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

Proceeding	92043152
Party	Plaintiff ARTURO SANTANA GALLEGO
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Attachments	Amended Petition 978.pdf (7 pages)

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)

Cancellation No. 92043152

AMENDED PETITION TO CANCEL

Petitioner, ARTURO SANTANA GALLEGO, a citizen of the United States of America whose residence address is 977 Avenida, 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. Petitioner incorporates by reference all exhibits attached to the original Petition in this proceeding. As grounds for cancellation, it is alleged that:

1. Petitioner is now and has been since at least 1988, the owner through use in commerce that Congress can regulate, 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. Although unrecognized at the time, Petitioner believes that since at least 1988, he used the mark(s) in commerce that Congress can regulate, that the restaurant services he provided were provided to citizens of Mexico and states other than California and that his radio advertising may have been

transmitted to Nevada, Arizona, and Mexico. (Dec. of A. Gallego, ¶ 4)

3. The date of first use is confirmed by Registrant's declarations, since Registrant is claiming Petitioner's use as its first use.

4. 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)

5. 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)

6. 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)

7. 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)

8. 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)

9. 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.

10. 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)

11. 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.

12. 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.

13. 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.

14. 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 in 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.

15. 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".

16. The mark SANTANA'S MEXICAN FOOD . . .ES MUY BUENO HOME OF THE FAMOUS CALIFORNIA BURRITO is confusingly similar to SANTANA'S MEXICAN GRILL and to SANTANA'S MEXICAN FOOD, with or without ES MUY BUENO, particularly since: (1) the Registrant of SANTANA'S MEXICAN GRILL disclaimed "Mexican grill" when registering that mark; and (2) HOME OF FAMOUS CALIFORNIA BURRITO is misdescriptive and confusing since all restaurants bearing the marks involved in these consolidated proceedings serve the identical "California Burrito" invented by Petitioner and whose original home was actually the Yucca Valley restaurant, owned at the time by Petitioner.

17. 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.

17. 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 was not a party to that litigation but has been since made a party.

18. 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: 12 December 2005

Reg. No.: 25,113

Tel. No.: (310) 917-1026

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Exhibit A: Ownership change form #1
Exhibit B: Ownership change form #2
Exhibit C: Secretary of State Printout
Exhibit D: Webpage printout for Santana's Grill, Inc.
Exhibit E: Claudia Vallarta-Santana Application and Declaration
of 11-27-01
Exhibit F: Communication to Examining Attorney of October 2003
including Claudia Vallarta-Santana Declaration of 10-20-03