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

Proceeding	92043152
Party	Defendant SANTANA'S GRILL, INC.
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8 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
9 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**  
10

11 ARTURO SANTANA GALLEGO,

12 Petitioner,

13  
14 v.

15 SANTANA'S GRILL, INC..

16 Registrant.  
17  
18  
19

Cancellation Nos. 92043152  
(Consolidated) 92043160  
92043175

**REGISTRANT'S TRIAL (MAIN) BRIEF**

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**I. INTRODUCTION**

In this consolidated proceedings, Petitioner, Arturo Santana Gallego, (“Petitioner”), seeks to cancel Registrant’s three service mark Registrants. U.S. Registration No. 2,631,458 for SANTANA’S MEXICAN FOOD...ES MUY BUENO. U.S. Registration No. 2,682,978 for SANTANA’S MEXICAN FOOD...ES MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO and Design, and U.S. Registration No. 2,634,976 for SANTANA’S MEXICAN GRILL.

The evidentiary record contains no competent evidence that Petitioner is the rightful owner of the three service marks that are the subject of this Consolidated Cancellation. As the holder of valid federal registrations in the marks, *Registrant* is the presumptive owner of the marks. Petitioner cannot and has not rebut that presumption, nor met his burden of proof necessary to obtain cancellation. Petitioner cannot establish it is a licensor of the marks at issue or that it maintains control over any of Registrant’s restaurants. Petitioner has not established that he is the senior user of the mark Santana’s Mexican Food, through priority of use. Indeed, there is no dispute that Petitioner does *not* control Registrant’s restaurants, and he never objected to Registrant’s use of the subject three service marks, nor as to Registrant’s intent on filing the subject three service mark applications, so Petitioner’s vague assertions that he is a licensor fail. Further, Petitioner cannot assert any rights over two of the marks because Petitioner never used those marks. The undisputed facts indicate that Registrant created two of the marks at issue after it purchased its original restaurant from Petitioner.

Petitioner has no evidence to support its specious fraud allegations. Petitioner has the burden to prove that Registrant made a *knowingly* false material statement *with intent to deceive* the Trademark Office, by clear and convincing evidence. Petitioner has not made that showing because Registrant had a good faith belief in all of its statements to the Trademark Office. Primarily, Registrant had every belief that it was the rightful owner of the marks and that no other person had any right to use the marks at issue. As such, Petitioner cannot show that Registrant made any statements in its registrations with the intent to deceive the Trademark Office.

1 Indeed, evidentiary record merit a conclusion that *Registrant* is the rightful owner of the  
2 marks at issue and that Registrant did not fraudulently obtain its registrations.

3 In sum, Petitioner has failed to establish any legal rights in his claimed mark, Santana's  
4 Mexican Food, except that of possibly a junior user in a limited/remote geographical location.  
5 Inasmuch as any rights of priority over Registrant. Further, Petitioner has wholly failed to show that  
6 Registrant is a licensee of Petitioner, and that the mark "Santana's Mexican Food" did not transfer  
7 to Registrant's predecessors, Abelardo and Claudia Santana, when he sold his first Mexican  
8 Restaurant named "Santana's Mexican Food" to Abelardo and Claudia Santana (husband & wife)  
9 in January of 1992.

10 For the reasons set out in detail below and based on the evidentiary record, the Trademark  
11 Trial and Appeal Board (the "Board") should deny Petitioner's petition to cancel. Petitioner has  
12 not established as a matter of law that (1) Petitioner is the rightful owner of the marks at issue or  
13 (2) that Registrant obtained its registrations by fraud.

14 **II. DESCRIPTION OF THE RECORD**

15 Testimonial depositions in this matter commenced on or about January 28, 2008 and  
16 concluded on or about April 4, 2008. Both sides took testimonial depositions and each side also  
17 filed Notices of Reliance. The trial record consists of the following:

18 **A. Testimonial Depositions**

19 The following testimonial depositions were taken of the following Parties and fact  
20 witnesses in this matter during the testimonial period established by the TTAB:<sup>1</sup>

21 Testimony Depositions Taken by Petitioner:

- 22 1. Claudia Vallarta Santana, Vol. 1., taken on January 28, 2008 ("Claudia V1")
- 23 2. Abelardo Santana Lee, Vol. 1., taken on January 29, 2008 ("Abelardo V1")
- 24 3. Arturo Santana Lee taken on January 30, 2008 ("Arturo SL")

25 \_\_\_\_\_  
26 <sup>1</sup> All listed testimonial transcripts taken in these proceedings were lodged/submitted by Petitioner to the  
27 TTAB on or about July 15, 2008, and are erroneously noted as exhibits to Petitioner's Trial Brief on the  
TTAVUE website. On August 1, 2008, Petitioner filed a Notice of Filing the below testimony depositions.

1 4. Arturo Santana Gallego, Vol. 1 & 2, taken on January 30-31, 2008 (“AGS”)

2 5. Arturo Castaneda, taken on January 31, 2008 (“Castaneda”)

3 Testimony Depositions Taken by Registrant/Defendant:

4 1. Abelardo Santana Lee, taken on April 3, 2008 (“Abelardo V2”)

5 2. Maite Agahnia, taken on April 3, 2008 (“Maite”)

6 3. Claudia Vallarta fka Claudia Vallarta Santana, taken on April 4, 2008  
7 (“Claudia V2”)

8 4. Benito Santana Lee, taken on April 4, 2008 (“Benito SL”)<sup>2</sup>

9 **B. Petitioner’s Notices of Reliance – Untimely Filed**

10 Petitioner filed an untimely Notice of Reliance on February 4, 2008 (Pet. NOR”). See filing  
11 date on TTAVUE. Consequently, Registrant objects to Petitioner’s Notice of Reliance, and such  
12 should not be considered by the reviewing Board. Petitioner’s Notice of Reliance was due on  
13 January 31, 2008.

14 An adverse party may object to an untimely filed Notice of Reliance and thus the evidence  
15 submitted thereunder, in his/her brief on the case. See TBMP 707.02(b)(1); and *Questor Corp. v.*  
16 *Dan Robbins & Associates, Inc.* 199 USPQ 358, 361 n.3 (TTAB 1978), *aff’d*, 599 F.2d 1009, 202  
17 USPQ 100 (CCPA 1979) and *Miss Nude Florida, Inc. v. Drost* 193 USPQ 729, 731 (TTAB 1976)  
18 (respondent’s objection to untimely notice of reliance raised for the first time in its trial brief was  
19 not waived).

20 **C. Respondent’s Notice of Reliance**

21 Registrant’s Notice of Reliance (“Reg. NOR”) was timely filed, as admitted in Petitioner’s  
22 Trial Brief, on April 15, 2008, the contents of which are hereby referenced as exhibits in support of  
23 Registrant’s Trial Brief in these proceedings.

24 **III. STATEMENT OF THE ISSUES**

25  
26 <sup>2</sup> For witnesses requiring the use of a Spanish translator, such as Benito Santana Lee, the parties stipulated to  
27 dispense with the notarization and signature requirement (unless counsel noticed discrepancies in the  
28 testimony or interpretations). See Petitioner’s Trial Brief, foot note 1.

