

TTAB

Attorney's Docket No. 05280-0002A

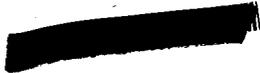
TRADEMARK

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

IN THE MATTER OF REGISTRATION NO. 2,682,978 SANTANA'S FOOD ... ES  
MUY BUENO HOME OF FAMOUS  
CALIFORNIA BURRITO and  
design

Date Registered: 4 February 2003 International Class 042

ARTURO SANTANA GALLEGO )  
 )  
 Petitioner, )  
 )  
 v. )  
 )  
 SANTANA'S GRILL, INC. )  
 )  
 Registrant )

  
03-30-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

Cancellation No.

PETITION TO CANCEL

Petitioner, ARTURO SANTANA GALLEGO, a citizen of the United States of America whose residence address is 977 Avendia, Revolución, Colonia Refugio, Tecate, Baja California, Mexico, believes that he is or will be damaged by Registration No. 2,682,978 on the Principal Register, and hereby petitions to cancel the same. As grounds therefore it is alleged that:

1. Petitioner is now and has been since at least 1988, the owner through use of the service mark "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phase "ES MUY BUENO" which was added by 1988. (Dec. of A. Gallego, ¶s 2 & 3)

2. Petitioner does not believe he has ever used the mark(s) in commerce that Congress can regulate, but recognizes that the restaurant services he has provided have been provided to citizens of Mexico and states other than California and that his radio advertising may have been transmitted to Nevada, Arizona, and Mexico, and therefore his use may be "in commerce". (Dec. of A. Gallego, ¶ 4)

3. Starting in 1986, Petitioner established Mexican restaurants, which by 1988 displayed the mark "SANTANA'S MEXICAN FOOD", and later "ES MUY BUENO" on the signage and/or menus thereof in San Diego, California and later in Yucca Valley, California. (Dec. of A. Gallego, ¶ 4)

4. Petitioner invented a potato-based burrito, named it the "California Burrito" and first sold it at his restaurant at 56547 29 Palms Highway, Yucca Valley, CA, which therefore is the actual home of the California Burrito. Copies of that potato-based burrito are now sold by many Mexican restaurants unaffiliated with Petitioner or Registrant under the name California Burrito. (Dec. of A. Gallego, ¶ 5)

5. As shown by reports of change in ownership filed with the Business Taxes Section of the City of San Diego, (Exhibits A & B) Petitioner gave his SANTANA'S MEXICAN FOOD restaurant located at 1480 Rosecrans St., San Diego, CA to his son Abelardo Santana Lee and his son's wife, Claudia Vallarta-Santana, December 31, 1991 by adding them as owners, and then removing himself as an owner, 27 January 1992. No exclusive rights to use the marks, "SANTANA'S MEXICAN FOOD", "ES MUY BUENO" and/or "HOME OF FAMOUS CALIFORNIA BURRITO" were included in the gift. (Dec. of A. Gallego, ¶ 7)

6. Petitioner sold his SANTANA'S MEXICAN FOOD restaurant located at 56547 29 Palms Highway, Yucca Valley, CA to Arturo Castañeda in 1999 on an installment payment schedule, which is ongoing. The sale included the rights to continue non-exclusive use of the mark "SANTANA'S MEXICAN FOOD", with or without "ES MUY BUENO" and to sell California Burritos. Registration No. 2,682,978 will affect Mr. Castañeda's ability to pay Petitioner the remaining amount. In 2003, Arturo Castañeda opened a second Mexican restaurant located at 7380 Sun Valley, Twenty Nine Palms, CA. In 2004, Arturo Castañeda opened a third SANTANA'S MEXICAN FOOD restaurant located at 28005 Bradley Road, Sun City, California. Arturo Castañeda has used the mark, "SANTANA'S MEXICAN FOOD" in association therewith. (Dec. of A. Gallego, ¶ 6)

7. Petitioner is aware of Mexican restaurants, unrelated to him, his sons, his son's wife, Claudia Vallarta-Santana, Santana's Grill. Inc., or Mr. Castañeda, using the mark: SANTANA'S MEXICAN GRILL at 3637 Thousand Oaks Boulevard, Thousand Oaks, CA and SANTANA'S MEXICAN FOOD at 10438 E. Waterloo Road, Stockton, CA. (Dec. of A. Gallego, ¶ 11)

8. According to the records of the Secretary of State of the State of California, the Registrant, Santanas Grill, Inc. did not exist in 1988 or 1993, it being formed 4/3/1998 (Exhibit C). There appears to be some confusion about the exact name of the Registrant as the name is listed as Santana's Grill, Inc. in the Registration and Santanas Grill, Inc. in the Secretary of State's records. The agent for notice of process for Santanas Grill, Inc. is Claudia Vallarta-Santana so Santanas Grill, Inc. and Santana's Grill, Inc. are clearly the same Corporation. Hereinafter, the Registrant will be referred to as Santana's Grill, Inc.

9. No valid agreement has ever existed that transfers any exclusive trademark rights and/or goodwill from Arturo Santana Gallego to Abelardo Santana Lee, Claudia Vallarta-Santana or Santana's Grill, Inc. (Dec. of A. Gallego, ¶ 12)

10. Apparently, in 1998, Abelardo Santana Lee and Claudia Vallarta-Santana transferred ownership of their restaurant at 1480 Rosecrans St., San Diego, CA to Santana's Grill, Inc., which corporation established SANTANA'S MEXICAN FOOD restaurants at: 1525 Morena Blvd. San Diego, CA; 580 South Pacific St., San Marcos, CA; and 719 Washington St., San Diego, CA. and a SANTANA'S MEXICAN GRILL restaurant at 3742 Midway, San Diego, CA. According to Santana's Grill, Inc.'s web site (Exhibit D), all restaurants owned by Santana's Grill, Inc. now use the mark SANTANA'S MEXICAN GRILL.

