to respondent's discovery responses to be whether they are complete.

Cancellation No. 92032853

Upon review of respondent's discovery responses, we find that its responses to interrogatory nos. 7 and 8 are insufficient<sup>5</sup> and that its responses to petitioner's document requests are also insufficient<sup>6</sup>.

In view thereof, petitioner's motion to compel is granted to the extent that if respondent has not already supplemented its responses to petitioner's interrogatory nos. 7 and 8 and petitioner's document requests, respondent is allowed until THIRTY DAYS to serve complete responses to these requests.   
↳ Due Feb. 13, 2004

Proceedings are resumed.

Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	March 31, 2004
30-day testimony period for party in position of plaintiff to close:	June 29, 2004 opens May 31, 2004
30-day testimony period for party in position of defendant to close:	August 28, 2004 opens July 30, 2004
15-day rebuttal testimony period for party in position of plaintiff to close:	October 12, 2004 opens Sep. 13, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

<sup>5</sup> Respondent's response to both interrogatory nos. 7 and 8 is "will supplement."

<sup>6</sup> Respondent's response to each of petitioner's document requests is "Registrant has not been given a sufficient amount of time for compliance with the request. Registrant will supplement."

TT Brief Due 12/13/04  
A Brief Due 1/12/05

6 TT Reply Brief 1/24/05

Cancellation No. 92032853

on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

*Sanchelima & Associates, P.A.*  
*Attorneys at Law*

Patent, Trademark & Copyright Law

J. Sanchelima, Patent Attorney  
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March 17, 2004

Law Offices of Richard Rodriguez  
ATT: *Richard Rodriguez, Esq.*  
1117 East Harrison Street  
Harlingen, Texas 78550

Via Facsimile: (956) 425-9639

Re: Registration No.: 2, 105,538  
Cancellation No. 32,853  
Mark: CONCHITA and DESIGN  
Our File No.: 22525

Dear Mr. Rodriguez:

Please be advised that pursuant to the most recent TTAB Order, the deadline for discovery period to close is approaching (March 31, 2004). To this end, and since we have not received your responses to our interrogatories, Nos. 7 and 8, and document requests, Nos. 1-11, as instructed by the Board, we request that you consent to a 90 day extension of time to extend discovery and testimonial periods.

In addition to this, we demand that you deliver to us your responses to the outstanding discovery requests immediately. We will file a motion to compel if we do not receive these responses in 10 days. As you know they were due on February 13, 2004.

Very truly yours,

  
Jesus Sanchelima, Esq.

File  
JS/me

HP OfficeJet  
Personal Printer/Fax/Copier

Fax Log Report

Mar-17-04 04:26 PM

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<u>Identification</u>	<u>Result</u>	<u>Pages</u>	<u>Type</u>	<u>Date</u>	<u>Time</u>	<u>Duration</u>	<u>Diagnostic</u>
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**GONZALES HOBLIT FERGUSON**  
*A Limited Liability Partnership*

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March 30, 2004

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Via Facsimile No. (305) 445-8484

Re: **Conchita Foods, Inc. v. Fritos Encanto de Monterrey, S.A. de C.V., Cancellation No. 92032853**

Dear Mr. Sanchelima:

I represent Fritos Encanto de Monterrey, S.A. de C.V., Respondent in the above-referenced matter. Please direct all future correspondence and copies of filings to me. Unfortunately, although this law firm is recognized as the attorney of record by the United States Patent and Trademark Office, we have not received past filings or discovery requests from you over the last several months. Your records should reflect that Mr. Rick Rodriguez no longer represents Fritos Encanto de Monterrey, S.A. de C.V. on this matter.

I will contact you this week to discuss this matter and to speak with you regarding the responses to Petitioner's Interrogatory Nos. 7 and 8.

Very truly yours,

  
JULIAN CASTRO

JC/sm

Exhibit  
"C"

*Sanchelima & Associates, P.A.*  
*Attorneys at Law*

Patent, Trademark & Copyright Law

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March 31, 2004

Gonzalez, Hoblit Ferguson  
*Att: Julian Castro, Esq.*  
One Riverwalk Place  
700 N. St. Mary's Street, Suite 1800  
San Antonio, Texas 78205

*Via Facsimile: (210) 226-1544*

Re: Registration No.: 2, 105,538  
Cancellation No. 92,032,853  
Mark: CONCHITA and DESIGN  
Our File No.: 22525

Dear Mr. Castro:

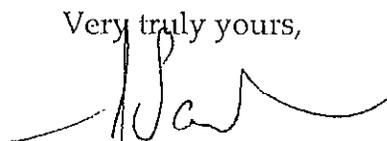
We are in receipt of your letter dated March 30, 2004.

Please be advised that we were never notified of any changes in address or attorney for this matter. You are the fourth attorney representing the Registrant! We were never served with a copy of either a Revocation of Previous Power of Attorney or Appointment of New Attorney by you or Mr. Rodriguez. As such, your assumption of "our records reflecting this change" is unfounded.

I am confident, that since you have been the attorney of record for several months, as you mention in your letter, you are aware of the current status with this case. Your supplemented responses were due in our office on February 13, 2004, pursuant to the Board order issued on January 22, 2004. We sent a letter to Mr. Rodriguez, regarding his overdue responses and the fact that we were giving him an additional 10 days, and no one replied to this letter.

We demand these responses immediately; otherwise, we will be forced to file a Motion for Discovery Sanctions. I will be out of town tomorrow and Friday, April 2, 2004. I do not see the need to have further dilatory discussions in lieu of compliance with your client's discovery duties.

Very truly yours,

  
Jesus Sanchelima, Esq.

File  
JS/me

Exhibit  
"D"

Apr-05-04 01:39 PM

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<u>Identification</u>	<u>Result</u>	<u>Pages</u>	<u>Type</u>	<u>Date</u>	<u>Time</u>	<u>Duration</u>	<u>Diagnostic</u>
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