- 1           A.     Petitioner has failed to carry his burden of proving that Registrant is not the Senior  
2                     user and rightful owner of the mark Santana’s Mexican Food...Es Muy Bueno  
3                     (“SMF”), which is the subject of its U.S. Registration No. 2,631,458; Petitioner has  
4                     failed to meet his burden of proof establishing that he has priority of use through  
5                     secondary meaning with respect to the Santana’s Mexican Food mark. at his other  
6                     restaurant located in a remote location in Yucca Valley, California: Whether  
7                     Petitioner request for cancellation of the Santana’s Mexican Food mark is barred by  
8                     the doctrines of laches, estoppel. acquiescence and uncontrolled licensing. thus  
9                     abandonment.<sup>3</sup> Petitioner has failed to prove by competent evidence that he did not  
10                    transfer/assign the name Santana’s Mexican Food to Registrant’s predecessors,  
11                    Abelardo Santana Lee and Claudia Vallarta Santana. upon the sale of his first  
12                    Mexican restaurant know herein as the “Rosecrans restaurant” to Registrant’s  
13                    predecessors in January 1992.
- 14           B.     Petitioner has failed to carry his burden of proving that Registrant is not the owner  
15                     and does not have the exclusive right to use the mark for SANTANA’S MEXICAN  
16                     FOOD...ES MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO and  
17                     Design. which is the subject of Registrant’s U.S. Registration No. 2,682,978;  
18                     whether Petitioner’s request for cancellation of this mark barred by the doctrines of  
19                     laches, estoppel, acquiescence, and uncontrolled licensing. thus abandonment.
- 20           C.     Petitioner has failed to carry his burden of proving that Registrant is not the owner  
21                     and does not have the exclusive right to use the mark SANTANA’S MEXICAN  
22                     GRILL (“SMG”). which is the subject of its U.S. Registration No. 2.634,976;  
23                     whether Petitioner’s request for cancellation of the SMG mark is barred by the  
24                     doctrines of laches. estoppel. lack of standing. acquiescence. uncontrolled licensing,  
25                     thus abandonment.

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26  
27 <sup>3</sup> Priority of use with respect to surname marks is established not by first use. but first to obtain secondary  
28 meaning.



1 It is undisputed that Registrant is the owner of the three registered service marks that are the  
2 subject of this consolidated Cancellation Proceeding: U.S. Registration No. 2,631,458 for  
3 SANTANA'S MEXICAN FOOD...ES MUY BUENO, U.S. Registration No. 2.682,978 for  
4 SANTANA'S MEXICAN FOOD...ES MUY BUENO HOME OF FAMOUS CALIFORNIA  
5 BURRITO and Design, and U.S. Registration No. 2,634.976 for SANTANA'S MEXICAN GRILL.  
6 (hereinafter "the '458, '978 and '976 Registrations." respectively, attached as Tabs 1-3). [Depo Abelardo  
7 SL2. 8:4-7; Claudia VS2. 10:7-19; Reg. NOR, Tabs 2, 3 & 4; Abelardo SL2 64:7-125, 65:1. Exh. R-23. R-  
8 24. & R-25 thereto] Registrant has continuously used the above Registered service marks from the date of  
9 creation and their Registration to the present. [Depo Abelardo SL2 64:1-25, 65:1]

10 Registrant filed applications for the three subject service marks on December 5, 2001, and  
11 the three marks, which are the subject of these proceedings, were all registered by February 2003  
12 without opposition. [Reg. NOR, Tabs 2-5; Depo. Claudia VS2 Exh. R-53. R-54 and R-25; Claudia  
13 VS1 Exh. Petitioner 2 & 3] The oaths were all signed by Claudia, and as is typical generally  
14 provide that Registrant believes it owns the marks and believes that no other person or entity may  
15 use the marks in a confusingly similar manner. [Reg. NOR, Tabs 2-5; Depo. Claudia VS2 Exh. R-  
16 53, R-54 and R-25; Claudia VS1 Exh. Petitioner 2 & 3] Claudia Vallarta Santana had a good faith  
17 and reasonable belief and still maintains those beliefs when she signed the oaths when submitting  
18 the service mark applications. [Claudia VS1 33-34:6-25; 35:1-25; 36-38; Claudia VS2 39:18-25:  
19 40:1-13; 40:14-25; 41-43, Ext R-56]

20 Petitioner, Arturo Santana Gallego, ("Gallego" or "Petitioner") is the father of Abelardo and  
21 started what would become the first restaurant to use the name "Santana's Mexican Food," located  
22 at 1480 Rosecrans Street in San Diego ("Point Loma" or "Rosecrans" business or restaurant).  
23 Petitioner has four sons, Arturo Santana Lee, Abelardo Santana Lee, Pedro Santana Lee and Benito  
24 Santana Lee. [Depo AGS 4:16: 5:6] Contrary to Petitioner's testimony, Abelardo testified that  
25 Petitioner in fact does speak English well, and can read English. [Depo Abelardo SL2 86:11-17]

26 Arturo Santana Lee, Abelardo's brother, owns and operates two Mexican food restaurants  
27 named Santana's Mexican Grill, which name was licensed to him by Registrant, but which has  
28 since been terminated. [Depo Abelardo SL1 42-49; Abelardo SL2 66:7-25, 68:25, 69:1-9] That

1 said. in Petitioner's Trial Brief ("PTB"). Petitioner claims that he opened his Mexican restaurants  
2 in 1979, called Alberto's Mexican Food. [PTB 5:3-5]. However, in response to Registrant's  
3 interrogatory No. 1, Petitioner states that he opened his first Mexican restaurant called Ablerto's in  
4 1986. [Reg. NOR, Tab 1] Arturo Castaneda ("Castaneda") is not related to Petitioner, but is a  
5 good friend of his who purchased a Mexican restaurant from Petitioner, located 56547 Twenty-  
6 Nine Palms Highway, Yucca Valley, California ("Yucca Valley restaurant"). named Santana's  
7 Mexican Food. [Depo AGS 15:17-25]

8 It is undisputed that in November 2003, Registrant filed suit in the United States District  
9 Court for trademark infringement with respect to Registrant's three service marks against  
10 Petitioner's testifying witnesses, Arturo Santana Lee and Arturo Castaneda ("Castaneda").  
11 Petitioner testified that Arturo Santana Lee and Castaneda are his licensees with respect to the use  
12 of the name Santana's Mexican Food and/or Santana's.

13 **2. The Name Change of Petitioner's Two Mexican Restaurants**

14 When Petitioner originally opened the Rosecrans restaurant and then Yucca Valley  
15 restaurant, he initially used the names "Alberto's" and then "Corona's." Petitioner was asked to  
16 change the name of his restaurants from "Corona's." In compliance with the request, the evidence  
17 establishes that Petitioner first changed the name of his Rosecrans restaurant to Santana's Mexican  
18 Food, in early 1988, and then subsequently, he changed the name of his Yucca Valley restaurant to  
19 Santana's Mexican Food. The evidence shows that the Santana's Mexican Food name was first  
20 used at the Rosecrans restaurant.