11. Claudia Vallarta-Santana, as Vice President of Registrant, falsely confirmed by Declaration (Exhibit E, Page 3), executed 11-27-01, that the mark was first used by Santana's Grill, Inc. "on or before 1988" (Exhibit E, Page 1) and that to the best knowledge and belief of Santana's Grill, Inc. "... no other person, firm, corporation or association has the right to use the mark in commerce either in the identical form or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of any other person, to cause confusion or to cause mistake, or to deceive; ". Since Santana's Grill, Inc. did not even exist until 1998, and clearly Santana's Grill, Inc. through its owners, knew of Petitioner's continuing use of the SANTANA'S MEXICAN FOOD mark, in association with his Yucca Valley restaurant until 1999 and the continuing use of Mr. Castañeda from 1999 to this day, such Declaration is fraudulent.

12. In a REQUEST FOR CORRECTED REGISTRATION CERTIFICATE DUE TO ERROR BY REGISTRANT UNDER 37 C.F.R. § 2.175 dated by the

Trademark Office 11/07/03, (Exhibit F, Page 1) Claudia Vallarta-Santana or the attorney for Santana's Grill, Inc. reaffirmed the following false statement:

"The date of first use of the mark and the date of first use of the mark in commerce originally provided in Application Serial No. 76/345,542" (which matured into Registration 2,682,978) "were the dates the Applicant first used the words 'Santana's Mexican Food' in conjunction with its services." Since Santana's Grill, Inc. was not formed until 1998 (Exhibit C) and during 1988, the date originally claimed, the restaurant using the mark, "SANTANA'S MEXICAN FOOD" was owned by Petitioner, Arturo Santana Gallego, these statement is a deliberate falsehood.

13. Claudia Vallarta-Santana, as Vice President of Registrant, misleadingly confirmed by a second Declaration of 10-20-03 (Exhibit F, Page 3) "that the term "Santana's Mexican Food" has been in use in conjunction with restaurant service since as early as 1988, in accordance with the original application," when in fact she knew that the use was by Petitioner, to which use Santana's Grill, Inc. has no exclusive rights. Such use was in association with the Rosecrans St., San Diego restaurant, established in 1986 by Petitioner, which had used the mark SANTANA'S MEXICAN FOOD since at least 1988. This was the restaurant given to her and her husband in 1991-1992 by Petitioner. (Dec. of A. Gallego, ¶ 7) Claudia Vallarta-Santana then implies the alleged use in 1993 was by Applicant, Santana's Grill, Inc., when it fact it was not. As her excuse for the false Declaration of 11-27-01, she declares (Exhibit F, Page 3): "that I misunderstood what date was to be provided in the application and mistakenly believed it was the date of use or use in commerce of the words 'Santana's Mexican Food'; that the attorney who prepared Application Serial No. 76/345,542 did not provide legal representation of the Registrant Corporation until 2001 and therefore relied on information I provided relating to the dates of first use and first use in commerce; ..." The excuse that legal counsel was not fully informed and hence falsehoods in a prior declaration should be excused, does not excuse the misleading statements in the Declaration of 10-20-03, as clearly Ms. AnneMarie Kaiser, attorney from Knobbe Martens Olson & Bear LLP should have been informed as to the circumstances of early use by the time of the Declaration of 10-20-03, and either was provided misinformation and failed to determine the information she was given was incorrect, or was a party to the frauds.

14. If the alleged use of the registered mark in 1993 was, "in commerce", then the identical prior use of the marks

"SANTANA'S MEXICAN FOOD" and "ES MUY BUENO" by Petitioner was also "in commerce".

15. The present registration was obtained by:  
fraudulently claiming use of the mark "SANTANA'S MEXICAN FOOD ... ES MUY BUENO" by Santana's Grill, Inc. before such entity existed;

fraudulently claiming use of the registered mark by Santana's Grill, Inc. before such entity existed;

submission of fraudulent and misleading Declarations;  
falsely representing in the registered mark that a restaurant owned by Santana's Grill, Inc. is the home of the "California Burrito", when it is not; and

misrepresenting to the Trademark Examining Attorney that the mark was first used by Registrant in commerce when either no use in commerce by 1993 occurred at all, or it occurred through use by another.

16. Registration No. 2,682,978 is involved in litigation, Case No. 03 CV 2340 L(RBB) in U.S. District Court, Southern District of California. Petitioner is not a party to that litigation.

17. Therefore Registration No. 2,682,978 should be cancelled and the Declarant, Claudia Vallarta-Santana should be referred to the Attorney General for prosecution under 18 U.S.C. 1001.

Dated: 26 March 2004

Reg. No.: 25,113

Tel. No.: (310) 315-8200

  
George W. Finch  
Van Etten Suzumoto & Becket LLP  
1620 26th St.  
Suite 6000, North Tower  
Santa Monica, CA 90404

Attorney's Docket No. 05280-0002A

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Date Registered: 4 February 2003 International Class 042

ARTURO SANTANA GALLEGO )  
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 Petitioner, )  
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 SANTANA'S GRILL, INC. )  
 )  
 Registrant )

Cancellation No.

**DECLARATION OF ARTURO SANTANA GALLEGO**

1. I, Arturo Santana Gallego, declare I am a citizen of the United States of America whose residence address is 977 Avendia, Revolución, Colonia Refugio, Tecate, Baja California, Mexico.

2. In 1986, I started and was the sole owner of a restaurant at 1480 Rosecrans St., San Diego, CA and in late 1987 or early 1988 started using the mark, "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phase "ES MUY BUENO".

3. By 1991, I owned restaurants at: 1480 Rosecrans St., San Diego, CA; and 56547 29 Palms Highway, Yucca Valley, CA, which used the mark, "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phase "ES MUY BUENO".