21 Petitioner testifies: [Depo AGS 37:16-19]

22 Q: Isn't true that the Rosecrans restaurant was the first Mexican restaurant that  
23 used the name Santana's Mexican Food? Isn't that right?

24 A: That I know, yes.

25 Abelardo testifies at [Depo Abelardo SL2 59:15-24]:

26 Q: If you know, what was the first restaurant name to use "Santana's Mexican  
27 Food" name?

28 A: Rosecrans.

Q: What was the next restaurant?

A: Yucca Valley

1 Further, Petitioner's son, Benito Santana Lee ("Benito"), who was responsible for  
2 remodeling and changing the signage for the Rosecrans and Yucca Valley restaurants from  
3 Corona's to Santana's Mexican Food, testified that it was his idea to name his father's two  
4 Mexican restaurants (Rosecrans and Yucca Valley) Santana's Mexican Food because of the  
5 populate musician Carlos Santana. [Depo Benito SL 6:2-22; 8:6-17; 9:2-12]. **Benito further**  
6 **testified:**

7 Q: Do you know which restaurant used the name Santana's Mexican Food first,  
the Rosecrans restaurant or the Yucca Valley restaurant?

8 A: **First Rosecrans....**

9 Q: So how long after the Rosecrans restaurant started using the name Santana's  
Mexican Food did Yucca Valley restaurant use the name Santana's Mexican  
Food, if you know?

10 A: Might have taken a month, two months, I don't remember very well. [Depo  
Benito 9:16-25]

11 Q: At the time you made the sign with the little squares that's depicted on No. 5  
12 [referring to Petitioner Exh. 5] did you at the same time make an identical  
sign for the Rosecrans location?

13 A: No. I did everything first in Rosecrans. [Depo Benito 30:14-24]

14 Further, Petitioner's fictitious business name statement for the Rosecrans restaurant, filed  
15 with the County of San Diego, reflects that the Rosecrans restaurant changed its name to Santana's  
16 Mexican Food on December 1987 [Depo ASG Vol.2, Exh. R-7; Claudia VS2, Exh. R-30 (Fictitious  
17 Business Name Statement reflecting December 1987 first use of the name Santana's Mexican Food  
18 for the Rosecrans restaurant with a filing date of March 14, 1988)] Petitioner has not produced any  
19 documentary evidence showing a name change for Yucca Valley before December 1987 nor prior  
20 March 14, 1988.

21 Moreover, in response to Registrant's interrogatory No. 1, Petitioner responded that the  
22 Yucca Valley restaurant did not open until December of 1988. [Reg. NOR, Tab 1]. Consequently,  
23 the evidence shows that by early 1988, Petitioner started using the name "Santana's Mexican  
24 Food" first at his Rosecrans restaurant and subsequently at his Yucca Valley restaurant (located  
25 150 miles away from the Rosecrans restaurant, in the desert).<sup>4</sup>  
26

27 <sup>4</sup> That said, first to use is not the test. Petitioner has submitted no evidence that he established  
28 priority of use, via secondary meaning, through use of the Santana's Mexican Food name. Hence,  
(Continued...)

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**3. Petitioner Has Failed To Show That Registrant's Does Not Rightfully Own U.S. Registration No. 2,631,458 For SANTANA'S MEXICAN FOOD...ES MUY BUENO.**

Registrant, Santana's Grill, Inc., was incorporated in 1998. From January 1992 until its incorporation in 1998, Registrant was run as a "dba" of husband and wife partnership Abelardo and his x-wife, Claudia. [Depo. Abelardo SL2, 7:5-9] References to "Registrant" herein include its predecessor business (the husband and wife partnership) prior to incorporation.

**A. Abelardo and Claudia Purchased The Rosecrans Restaurant/Business From Petitioner In January 1992, Along With The Santana's Mexican Food Mark and Associated Goodwill.**

Abelardo and Claudia purchased their first Mexican food business by acquiring the Rosecrans restaurant from Petitioner in a transaction that was completed in January 1992. [Depo Abelardo SL2 9:7-22. 10:1-13. Exh. R-10; Claudia VS1 6:1-25. 7:1-25] See Tab 4, Exh. R-10, attached hereto. Petitioner continued to own another restaurant located in a remote location of Yucca Valley, San Bernardino County, California, also named "Santana's Mexican Food." [Depo Abelardo SL1 16:21-25, 17:1-11] However, as noted above, the "Santana's Mexican Food" name was first used at the Rosecrans restaurant and only later at the Yucca Valley location.

The evidence establishes that in order to accomplish the acquisition of the Rosecrans restaurant in January 1992, Registrant's predecessor, Abelardo and Claudia, first joined Petitioner as partners in the Rosecrans restaurant business located at 1480 Rosecrans Street on December 31, 1991, and as part an parcel, took over the Rosecrans' restaurant lease for the premises on October 11, 1991. [Depo Claudia VS2 Pg.11-18; Exh. R-29 (letter agreement evidencing Abelardo and Claudia assuming lease for the Rosecrans restaurant), Exh. R-31 (City of San Diego Report in Change of Ownership, evidencing Abelardo and Claudia being added as Partners along with

(...Continued)  
Petitioner has failed to meet his burden of proof that he is the senior user of the Santana's Mexican Food mark.

1 Petitioner for the Santana's Mexican Food Rosecrans Restaurant)] See Tab 5 & 6, Exh. R-29 and  
2 R-31, attached hereto. Then, on January 27, 1992, Petitioner was "deleted" from the partnership.  
3 [Depo Claudia VS2 Pg.11-18, Exh. R-32, R-33 (San Diego County Statement of Abandonment by  
4 Petitioner of the name Santana's Mexican Food) & Exh. R-34 (City of San Diego Reporting  
5 Change In Ownership of the Rosecrans Restaurant deleting Petitioner from the partnership)]. See  
6 Tabs 7, 8 & 9, Exh. R-32, R-33, R-34, attached hereto. As a result of the sale, Petitioner did  
7 not retain any rights or control over the Rosecrans restaurant, which after the transaction was under  
8 the complete and sole control of Registrant. Further, at no time did Petitioner claim he was  
9 retaining any rights to the name Santana's Mexican Food or goodwill [Depo Abelardo SL2 8:8-16,  
10 9:7-22, 11:22-25, 12:1-21; Claudia VS2 10:10-25, 11:1-2, 18:10-25, 19:1-8 (after purchase of  
11 Rosecrans restaurant, Claudia and Abelardo understood that they had "sole rights" to the Santana's  
12 Mexican Food mark)]. At no time have Abelardo nor Claudia been a licensee of Petitioner with  
13 respect to any mark which is the subject of these proceedings. [Depo Claudia VS2 19:20-25; 20:1-  
14 12; Abelardo SL2 13:4-18]

15  
16  
17 **Petitioner Testified** [Depo AGS 13:10-13 & 19], as follows:

18 Q: Did you and Abelardo have any specific discussions at the time of that transaction  
19 [referring to Sale of the Rosecrans restaurant] by which you told him he had the  
20 exclusive right to use the name "Santana's Mexican Food"? (brackets added)

21 A: I told Abelardo to keep the business.

22 **Petitioner Testified** [Depo AGS 44:9-25; 45:1-4], in part, as follows:

23 Q: At the time you transferred the Rosecrans restaurant to Abelardo and Claudia  
24 Santana, you never told them that you were retaining any rights in the name  
25 Santana's Mexican Food," did you?

26 A: No, we never took that into consideration.

27 Q: Isn't true that at the time Abelardo and Claudia Santana took control over the  
28 Rosecrans restaurant, that you no longer had any control or authority how they  
operated the restaurant?

A: Nothing.

Q: Isn't true you have no say over how Claudia and Abelardo Santana or their  
corporation conducted marketing efforts or advertising for their restaurants? Isn't  
true?

A: That I have some right of telling them something? No, nothing.

1 Significantly, as part of the acquisition, Petitioner abandoned his Fictitious Business Name  
2 Statement in San Diego County for the name "Santana's Mexican Food" so that Registrant's  
3 predecessors, Abelardo and Claudia, could register/file it with the San Diego County Recorder's  
4 Office and thereby take possession of the service mark as their own. [Depo Claudia VS2 11-18,  
5 Exh. R-33 (San Diego County Statement of Abandonment by Petitioner of name Santana's  
6 Mexican Food) Abelardo and Claudia understood the foregoing transaction and filings to be a  
7 transfer of the mark along with the business and associated goodwill, and based on that has built its  
8 business to now seven restaurants in San Diego County. [Depo Abelardo SL2 8:8-16. 9:7-22.  
9 11:22-25, 12:1-21; Claudia VS2 10:10-25, 11:1-2, 18:10-25,19:1-8] Petitioner did not retain any  
10 rights in the service mark with respect to the business and goodwill associated with the Rosecrans  
11 restaurant. [Depo Claudia VS2 19:5-19] Neither Registrant, nor its predecessors, have ever been a  
12 licensee of Petitioner. Therefore, by virtue of the acquisition, Registrant became the sole owner of  
13 and senior user of the service mark SANTANA'S MEXICAN FOOD...ES MUY BUENO, with  
14 respect to the Rosecrans restaurant, and all the goodwill associated with that business. [Depo  
15 Claudia VS2 19:20-25: 20:1-2]

16 Registrant has continuously used the service mark that is the subject of the '458  
17 Registration, '978 Registration and '976 Registrant in commerce at 1480 Rosecrans Street, at  
18 Registrant's other restaurants, and in general advertising for all its restaurants to the present day.  
19 [Depo Abelardo SL2. 14:22, 32:13-17; 45:1-10. 46:15-21, 47:13-24, 48:21-25. 49:1]

20 It was on the above basis that Claudia signed the declaration for registration of this service  
21 mark and the others, that issued, the '458 Registration, so Registrant owns the mark and there was  
22 no fraud in procuring the registration. [Depo Claudia VS1, 33-34:6-25; 35:1-25; 36-38; Claudia  
23 VS2, 39:18-25; 40:1-13; 40:14-25; 41-43. Ext R-56]

24 **B. Abelardo Paid \$40,000.00 In Value To Petitioner For the Purchase of The  
25 Rosecrans Restaurant.**

26 Despite Petitioner's forgetfulness, Abelardo paid Petitioner the value of \$40,000 for the  
27 Rosecrans business/restaurant, and for the name Santana's Mexican Food in the form of debt  
28 forgiveness of \$20,000 that he loaned his father for a gravel plant business his father was starting in  
Mexico, and another \$20,000, for his 50% ownership interest in six unit apartment complex being  
built in Tecate, Mexico. [Depo Abelardo SL1, 6:14-25, 7:1. 52:12-25, 53:1-6; Abelardo SL2, 12:1-  
12; Benito SL Pgs. 11-13:1-14; Arturo SL 73:25; 74:1-5; 74:21-24 (Benito, Abelardo and Pedro  
Santana were business partners with respect to a six-unit apartment complex being built in Tecate

1 Mexico) Independent witness and Petitioner's son, Benito, testified he was the general contractor  
2 for the six unit apartment complex being built at the time in Tecate, Mexico. He Testifies that his  
3 brothers, Abelardo and Pedro Santana Lec, were equal partners in that construction project. Benito  
4 further testifies [Depo Benito SL. 12-13:1-13]:

- 5 Q: Do you know whether your brother Abelardo Santana ever transferred his  
6 interest in that apartment complex in Tecate, Mexico, to anyone?
- 7 A: Yes.
- 8 Q: And who did he transfer his interest to?
- 9 A: To my father
- 10 Q: And how do you know that?
- 11 A: Because...built it.
- 12 Q: Do you have an estimate whether that transfer took place in 1990?, '91?
- 13 A: At the beginning of the 1990's.

14 Petitioner testified that Abelardo could have given his wife \$20,000 for the sale of the  
15 Rosecrans restaurant from him to Abelardo. [Depo AGS. 41:14-22]. Petitioner also testified that  
16 his son Benito was the general contractor for the construction of the apartment complex in Tecate,  
17 Mexico. [Depo AGS. 41:11-18].

18 Benito further testified that he worked at a gravel plant in Mexico that was having financial  
19 problems, and that his father, Petitioner, had to borrow money to support the gravel plant. In that  
20 regard, Benito testified that the Petitioner borrowed money from his brother Abelardo. [Depo  
21 Benito SL. pages 13-16] Petitioner testified that while Abelardo was working for him as a  
22 manager at the Rosecrans restaurant before he transferred ownership of that restaurant to Abelardo,  
23 that he was working in Mexico at a gravel plant. [Depo AGS, 38:1-25. 39:1-6] Petitioner testified  
24 that he doesn't remember whether Abelardo foregave a debt of \$20,000 to him as part  
25 consideration for purchase of the Rosecrans restaurant, nor that Abelardo paid him approximately  
26 \$40,000 in value for the purchase of the Rosecrans restaurant. [Depo AGS, pages 42-43]

27 **Petitioner testifies [Depo AGS. 43:14-18]. as follows:**

- 28 Q: Isn't true that Abelardo Santana paid you approximately \$40,000 in value  
for the Rosecrans restaurant?
- A: **That's what I don't remember. See, when I owe, I forget. Very bad.**

**C. The Sale Of The Yucca Valley Restaurant**

1           Although Petitioner continued to own another restaurant in Yucca Valley, California after  
2 the sale of the Rosecrans business/restaurant to Registrant, the evidence supports the finding that  
3 this restaurant was, if anything, the second or junior user of the mark. Further, the Yucca Valley  
4 restaurant was in a remote location, 150 miles away, and was not worth anything at the time of the  
5 sale of the Rosecrans restaurant to Abelardo and Claudia. [Depo Abelardo SL1. 44:5-8] The  
6 evidence and law support a finding that Registrant was the senior user of the mark Santana's  
7 Mexican Food prior to the sale of the Yucca Valley restaurant to Castaneda by Petitioner. When  
8 Petitioner sold that restaurant to Arturo Castaneda in 1999 (six to seven years after Registrant  
9 purchased the Rosecrans restaurant), Castaneda obtained, at most, the junior user of the mark so is  
10 at best an "intermediate junior user," that has limited area rights because of use prior to issuance of  
11 the '458 Registration. See *McCarthy*, § 26:44 (Intermediate junior user's limited area defense).  
12 [Reg. NOR. Tab 1, Interrogatory No. 18] The Yucca Valley restaurant is in a remote location in  
13 the desert over 150 miles away from the City of San Diego so it was not relevant to the business  
14 and goodwill transferred to Registrant when it acquired the Rosecrans restaurant. [Reg. NOR. Tab  
15 20]