4. My restaurants catered to local customers and no special effort was made to cater to customers from other states or Mexico. However, I used the terms, SANTANA'S MEXICAN FOOD, and SANTANA'S MEXICAN FOOD ... ES MUY BUENO on the signage, menus, and advertising in the yellow pages. My son, Arturo Santana Lee, assisted me in purchasing a radio advertisement as early as 1988 that was broadcast on a local radio station in Yucca Valley. The advertisement used the phrases SANTANA'S MEXICAN FOOD and SANTANA'S MEXICAN FOOD ... ES MUY BUENO. The advertisement included a musical jingle which I recall distinctly and could recite in person. I believe that the signal from that radio station reaches Nevada, Arizona and/or Mexico at least occasionally.

5. I invented a potato-based burrito, named it the "California Burrito", and first sold it at my Yucca Valley restaurant. Similar potato-based burritos are now sold as California Burritos by many Mexican restaurants with which I have never had an affiliation.

6. I sold my SANTANA'S MEXICAN FOOD restaurant located at 56547 29 Palms Highway, Yucca Valley, CA to Arturo Castañeda in 1999 on an installment payment schedule, which is ongoing. As part of the sale, I allowed Mr. Castañeda to continue non-exclusive use of the mark, "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phrase "ES MUY BUENO", as such enhances his business, and enables him to make enough profit that he can continue his installment payments to me. In 2003, Arturo Castañeda opened a second SANTANA'S MEXICAN FOOD restaurant, located at 7380 Sun Valley, Twenty Nine Palms, California 92277. In 2004, Arturo Castañeda opened a third SANTANA'S MEXICAN FOOD restaurant located at 28005 Bradley Road, Sun City, California. I did not and do not object to Mr. Castañeda's extension of his business in this manner.

7. In December, 1991, I gave my SANTANA'S MEXICAN FOOD restaurant located at 1480 Rosecrans St., San Diego, CA to my son Abelardo Santana Lee and his wife, Claudia Vallarta-Santana with the transaction being completed by January 27, 1992. As part of the gift, I allowed my son Abelardo and Claudia Vallarta-Santana to continue non-exclusive use of the mark, "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phrase, "ES MUY BUENO", as such enhanced their business. No exclusive rights to use the marks, "SANTANA'S MEXICAN FOOD" and/or "ES MUY BUENO" were

included in the gift as I was still using "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phrase, "ES MUY BUENO", at my restaurant at 56547 29 Palms Highway, Yucca Valley, CA.

9. My sons, Abelardo Santana Lee, Arturo Santana Lee, and Pedro Santana Lee, and Arturo Castañeda all make and sell the "California Burrito" in their restaurants, the same burrito that I invented. If any place is to be designated as the "HOME OF FAMOUS CALIFORNIA BURRITO," it would be the Yucca Valley Restaurant where I first offered the California Burrito for sale and which is now owned by Arturo Castañeda.

9. My son Abelardo has asked me to give him exclusive rights in the mark "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phrase "ES MUY BUENO", which I refused, since the use of the marks was part of what I sold to Mr. Castañeda.

10. I am aware of Mexican restaurants, unrelated to me or my sons, using the mark: SANTANA'S MEXICAN GRILL at 3637 Thousand Oaks Boulevard, Thousand Oaks, CA and SANTANA'S MEXICAN FOOD at 10438 E. Waterloo Road, Stockton, CA, but I have no information when such use started or whether such restaurants are using the marks in commerce.

11. Since my gift of a restaurant was to my son, Abelardo Santana Lee, I required no written agreement, the transfer of ownership being mainly based on oral agreements. I have never entered into an agreement, oral or written, that transfers any exclusive trademark rights or goodwill from me to Abelardo Santana Lee, Claudia Vallarta-Santana or Santana's Grill, Inc.

12. I have had discussions with my son Abelardo Santana Lee and his wife Claudia Vallarta-Santana about the founding of my restaurants and I believe they are both knowledgeable as to the true ownership of the mark, "SANTANA'S MEXICAN FOOD" for restaurant services both with and without the phrase "ES MUY BUENO", and they know that the home of the famous California Burrito is not any restaurant that is owned by Santana's Grill, Inc.

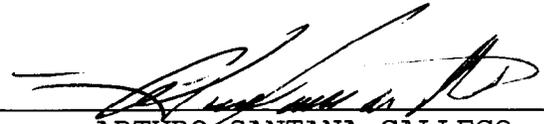
13. Prior to 1991, Abelardo had worked very infrequently in my restaurants as an occasional cashier or performing other sundry work. Abelardo was not involved in

any respect whatsoever with the management, ownership or operational decisions of my restaurants.

14. On information and belief, my son Abelardo Santana Lee and his wife Claudia Vallarta-Santana own Registrant, Santana's Grill, Inc. In January 2004, Santana's Grill, Inc. filed a trademark infringement lawsuit against my sons, Arturo Santana Lee and Pedro Santana Lee, and Arturo Castañeda, alleging, amongst other things, exclusive rights to the mark, "SANTANA'S MEXICAN FOOD ... ES MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO and design" for restaurant services, the suit being based in part on U.S. Trademark Registration 2,682,978.

16. I declare further that all statements made herein of my own knowledge and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code.

Dated: 23 March 2004

  
ARTURO SANTANA GALLEGO



Lazar & Associates  
Translating Interpreting

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TEL: (310) 453-3302 FAX: (310) 453-6002  
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4. Mis restaurantes proveyeron comidas preparadas a clientes locales y no se hizo ningún esfuerzo para proveer comidas preparadas a clientes en otros estados o en México. Sin embargo, yo usé los términos SANTANA'S MEXICAN FOOD y SANTANA'S MEXICAN FOOD... ES MUY BUENO en los carteles, menús y propagandas en las páginas amarillas. Mi hijo, Arturo Santana Lee, me asistió en la adquisición de un espacio publicitario radiofónico bien a principios de 1988, que fue emitido en una estación de radio local en Yucca Valley. El anuncio publicitario usó las frases SANTANA'S MEXICAN FOOD y SANTANA'S MEXICAN FOOD... ES MUY BUENO. El anuncio publicitario incluyó un corto musical, el que recuerdo y puedo recitar en persona. Creo que la señal de esa estación de radio llega hasta Nevada, Arizona, y/o México, por lo menos ocasionalmente.