16           Further, both Petitioner and Castaneda testified that Petitioner sold the Yucca Valley  
17 restaurant to Castaneda for \$1,080,000.00, to be paid in monthly installments. However, in  
18 response to Registrant's interrogatory No. 18, Petitioner responds that he sold the Yucca Valley  
19 restaurant to Castaneda for \$500,000.00 on an installment payment schedule, and that as a result,  
20 Arturo obtained a fee non-exclusive license to use the name Santana's Mexican Food. [Reg. NOR.  
21 Tab 1, interrogatory No. 18]<sup>5</sup>

22  
23           **4.       Petitioner Has Failed To Show That Registrant's Does Not Rightfully Own U.S.**  
24                   **Registration No. 2,682,978 For SANTANA'S MEXICAN FOOD And Design.**  
25

26           <sup>5</sup> Petitioner believes that just because he was the founder because he was the founder of the name Santana's  
27 Mexican Food. [Depo AGS. 17:18-23]

1 Registrant incorporates the recited facts set forth above. Registrant's Ownership Of U.S.  
2 Registration No. 2,682,978 For SANTANA'S MEXICAN FOOD And Design. The '978  
3 Registration is a composite word and design mark that includes the words SANTANA'S  
4 MEXICAN FOOD...ES MUY BUENO and HOME OF FAMOUS CALIFORNIA BURRITO.  
5 [Depo Claudia VS2, Exh R-55]

6 Claudia created/designed this service mark and design/logo depicted on Registrant's Exh.  
7 R-28 (saw tooth pattern design) in early 1993, and first used the service mark in commerce in 1993  
8 on her existing Mexican restaurants. See Tab 9 (logo), attached hereto. [Depo Claudia VS2.  
9 38:7-25, 39:1-4, 40-42:1-8; Benito SL 11:9-22. Exh. R-28 (Logo)] Despite Petitioner testimony to  
10 the contrary, Petitioner's son, Benito, testified that he in fact did not create nor design the saw tooth  
11 triangular pattern design which is the subject of '978 Registration. [Depo Benito SL, 11:14-22,  
12 Exh. R-28]

13 Benito testified [Depo Benito SL, 24:2-8], as follows:

14 Q: So tell me the first time that you ever saw triangles associated with any of  
the Santana's restaurants.  
15 A: When they changed the design that I had created.  
16 Q: Who changed the design?  
A: Claudia

17 Registrant has used this composite design mark in commerce in various forms, sometimes  
18 without the words HOME OF FAMOUS CALIFORNIA BURRITO and sometimes only with the  
19 words SANTANA'S MEXICAN FOOD and/or SANTANA'S MEXICAN GRILL. However, it is  
20 always used with the words SANTANA'S MEXICAN FOOD or SANTANAS MEXICAN GRILL  
21 sandwiched between the distinctive upper and lower "saw tooth" patterns that are part of the  
22 design. [Depo Claudia VS2. 46:5-13] Petitioner had absolutely no involvement in the creation or  
23 first use of the service mark, '978 Registration. [Depo Claudia VS2. Pg 38:7-25, 39:1-4, 40-42:1-  
24 8; Benito SL, 11:9-22, Exh. R-28 (design/logo)]

25 Neither Petitioner nor his son, purported licensee, Arturo Santana Lee, created the  
26 logo/design depicted on '978 Registration – See Exh R-23 (design/logo) to Depo of Abelardo SL2.  
27 [Depo Abelardo SL2, 63:3-16] Petitioner does not claim to be the first user of this word mark and  
28 design, he only alleges the same ownership right to the word mark SANTANA'S MEXICAN

1 FOOD as discussed above, and he claims to have “invented” the “California Burrito.” [Depo AGS,  
2 11:22-12:10] Nor does Petitioner claim to be the first user of the phrase HOME OF FAMOUS  
3 CALIFORNIA BURRITO as a trademark. Rather, Petitioner alleges that through his inventorship  
4 claim one of his restaurants was literally the real “home” of the California Burrito. [Depo AGS,  
5 11:22, 12:10] Petitioner has not submitted any evidence that he created/designed the service mark  
6 ‘978 Registration, nor that he used this service mark prior to 1993. Further, Petitioner testified  
7 [Depo AGS. 81:18-21

7 Q: Do you know whether or not another restaurant prior to you making the a  
8 California Burrito was making burritos that were similar to the California  
9 burrito?

9 A: No. I don’t know if anybody had or not.

10 By 1993 when this word and design mark was first created Registrant’s predecessor,  
11 Claudia, Registrant was the first to use the phrase HOME OF FAMOUS CALIFORNIA BURRITO  
12 as a trademark in what issued as the ‘978 Registration. [Depo Claudia VS2. Pg 38:7-25, 39:1-4,  
13 40-42:1-8]

14 When Registrant first applied for registration of this mark, it mistakenly indicated that the  
15 date of first use in commerce coincided with the 1988 date of first use of the words SANTANA’S  
16 MEXICAN FOOD alone at the Rosecrans restaurant, and the ‘978 Registration issued with that  
17 incorrect date. This was merely an honest mistake caused by a misunderstanding between  
18 Registrant and its attorney, as obviously the design mark, as a whole, was not created and used  
19 until 1993. [Depo Claudia VS2, pages 40-43, Exh. R-56 (Certificate of Correction and supporting  
20 declaration)] The mistake was corrected by the Registrant by a Request for Corrected  
21 Registration Certificate under 37 C.F.R. § 2.175 submitted to the U.S. Patent and Trademark Office  
22 (“PTO”) in October 2003 [Depo Claudia VS2, Pages 40-43, Exh. R-56] Registrant has  
23 continuously used this service mark in commerce at all its restaurants and in general advertising for  
24 all its restaurants to the present day. [Depo Claudia VS2, 46:5-13] Accordingly, Registrant may  
25 claim priority of use of this service mark going back to its first use in 1993.

26 It was on this basis that Claudia signed the declaration for registration of this service mark  
27 that issued as the ‘978 Registration, so Registrant owns the mark and there was no fraud in  
28 procuring the registration.