5. Inventé un burrito en base a papas, y le puse el nombre de "California Burrito", vendiéndolo primero en mi restaurante en Yucca Valley. Actualmente muchos restaurantes mexicanos, con los cuales nunca tuve afiliación alguna, venden burritos en base a papa similares con el nombre de California Burritos.

6. Vendí mi restaurante SANTANA'S MEXICAN FOOD, ubicado en 56547 29 Palms Highway, Yucca Valley, CA a Arturo Castañeda en 1999 en un arreglo de pagos mensuales, que está vigente. Como parte de la venta, permití que el Sr. Castañeda continúe con el uso no exclusivo de la marca, "SANTANA'S MEXICAN FOOD" para servicios de restaurante, con y sin la frase "ES MUY BUENO", dado que éste mejora sus actividades comerciales, y le permite obtener suficientes ganancias, lo que a su vez le permite continuar pagándome en pagos mensuales. En 2003, Arturo Castañeda abrió un segundo restaurante SANTANA'S MEXICAN FOOD, ubicado en 7380 Sun Valley, Twenty Nine Palms, California 92277. En 2004, Arturo Castañeda abrió un tercer restaurante SANTANA'S MEXICAN FOOD, ubicado en 28005 Bradley Road, Sun City, California. No objeté ni objeto la expansión de las actividades comerciales del Sr. Castañeda de esta manera.

7. En diciembre de 1991, le di mi restaurante SANTANA'S MEXICAN FOOD sito en 1480 Rosecrans St., San Diego, CA a mí

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hijo Abelardo Santana Lee y a su esposa, Claudia Vallarta-Santana, transacción que se completó el 27 de enero de 1992. Como parte del regalo, le di permiso a mi hijo Abelardo y a Claudia Vallarta-Santana para que sigan usando la marca "SANTANA'S MEXICAN FOOD" para servicios de restaurante, con y sin la frase "ES MUY BUENO", dado que éste mejoraba sus actividades comerciales. El regalo no incluyó ningún derecho exclusivo de uso de las marcas "SANTANA'S MEXICAN FOOD" y/o "ES MUY BUENO".

8. dado que todavía estaba usando "SANTANA'S MEXICAN FOOD" para servicios de restaurante, con y sin la frase "ES MUY BUENO", en mi restaurante ubicado en 56547 29 Palms Highway, Yucca Valley, CA.

9. Mis hijos, Abelardo Santana Lee, Arturo Santana Lee, y Pedro Santana Lee, y Arturo Castañeda elaboran y venden el "California Burrito" en sus restaurantes, el mismo burrito que inventé. Si hubiera un lugar que tuviera que ser considerado el "HOGAR DEL FAMOSO CALIFORNIA BURRITO", tendría que ser el Yucca Valley Restaurant, que fue donde puse a la venta, por primera vez, el California Burrito, actualmente propiedad de Arturo Castañeda.

10. Mi hijo Abelardo me pidió que le concediera los derechos exclusivos de la marca "SANTANA'S MEXICAN FOOD" para servicios de restaurante, con y sin la frase "ES MUY BUENO", a lo que me negué, dado que el uso de la marca fue parte de lo que le vendí al Sr. Castañeda.

11. Sé que hay restaurantes mexicanos, no relacionados conmigo ni con mis hijos, que están usando la marca: SANTANA'S MEXICAN GRILL en 3637 Thousand Oaks Boulevard, Thousand Oaks, CA y SANTANA'S MEXICAN FOOD en 10438 E. Waterloo Road, Stockton, CA, pero no tengo información en cuanto a la fecha en la cual comenzaron a usar la marca o si tales restaurantes las estaban usando en sus actividades comerciales.

12. Desde de que le regalé un restaurante a mi hijo, Abelardo Santana Lee, no requerí acuerdo escrito alguno, la transferencia de propiedad se llevó a cabo en base a acuerdos orales. Nunca celebré acuerdo alguno, ni oral ni

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escrito, que transfiera derechos de marca registrada exclusivos o de buena voluntad de mi persona a Abelardo Santana Lee, Claudia Vallarta-Santana, o a Santana's Grill, Inc.

13. Tuve discusiones con mi hijo Abelardo Santana Lee y con su esposa Claudia Vallarta-Santana, en cuanto al establecimiento de mis restaurantes y creo que ambos tienen conocimiento de la verdadera propiedad de la marca "SANTANA'S MEXICAN FOOD" para servicios de restaurante, con y sin la frase "ES MUY BUENO", y saben que el lugar de nacimiento del famoso California Burrito no es ningún restaurante que sea propiedad de Santana's Grill, Inc.

14. Antes de 1991, Abelardo trabajó con muy poca frecuencia en mis restaurantes, como un cajero ocasional o ejecutando diversos trabajos. Abelardo no estuvo involucrado, de manera alguna, en la administración, propiedad o decisiones operativas de mis restaurantes.

15. En cuanto a lo que yo sé, mi hijo Abelardo Santana Lee y su esposa, Claudia Vallarta-Santana son propietarios Registrantes de Santana's Grill, Inc. En enero de 2004, Santana's Grill, Inc. entabló una acción legal en contra de mis hijos Arturo Santana Lee y Pedro Santana Lee, y Arturo Castañeda, alegando tener, entre otras cosas, los derechos exclusivos de la marca "SANTANA'S MEXICAN FOOD... ES MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO y diseño" para servicios de restaurante. El proceso judicial se basó en parte en la Inscripción de Marca registrada N° 2,682,976 de los EE.UU.

16. Por otro lado, declaro que creo que todas las declaraciones hechas en este documento, en base a mi buen entender y opinión, son verdaderas y que dichas declaraciones fueron hechas con el conocimiento de que las declaraciones falsas premeditadas y otras por el estilo son punibles con multas o prisión, o ambos, de acuerdo con lo establecido en la Sección 1001 del Título 18 del Código de los Estados Unidos.

Fecha: 23 de marzo de 2004

  
ARTURO SANTANA GALLEGO



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Web Site: http://www.lazar.com

**CERTIFICATION**

I, the undersigned, state that I have utilized the services of the qualified translator,

Eduardo Zaldivar fluent in the Spanish and English languages and said person has translated the attached document from English into Spanish.

Said translation is a complete and accurate version of the text attached hereto, to the best of my knowledge.

Javier Urey

SIGNED - Javier Urey, Project Manager

03/16/04

DATE

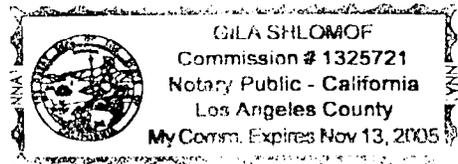
**STATE OF CALIFORNIA:**

**COUNTY OF LOS ANGELES:**

Sworn and subscribed to before me this 16th day of

March 2004.

Gila Shlomof  
NOTARY PUBLIC





City of San Diego  
**BUSINESS TAXES SECTION**  
 P.O. Box 121536  
 San Diego, California 92112

Business Tax Certificate No.  
86015722

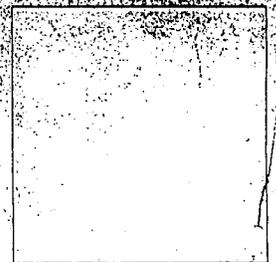
Effective Date of Change: 12-31-91

**REPORTING CHANGE IN:**

(Please check all applicable)

- LOCATION
- OWNERSHIP TYPE ON EXISTING BUSINESSES
- ACTIVITY CODE
- EMPLOYEE COUNT: From \_\_\_\_\_ to \_\_\_\_\_

ZUC NO.



OWNER'S NAME: ARTURO SANTANA

BUSINESS NAME: SANTANA'S MEXICAN FOOD

LOCATION

PREVIOUS BUSINESS ADDRESS

(required for reporting the change of location only)

CURRENT BUSINESS ADDRESS:

1480 ROSECRANS ST  
NUMBER STREET  
SAN DIEGO CA 92106 (013) 226-8745  
CITY STATE ZIP CODE PHONE #

CURRENT MAILING ADDRESS:

SAME  
NUMBER STREET SUITE  
CITY STATE ZIP CODE PHONE #

OWNERSHIP TYPE: (Check box if reporting change of ownership type only)

- Sole to Partnership
- Partnership to Sole
- Corporation to Sole
- Sole to Corporation
- Partnership to Corporation
- Corporation to Partnership

Please list below the names and full residence addresses of partners or corporate officers of your business. (Deleting use letter "D" in box and if adding partner or corporate officer, use "A" in box)

Name: ABELARDO SANTANA-LEE

Residence Address: 5810 RILEY ST #1  
SAN DIEGO, CA 92110

S.S. or Fed. Emp. I.D. No.  
55-7-91-20691

Name: CLAUDIA VALLARTA-SANTANA

Residence Address: 5810 RILEY ST #1  
SAN DIEGO, CA 92110

S.S. #  
545-91-4087

Name: \_\_\_\_\_

Residence Address: \_\_\_\_\_

S.S. # \_\_\_\_\_

PRINCIPAL BUSINESS ACTIVITY CODE New Principal Business Activity Code:

(use the business listing category)

Describe in detail activities to be conducted on the premise, including any products or services provided:

Seller's Permit # \_\_\_\_\_ Current State Contractor's License # \_\_\_\_\_

(Seller's Permit may be obtained from the State Board of Equalization, 237-7233.)

(State Contractors License may be obtained from the State Contractors Bureau, 455-0237, and is required from all contractors.)

Arturo Santana  
 OWNER'S SIGNATURE

12-31-91  
 DATE

(PLEASE FILL OUT IN DUPLICATE AND RETAIN ONE COPY)

**FOR OFFICE USE ONLY**

Zoning fee required: YES  NO   
 (circle one)

Payment Date \_\_\_\_\_ Total Paid \_\_\_\_\_ Total Owed \_\_\_\_\_

EXHIBIT A

86015722



City of San Diego  
**BUSINESS TAXES SECTION**  
 P.O. Box 121536  
 San Diego, California 92112

Business Tax Certificate No.  
86015722

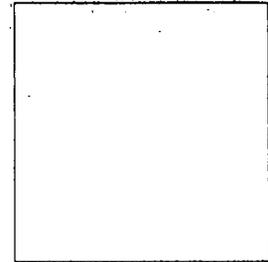
Effective Date of Change: \_\_\_\_\_ X

**REPORTING CHANGE IN:**

ZUC NO.

(Please check all applicable)

- LOCATION
- OWNERSHIP TYPE ON EXISTING BUSINESSES
- ACTIVITY CODE
- EMPLOYEE COUNT: From \_\_\_\_\_ to \_\_\_\_\_



OWNER'S NAME: CLAUDIA VALLARTA-SANTANA

BUSINESS NAME: SANTANA'S MEXICAN FOOD

LOCATION

PREVIOUS BUSINESS ADDRESS \_\_\_\_\_

(required for reporting the change of location only)

CURRENT BUSINESS ADDRESS:

1480 ROSECRANS ST.  
NUMBER STREET  
SAN DIEGO CA 92106 (619) 226-8745  
CITY STATE ZIP CODE PHONE #

CURRENT MAILING ADDRESS:

\_\_\_\_\_  
NUMBER STREET SUITE  
 \_\_\_\_\_  
CITY STATE ZIP CODE PHONE #

OWNERSHIP TYPE: (Check box if reporting change of ownership type only)

- Sole to Partnership\*
- Partnership to Sole
- Corporation to Sole
- Sole to Corporation\*
- Partnership to Corporation\*
- Corporation to Partnership\*

\*Please list below the names and full residence addresses of partners or corporate officers of your business. If deleting, use letter "D" in box and if adding partner or corporate officer, use "A" in box.