1           **5.       Petitioner Has Failed To Show That Registrant's Does Not Rightfully Own.**  
2                           **Registration No. 2,634,976 For SANTANA'S MEXICAN GRILL**

3           Registrant incorporates the recited facts set forth above. The '976 Registration is a service  
4 mark for the words SANTANA'S MEXICAN GRILL. [Depo Claudia VS2, Pages 39-40, Exh. R-  
5 53 ('976 Registration)] The SANTANA'S MEXICAN GRILL service mark of the '976  
6 Registration was created by Abelardo in 1997 as part of Registrant's overall plan to incorporate its  
7 business as "Santana's Grill, Inc" and open their next Mexican Restaurant at 3742 Midway Drive,  
8 San Diego, California ("Midway restaurant"). [Depo Abelardo SL2, 29:9:11, 30:8-15, 43:17-22;  
9 Claudia VS2, pages 25-33; Arturo SL, 69:1-5] Petitioner did not create the name "Santana's  
10 Mexican Grill." [Depo AGS, 55:7-10] As part of this overall plan, Abelardo and Claudia made a  
11 deposit for the purchase of the Midway restaurant, via a check dated October 16, 1997. [Depo  
12 Claudia VS2, 28:10-25, Exh. R-43 (10-16-97 deposit check)]

13           Registrant planned to start using this mark at its other restaurant locations, the Rosecrans  
14 restaurant, Morena Boulevard restaurant, and two new locations to open at 411 Broadway in El  
15 Cajon, California ("El Cajon restaurant") and Midway restaurant, all in San Diego County.  
16 However, this mark was first used at the restaurant at the El Cajon restaurant in December of 1997  
17 because that was the first of the two new locations to open. [Depo Claudia VS2, 26:9-18; 28:5-7;  
18 Arturo SL 69:1-5] The El Cajon restaurant was opened and set up by Registrant's predecessor's  
19 Abelardo and Claudia, with the intention that it would be owned and operated by Abelardo's  
20 brother, Arturo Santana Lee, as another in the growing chain of Registrant's Mexican food  
21 restaurants. [Depo Claudia VS2, 24:23-25, 25:1-25, 26:16-18; Abelardo SL2, 66:13-25; Arturo SL,  
22 10:16-25, Pg 11:1-24, 58, 59:1-15, 60:4-17, 96:7-25, 97:1-13] It was always the understanding and  
23 intention of Abelardo that Arturo Santana Lee would operate the restaurant in the same manner as  
24 Registrant's other restaurants, with the same menu items, ingredients and quality. [Depo Claudia  
25 VS2, 24:23-25, 25:1-25; Abelardo SL1, 43:6-22; 45:11-25 (Abelardo established the El Cajon  
26 restaurant and the menu); 46, 47:15-25, 48:1-6; & 49:4-12 (Arturo Santana Lee was permitted to  
27 use the name Santana's Mexican Food **under the orders of Abelardo**)]

28           Abelardo testifies [Depo Abelardo SL1, 43:6-22], as follows:

1 Q: Did you ever acquire any ownership interest -- ...in the El Cajon restaurant?  
2 A: When my brother [referring to Arturo Santana Lee] came to me and said he  
3 wanted to open up a restaurant here in San Diego, I told him, yes, gladly I would  
4 help him, and he -- I told him the only thing I want is that we do the same, that we  
5 have the same recipes, that we buy in volume in order to save money. My benefit  
6 will be to save money in volume.  
7 Q: Was that it?  
8 A: Well, no, and he agreed. He agreed that the name [referring to Santana's Mexican  
9 Grill] was mine, that I had bought the name from my father and that the name was  
10 mine.  
11 Q: Did he tell you that or do you think that?  
12 A: I told him.

13 Abelardo further testifies [Depo of Abelardo SL1. 49:21-25], as follows:

14 A: Well, it was an understanding between him (referring to his brother Arturo Santana  
15 Lee) and I that **I was the owner of the name**. If at that moment you and I had  
16 asked him about that, he would have said that I was the owner of the name definitely  
17 (referring to the name "Santana's Mexican Grill).

18 At this time in late 1997, Arturo Santana Lee was still an employee of Registrant. [Depo  
19 Claudia VS2. 29:1-8, 49:8-11. Exh. R-61 (W-2 showing Arturo Santana Lee as an employee);  
20 Abelardo SL2. 68:9-17] Registrant's predecessors, Abelardo and Claudia, also guaranteed the  
21 lease for the El Cajon Restaurant for ten (10) years, otherwise the landlord was not going to lease  
22 the real property to Arturo Santana Lee. [Depo Claudia VS2, 25:9-16, 26:19-25, 27:1-15, Ext. R-42  
23 (10 year lease guarantee for El Cajon lease): Arturo SL, 60:4-17] Abelardo and Santana also  
24 arranged for insurance at the El Cajon restaurant from Farmers Insurance Group, and the  
25 certificates of insurance for the El Cajon restaurant reflect that Abelardo, Claudia and Arturo  
26 Santana Lee were all doing business as Santana's Mexican Grill, and reflect that **Abelardo and**  
27 **Claudia were listed as named insureds of the insurance policy for the El Cajon Restaurant**  
28 **for seven years, from December 1997 until 2004.** [Depo Claudia VS2, 30:9-25, 31:1-10. Exh. R-  
45 A through G (El Cajon restaurant Certificates of Insurance): Arturo SL, 61, 62:1-25, Exh. R-2  
(insurance certificate for El Cajon restaurant)] The Certificates of Insurance for the El Cajon  
restaurant also identify Arturo Santana Lee, Abelardo and Claudia as **partners** (the partner box is  
checked). [Depo Claudia VS2, 30:9-25, 31:1-10, Exh. R-45 A through G (Certificates of  
Insurance): Arturo SL. 62:6-2, 63:9-25, pages 64-65, Exh. R-2] Registrant also arranged for

1 various services for the El Cajon restaurant such as bookkeeping, banking, gas and electric,  
2 telephone, water, sewer, and waste disposal. [Depo Arturo SL. 96:10-25, 97:1-20] Moreover,  
3 when the Fictitious Business Name Statement in San Diego County for "Santana's Mexican Grill"  
4 was applied for, Registrant filed out the form for Arturo Santana Lee's signature using Registrant's  
5 original address, 2067 Cecelia Terrace in San Diego. This is the same original address for  
6 Registrant found on the '458, '978 and '976 Registrations. [Depo Claudia VS2. 32:1-19, Exh. R-  
7 47]

8 As noted above, Registrant orchestrated the entire set up and employee training necessary to  
9 open the restaurant at El Cajon restaurant, and instructed Arturo Santana Lee to use the "Santana's  
10 Mexican Grill" name under an implied license with the understanding that he would operate the  
11 restaurant in a manner substantially uniform to the restaurants already operated by Registrant.  
12 [Depo Abelardo SL2. 29:9:11, 30:8-15, 43:17-22; Claudia VS2. pages 25-33; Arturo SL. 59:1-15]  
13 Abelardo and Claudia worked very hard to open the El Cajon restaurant and properly train the new  
14 employees, in part to help Abelardo's brother get into a successful business in the United States,  
15 and mainly because all of Registrant's restaurants could benefit by buying the same supplies and  
16 ingredients in greater quantities and at better discounts. [Depo Abelardo SL1, 43:6-22, 47:19-25,  
17 48:13, 68:25, 69:1-9] Arturo Santana Lee agreed to this arrangement and never indicated that he  
18 wanted to do anything different, which of course would have been unacceptable to Registrant.  
19 [Depo of Abelardo SL1, 49:21-25]

20 As set forth above, in April of 1998 Registrant incorporated as "Santana's Grill, Inc.," and  
21 by July 1998 opened its fourth restaurant, the Midway restaurant using the SANTANA'S  
22 MEXICAN GRILL mark. [Depo Abelardo SL1. 47:15-18; Abelardo SL2. 43:6-22] With the  
23 opening of this fourth location Registrant prepared a uniform menu for all four restaurants,  
24 including for the El Cajon restaurant. [Depo Abelardo SL1, 45:19-25; Abelardo SL2, 66:1-25,  
25 Exh. R-27 (the uniform menu); Claudia VS2. pages 29-30:1-8, Exh. R-44 (the uniform menu  
26 created by Claudia for use at Registrant's restaurants, including the El Cajon restaurant)] **This**  
27 **menu prepared by Abelardo and Claudia contained the address of all of Registrant's four**  
28 **existing restaurants including the El Cajon restaurant owned and operated by Arturo Santana Lee.**

1 In fact, from 1998 until approximately 2005 (for seven years) Arturo Santana Lee used the menu  
2 created by Registrant, listing the addresses of *Registrant's* three other restaurants – See  
3 Respondent's Exhibit, R-1, attached to the deposition of adverse witness Arturo Santana Lee  
4 (declaration of Arturo Santana Lee and the menu evidencing use of the menu for seven years).  
5 [Depo Arturo SL, 48:20-25, 49:1-20] Arturo Santana Lee testified and declared that he had used  
6 the menu created by Registrant from 1998 to 2005. this menu advertised Registrant's other three  
7 Mexican restaurants named Santana's Mexican Food and/or Santana's Mexican Grill. [Depo Arturo  
8 SL, 52:6-25, 53-54, 58:10-19, Exh. R-1 (Arturo used Registrant's menu bearing the addresses of  
9 Registrant's other Santana's Mexican restaurant for seven years after the El Cajon restaurant  
10 opened)].

11 The record and the above further evidence the intentions and understandings of all the  
12 parties involved that the El Cajon restaurant would be allowed to use the "Santana's Mexican  
13 Grill" name only on condition that it operate in the same manner and with the same menu as the  
14 other three restaurants in Registrant's growing chain of Mexican food restaurants. Registrant  
15 therefore was controlling the manner of use of the mark at the El Cajon restaurant by training  
16 employees. establishing the menu and recipes used. and lining up the suppliers of the ingredients,  
17 among other things. What started this dispute in part was the fact that Arturo Santana Lee  
18 apparently no longer wants to operate his restaurants in the same high quality manner as  
19 Registrant's now seven other "Santana's Mexican Grill" restaurants in San Diego. However, he  
20 wants to continue using Registrant's trademark, which is causing rampant consumer confusion  
21 because Registrant's chain of restaurants has become very popular in San Diego.

22 Although Registrant gave the July 1998 date as its first use "on or before" date when it  
23 applied for the '976 Registration. this was again due to an honest misunderstanding between  
24 Registrant and its former attorney about the concept that Registrant could claim its first use through  
25 a licensee and not just by its own direct use. [Depo Claudia VS2, 39:18-25, 19:1-13]. Registrant  
26 claims ownership and use of the mark SANTANA'S MEXICAN GRILL to the December 1997  
27 first use date at El Cajon restaurant by virtue of the fact that Registrant created the mark and  
28 licensed its use to Arturo Santana Lee (then an employee of Registrant), completely set up the El

1 Cajon restaurant to be operated as one of Registrant's chain, and the continuing direct use of the  
2 mark by Registrant itself since 1998 to the present. See above for evidentiary citations.

3 It was on this basis that Claudia signed the declaration for registration of this service mark  
4 that issued as the '976 Registration, so Registrant owns the mark and there was no fraud in  
5 procuring the registration. [Depo Claudia VS2, 39:18-25, 19:1-13].

6  
7 **6. Since 1992 Neither Petitioner Nor His Purported Licensee Have Objected To**  
8 **Registrant And Its Predecessor's Use Of The Name Santana's Mexican Food**  
9 **and Santana's Mexican Grill Nor Have They Controlled Nor Exercised Any**  
10 **Control Over Registrant Use of The Three Service Marks Which Are The**  
11 **Subject Of These Proceedings.**

12 It is undisputed and the evidentiary record establishes that neither Petitioner nor is  
13 purported licensee, Arturo Santana Lee, have ever objected to Registrant's use of Registrant's three  
14 service including the names Santana's Mexican Food and Santana's Mexican Food. [Depo AGS,  
15 44:17-21, 95:16-22]. Petitioner testifies:

16 Q: But isn't true that you have no right to control his restaurants? (referring to  
17 Registrant's owner, Abelardo)

18 A: Well, him. I don't have a right. It's his. [Depo AGS, 95:16-22]

19 Q: Isn't it true you have no right to control and you have not controlled the way  
20 Abelardo Santana Lee has used the name "Santana's Mexican Food" in  
21 connection with his Mexican restaurants?

22 A: We have never done that. [Depo AGS, 96:7-11]

23 Further, Petitioner testifies that prior to filing the Petition to Cancel, which were filed after  
24 Registrant filed its trademark infringement suit against Petitioner, Castaneda, and Arturo Santana  
25 Lee, Petitioner **never objected to Abelardo's use of the Santana Mexican Food name nor his**  
26 **use of the name Santana's Mexican Grill.** [Depo AGS, 53:12-18].

27 Moreover, **Petitioner testifies that before Abelardo filed for the three service mark**  
28 **applications on December 5, 2001, Abelardo told Petitioner his intention on doing so and**  
**Petitioner did not object to the same.** [Depo AGS, 50:3-11] Similarly, Abelardo told

1 Petitioner's purported licensee. Arturo Santana Lee, that he was going to apply for a Federal  
2 trademark registrations for the "Santana's name. and Arturo Santana Lee did not object to the  
3 same. [Depo Arturo SL, 32:20-24]

4 Arturo Santana Lee testified that since the summer of 1998, he has never objected to  
5 Registrant. nor Registrant's predecessors', (Abelardo and Claudia) use of the name "Santana's  
6 Mexican Grill." [Depo Arturo SL, 104:1-12] He also testified that **he did not consult with**  
7 **Petitioner (his father) about using the name Santana's Mexican Grill for the El Cajon**  
8 **restaurant.** [Depo Arturo SL, 105:5-9]

9 Arturo Santana Lee also testified that Petitioner has no authority to control how he runs his  
10 restaurants. [Depo Arturo SL, 79:24-25, 80:1-3, 81:2-25] Arturo Santana Lee testified that he  
11 could sell his two Santana's Mexican Grill restaurants **and his father could not stop him.** and that  
12 he had sole discretion as to the menu items. and that he could sell hamburgers at this Mexican  
13 restaurants if he so chose. [Depo Arturo SL, 81:2-25] Clearly, Arturo Santana Lee's testimony is  
14 contrary to that of a licensee.

15 Moreover, Arturo Santana Lee testifies that he runs his restaurant's completely  
16 independently from Castaneda's Mexican restaurants, named Santana's Mexican Food. Castaneda  
17 is Petitioner's other purported licensee. [Depo Arturo SL, 98:22-23, 99:1 ("I run my restaurants  
18 totally independent from the restaurants that belong to Arturo Castaneda")]. Again, other evidence  
19 of uncontrolled purported licensing by Petitioner or lack of licensing.