Name: ARTURO SANTANA

Residence Address: \_\_\_\_\_

S.S. or Fed. Emp. I.D. No.  
95-4083523

Name: \_\_\_\_\_

Residence Address: \_\_\_\_\_

S.S. # \_\_\_\_\_

Name: \_\_\_\_\_

Residence Address: \_\_\_\_\_

S.S. # \_\_\_\_\_

PRINCIPAL BUSINESS ACTIVITY CODE New Principal Business Activity Code: \_\_\_\_\_  
 (use the business listing category)

Describe in detail activities to be conducted on the premise, including any products or services provided:

Seller's Permit # \_\_\_\_\_ Current State Contractor's License # \_\_\_\_\_  
 (Seller's Permit may be obtained from the State Board of Equalization, 237-7733.)  
 (State Contractors License may be obtained from the State Contractors Bureau, 455-0237, and is required from all contractors.)

[Signature]  
 OWNER'S SIGNATURE:

1-27-92  
 DATE

(PLEASE FILL OUT IN DUPLICATE AND RETAIN ONE COPY)

**FOR OFFICE USE ONLY**

Zoning fee required: YES \_\_\_\_\_ NO \_\_\_\_\_  
 (circle one)

Payment Date \_\_\_\_\_ Total Paid \_\_\_\_\_ Total Owed \_\_\_\_\_

EXHIBIT B

SD 86015722

# California Business Portal

Secretary of State Kevin Shelley

**DISCLAIMER:** The information displayed here is current as of FEB 13, 2004 and is updated weekly. It is not a complete or certified record of the Corporation.

Corporation		
SANTANAS GRILL INC.		
Number: C2104624	Date Filed: 4/3/1998	Status: active
Jurisdiction: California		
Mailing Address		
5852 BOX CANYON RD		
LA JOLLA, CA 92037		
Agent for Service of Process		
CLAUDIA VALLARTA-SANTANA		
5852 BOX CANYON RD		
LA JOLLA, CA 92037		

For information about certification of corporate records or for additional corporate information, please refer to Corporate Records. If you are unable to locate a corporate record, you may submit a request to this office for a more extensive search. Fees and instructions for requesting this search are included on the Corporate Records Order Form.

Blank fields indicate the information is not contained in the computer file.

If the status of the corporation is "Surrender", the agent for service of process is automatically revoked. Please refer to California Corporations Code Section 2114 for information relating to service upon corporations that have surrendered.

*EXHIBIT C*



[CLICK HERE TO STAY INFORMED](#)  
[SPECIAL OFFER](#)

**NOW OPEN!**  
**HILLCREST:**  
 719 West Washington St

**COMING SOON!**  
 Pacific Beach:  
 2303 Garnet Ave

[Click here for our other locations](#)

[Click here to visit restaurantpage.com](#)

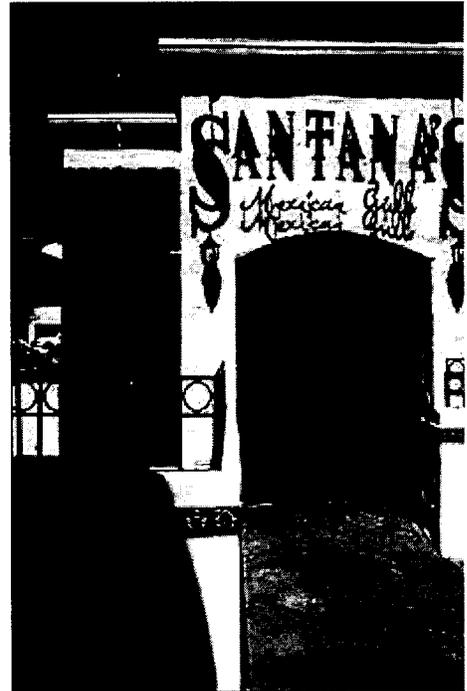


Thanks to you, we have been serving you in San Diego since 1987. We now have four locations to serve you. It is because of you that our business continues to grow.

We believe that fresher is better. That is why our food is prepared every day on our premises, and our tortillas, meat, poultry, and produce are delivered daily. We use 100% corn oil, and no preservatives.

We thank you again for the opportunity of letting us serve you. And to you who haven't tried our food, we dare you to do so!

We also offer frequent eater cards and a fresh salsa bar when you dine in at all our locations.



VISIT [WWW.SDLATINOFILM.COM](http://WWW.SDLATINOFILM.COM)



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**CLICK HERE TO STAY INFORMED**  
**SPECIAL OFFER**

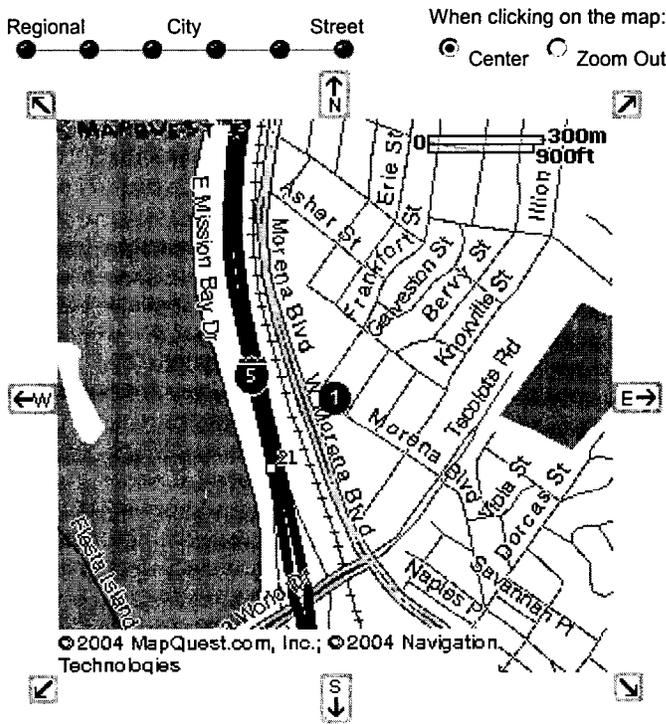
**NOW OPEN!**  
**HILLCREST:**  
 719 West Washington St

**COMING SOON!**  
 Pacific Beach:  
 2303 Garnet Ave

Click here for our other locations

Click here to visit restaurantpage.com

**1525 Morena Blvd  
 San Diego, CA 92110**



**1525 Morena Boulevard  
 San Diego, CA 92110  
 (619) 276-6010**

**Come and dine at our other locations!**

**1480 Rosecrans Street  
 San Diego, CA 92106  
 (619) 226-2033**

**580 South Pacific Street  
 San Marcos, CA 92069  
 (760) 736-4648**

**3742 Midway Drive  
 San Diego, CA 92116**

**San Diego, CA 92110  
(619) 523-9517**

**719 West Washington St  
San Diego, CA 92103  
(619) 574-8710**

**ATMs at all of our locations w/  
only \$1.00 service charge!**



**SignOnSanDiego.com**  
BY THE UNION-TRIBUNE **get on it.**

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SANT.002T

SERVICE MARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
APPLICATION FOR SERVICE MARK REGISTRATION UNDER SECTION 1(a)  
PRINCIPAL REGISTER

Mark : SANTANA'S MEXICAN  
FOOD...ES MUY BUENO  
HOME OF FAMOUS  
CALIFORNIA BURRITO  
and Design  
Int. Class : 42

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

The Applicant is:

SANTANA'S GRILL, INC.,  
a California corporation,  
2067 Cecelia Terrace, San Diego, California 92110.

Applicant has adopted and is using the service mark shown in the accompanying drawing on or in connection with the following services: **RESTAURANT SERVICES in International Class 42**; and requests that the mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051, et seq., as amended).

The service mark was first used in connection with the services on or before 1988; was first used in commerce on or before 1988; and is now in use in such commerce.

One (1) specimen for each class showing the mark as used in commerce is submitted with this application.

*EXHIBIT E*

POWER OF ATTORNEY

Applicant hereby appoints Louis J. Knobbe, Don W. Martens, Gordon H. Olson, James B. Bear, Darrell L. Olson, William B. Bunker, William H. Nieman, Arthur S. Rose, James F. Lesniak, Ned A. Israelsen, Drew S. Hamilton, Jerry T. Sewell, John B. Sganga, Jr., Edward A. Schlatter, Gerard von Hoffmann, Joseph R. Re, Catherine J. Holland, John M. Carson, Karen Vogel Weil, Andrew H. Simpson, Jeffrey L. Van Hoosear, Daniel E. Altman, Marguerite L. Gunn, Vito A. Canuso, Lynda J. Zadra-Symes, William H. Shreve, Stephen C. Jensen, Steven J. Nataupsky, Paul A. Stewart, Joseph F. Jennings, Craig S. Summers, AnneMarie Kaiser, Brenton R. Babcock, Thomas F. Smegal, Jr., Michael H. Trenholm, Diane M. Reed, Ronald J. Schoenbaum, John R. King, Frederick S. Berretta, Nancy Ways Vensko, John P. Giezentanner, Adeel S. Akhtar, Ginger R. Dreger, Thomas R. Arno, David N. Weiss, Dan Hart, Douglas G. Muehlhauser, Lori Lee Yamato, Michael K. Friedland, Dale C. Hunt, Richard E. Campbell, Paul D. Tripodi, Stacey R. Halpern, Lee W. Henderson, Mark M. Abumeri, Jon W. Gurka, Deborah S. Shepherd, Eric M. Nelson, Mark R. Benedict, Paul N. Conover, Robert J. Roby, Sabin H. Lee, Karoline A. Delaney, John W. Holcomb, James J. Mullen, III, Joseph S. Cianfrani, Joseph M. Reisman, William R. Zimmerman, Glen L. Nuttall, Tirzah Abé Lowe, Alexander Franco, Sanjivpal S. Gill, Susan Moss Natland, Eric S. Furman, James W. Hill, Rose M. Thiessen, Michael L. Fuller, Michael A. Guiliana, Mark J. Kertz, Rabinder N. Narula, Bruce S. Itchkawitz, Peter M. Midgley, Thomas S. McClenahan, Michael S. Okamoto, John M. Grover, Mallary K. de Merlier, Irfan A. Lateef, Amy C. Christensen, Sharon S. Ng, Mark J. Gallagher, David G. Jankowski, Brian C. Horne, Payson J. LeMeilleur, Diana W. Prince, Paul C. Steinhardt, William C. Boling, Sheila N. Swaroop, Benjamin A. Katzenellenbogen, Chanette Lee Armstrong, Linda H. Liu, Vincent M. Pollmeier, Jeffrey S. Ellsworth, Andrew N. Merickel, Douglas T. Hudson, David L. Hauser, Kaare D. Larson, James F. Herkenhoff, Scott L. Murray, C. Philip Poirier, Roger S. Shang, Andrew M. Douglas, Marc T. Morley, Salima A. Merani, Tina M. Chappell, Sam K. Tahmassebi, Christy L. Green, Jalal Sadr, Jonathan A. Hyman, Curtiss C. Dosier, Richard A. DeCristofaro, Joseph J. Mallon, Ph.D., Joanne L. Dufek, Thomas P. Krzeminski, Jeffrey A. Birchak, and Matthew S. Bellinger of KNOBBE, MARTENS, OLSON & BEAR, LLP, 620 Newport Center Drive, Sixteenth Floor, Newport Beach, California 92660, Telephone (949) 760-0404, as its attorneys with full power of

substitution and revocation to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith.

DECLARATION

I, Claudia Santana, declare as follows: I am properly authorized to execute this application and declaration on behalf of said Applicant; I believe Applicant to be the owner of the mark sought to be registered, or, if the application is being filed under Section 1051(b) of Title 15 of the United States Code, I believe that Applicant is entitled to use the mark in commerce and that the Applicant has to the best of my knowledge and belief, no other person, firm, corporation or association has the right to use the mark in commerce either in the identical form or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of any other person, to cause confusion or to cause mistake, or to deceive; all statements made herein of my own knowledge are true; all statements made on information and belief are believed to be true; these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or document or any resulting registration.

SANTANA'S GRILL, INC.

Dated: 11-27-01

By: 

Claudia Santana  
Vice President

# 7

SANT.002T

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Santana's Grill, Inc. )  
 )  
 Reg. No. : 2,682,978 )  
 )  
 Registered : February 4, 2003 )  
 )  
 Mark : SANTANA'S MEXICAN )  
 )  
 FOOD ... ES MUY BUENO )  
 )  
 Etc. and Design )  
 )  
 Law Office : 106 )  
 )

---

REQUEST FOR CORRECTED REGISTRATION CERTIFICATE DUE TO ERROR BY REGISTRANT UNDER 37 C.F.R. § 2.175

BOX POST REG FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Sir:

The Registrant in the above-identified Registration hereby states that the certificate of registration for this mark contains an error that occurred in good faith and through the fault of Registrant, and therefore requests issuance of a Certificate of Correction pursuant to Section 7(h) of the Trademark Act of July 5, 1946, as amended.

The date of first use of the mark and the date of first use of the mark in commerce originally provided in Application Serial No. 76/345,542 were the dates the Applicant first used the words "Santana's Mexican Food" in conjunction with its services. The mark for which registration was applied, combining these words with design elements, was not developed and used until about 1993. Therefore, while the Applicant used the words alone prior to 1993, the date of first use of the above-referenced composite mark is on or before 1993 and the date of first

11/07/2003 TSMITH 00000029 2682978

01 FC:6212

100.00 DP

EXHIBIT F

Mark : SANTANA'S MEXICAN FOOD ... ES MUY BUENO Etc. and Design  
Reg. No. : 2,682,978

use in commerce is on or before 1993. This error arose in good faith as the Applicant for this mark provided the dates of use for the words alone and not for the composite mark that was registered.

The original certificate of registration is enclosed herewith for endorsement of the correction. The fee of \$100 required by Rule 2.6(a)(9) is submitted herewith.

Mark : SANTANA'S MEXICAN FOOD ... ES MUY BUENO Etc. and Design  
Reg. No. : 2,682,978

Declaration Under 37 C.F.R. § 2.20

I, Claudia Santana, declare that I am Vice President of Santana's Grill, Inc. and am authorized to make this declaration on its behalf; that I executed the application filed as Serial No. 76/345,542 on November 27, 2001, which matured into the registration now sought to be corrected; that the term "Santana's Mexican Food" has been in use in conjunction with restaurant service since as early as 1988, in accordance with the original application; that the mark registered and incorporating this term was not used or used in commerce until about 1993; that I misunderstood what date was to be provided in the application and mistakenly believed it was the date of use or use in commerce of the words "Santana's Mexican Food"; that the attorney who prepared Application Serial No. 76/345,542 did not provide legal representation of the Registrant Corporation until 2001 and therefore relied on information I provided relating to the dates of first use and first use in commerce; that this error occurred without any intent to deceive the U.S. Patent and Trademark Office or the public when the dates of use and use in commerce were provided and when Application Serial No. 76/345,542 was executed.

I declare further that all statements made herein of my own knowledge and belief are believed to be true and these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document and the registration to which it relates.

SANTANA'S GRILL, INC.

Dated: 10-20-03

By: Claudia Santana

Name: CLAUDIA V. SANTANA

Title: Vice President

S:\DOCS\UZBUZB-3109.DOC 102003

Attorney's Docket No. 05280-0002A

TRADEMARK

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

IN THE MATTER OF REGISTRATION NO. 2,682,978 SANTANA'S FOOD ... ES  
MUY BUENO HOME OF FAMOUS  
CALIFORNIA BURRITO and  
design  
Date Registered: 4 February 2003 International Class 042

ARTURO SANTANA GALLEGO )  
 )  
Petitioner, )  
 )  
v. )  
 )  
SANTANA'S GRILL, INC. )  
 )  
Registrant )

  
03-30-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

Cancellation No.

INITIAL COMMUNICATION

Enclosed are two copies of a Petition to Cancel the above identified mark along with the required fee, a Declaration of the Petitioner and Exhibits A through F. Although the Petitioner can speak and read English, he is much more comfortable in Spanish. Therefore, the Petitioner read the enclosed Certified Spanish translation of his Declaration to make sure he understood what he was signing, and executed both the English and Spanish versions of the Declaration. A copy of the Notarized Certification is enclosed as the translation service translated three Declarations under one Certification, all relating to Cancellation Petitions of marks involved in the litigation identified below.

Registration No. 2,682,978 along with Registrations Nos. 2,682,976 and 2,631,458 are involved in litigation, Case No. 03 CV 2340 L(RBB) in U.S. District Court, Southern District of California. The Petitioner is not a party to that litigation. However, the firm Van Etten Suzumoto & Becket LLP is defending claims of trademark infringement involving the above identified Registrations. As soon as communications from the Trademark Office are received that the requested Cancellation Proceedings have been declared, a stay of the litigation will be requested.

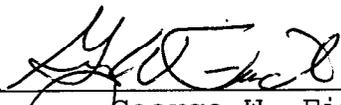


Therefore, prompt attention to this matter would be appreciated.

Dated: 26 March 2004

Reg. No.: 25,113

Tel. No.: (310) 315-8200

  
\_\_\_\_\_  
George W. Finch  
Van Etten Suzumoto & Becket LLP  
1620 26th St.  
Suite 6000, North Tower  
Santa Monica, CA 90404