20 In line with the above. Abelardo and Claudia have testified that Petitioner has never  
21 objected to nor controlled their use (Registrant's use) of the three service marks which are the  
22 subject matter of these consolidated proceedings. [Depo Abelardo SL2, 8:8-16, 12:22-25, 13:1-3,  
23 15:5-25 (no objection and no authority of control by Petitioner), 16-26:1-17 & 33-42 (father had no  
24 authority/no control over Registrant's restaurant operations nor use of the Santana's Mexican Food  
25 mark, Registrant had sole control over its Santana's Mexican restaurants). 50:2-9, 62-63:1 & 86:18-  
26 25, 87:1-8 (no objection to Registrant's filing trademark applications)].

27 Abelardo testifies [Depo Abelardo SL2, 8:8-16], as follows:

28

1 Q: Does your father have any control over any aspect of how you run your seven  
2 Mexican restaurants called Santana's Mexican Food or Santana's Mexican Grill?  
3 A: No.  
4 Q: Who has controlled the manner of operations of Santana's Grill, Inc.'s (Registrant)  
5 seven Mexican restaurants that you testified to earlier?  
6 A: I do (referring to Abelardo).

7 Further. Abelardo testifies that at no time after he purchased the Rosecrans  
8 restaurant/business from Petitioner did his father nor Arturo Santana Lee ever oppose or object to  
9 how Registrant used the name "Santana's Mexican Food" or operated or licensed its Mexican  
10 restaurants. [Depo Abelardo SL2, 12:22-25, 13:1-3, 15:5-20] Likewise, Abelardo testifies that  
11 prior to filing the subject service mark applications, which are the subject matter of these  
12 cancellation proceedings, Abelardo notified Petitioner (his father) and brother, Arturo Santana Lee,  
13 that he was doing so, and neither his father nor his brother, Arturo Santana Lee, objected. [Depo  
14 Abelardo SL2, 62-63:1] Abelardo also testifies that he had a formal discussion with Petitioner and  
15 Arturo Santana Lee about his plan to register the subject three service marks so if they were not in  
16 agreement they could tell him, they never objected. [Depo Abelardo SL2, 86:18-25, 87:1-8]

#### 17 **7. Registrant's Use Of The Three Registered Service Marks**

18 For over 17 years now Registrant has been very successful in developing its Mexican food  
19 restaurant business and the goodwill associated with the subject marks. Those efforts include  
20 careful quality control of the restaurants, uniformity in terms of the manner in which the restaurants  
21 are run (e.g., having employees wear uniform clothing bearing the marks and logos) and the menu  
22 items offered and ingredients used, and advertising for all the restaurants. Through this approach,  
23 Registrant has developed substantial goodwill in its registered service marks for Mexican food  
24 restaurants that offer uniformly high quality food and services. Registrant used all three service  
25 marks in commerce since their first use by Registrant or through its licensee(s). [Depo Abelardo  
26 SL2, 65:2-20, Exh. R-26 (Registrant's menu used for past 10 years), pages 50-56 (evidence of  
27 uniformity of Registrant's restaurants and goodwill), see Exh. R-15 (Registrant's website), R-16  
28 (Registrant's uniforms); Claudia VS2, pages 43-50 (evidence of Registrant's uniformity of  
operations, advertising and goodwill), Exh. R-57, R-58, R-59 and R-69 (Registrant's advertising

1 website and uniforms] Further, since 1992 to the present, Registrant has spent over \$550,000  
2 on advertising for its Santana's Mexican restaurants. [Depo Claudia VS2, 47:7-13].

3 Further, Claudia testified that upon incorporating the husband and wife partnership to  
4 Santanas Grill, Inc., she filed papers with the County of San Diego, California, evidencing the  
5 owner as of the various Mexican restaurants as Registrant, Santanas Grill, Inc., with respect to  
6 Registrant's Santana's Mexican Food/Santana's Mexican Grill restaurants. [Depo Claudia VS2,  
7 Exh. R-36, R-39, R-48, R-49, R-50, and R-51]

8 The evidentiary record shows that only Registrant is using the subject marks as true  
9 "trademarks" or symbols of origin for its chain of seven restaurants in a manner that will maintain  
10 and enhance the substantial customer recognition, loyalty and goodwill to which the marks have  
11 become associated.

12 **V. ARGUMENT**

13 **1. Petitioner Bears The Burden Of Proof Regarding Registrant Obtained**  
14 **Ownership Of The Trademark Of The '458, '978 and '976.**

15  
16 As a threshold matter, the Petitioner in a cancellation proceeding bears the burden of  
17 establishing that the challenged three service marks should be cancelled. A trademark owner's  
18 Certificate of Registration is prima face presumption that it and the mark are valid, that registrant  
19 is the owner and that registrant has the exclusive right to use the mark. 15 U.S.C. §1057(b) (2000).  
20 To rebut the presumptive validity of a registered mark, a Petitioner burden is "to establish a case  
21 for cancellation by a preponderance of the evidence. *Cerveceria Conetroamericana S.A v.*  
22 *Cerveceria India, Inc.* 13 U.S.P.Q.2d 1307, 1309 (Fed. Cir. 1989). Thus, the petitioner in a  
23 cancellation proceeding will face "greater evidentiary difficulties" than an opposer in an  
24 opposition proceeding because of the presumptive validity of the registration." *Id.* A petitioner in a  
25 cancellation proceeding asserting section 2(d) of the Lanham Act as grounds for cancellation must  
26 show by a preponderance of the evidence: (1) that it had priority and (2) that the registration of the  
27 mark creates a likelihood of confusion.

28

1 Cancellation of a valuable registration around which a valuable business good will has been  
2 built, as is the case here, should be granted only with due caution after a most careful study of all  
3 the facts. *McCarthy, McCarthy on Trademarks and Unfair Competition*, §20:64/118 (4th ed. 2004)  
4 (“*McCarthy*”)

5 **2. Petitioner Has Failed To Show That Registrant’s Does Not Rightfully Own U.S.**  
6 **Registration No. 2,682,458 For SANTANA’S MEXICAN FOOD ... ES MUY**  
7 **BUENO.**

8 As set forth above, there is no dispute that Registrant (through its Predecessor, Abelardo  
9 and Claudia Santana) acquired the restaurant at 1480 Rosecrans Street (“Rosecrans restaurant”)  
10 from Petitioner, and the testimony and documentary evidence submitted in this case establishes that  
11 the mark SANTANA’S MEXICAN FOOD of the ‘458 Registration was first used at that restaurant  
12 location.

13 Registrant (through its predecessor, husband and wife partnership, Abelardo and Claudia  
14 Santana) obtained the common law rights to the SANTANA’S MEXICAN FOOD mark when it  
15 obtained sole ownership of the Rosecrans restaurant/business in January 1992. Analysis of the  
16 documents related to the transaction (as noted above) and the applicable law compel an affirmative  
17 answer to this question. Petitioner’s unsubstantiated claims that he is still an owner or licensor of  
18 the SANTANA’S MEXICAN FOOD mark cannot rebut Registrant’s presumption of ownership,  
19 nor the evidence presented as cited above and through the testimonial depositions and Registrant’s  
20 Notice of Reliance.

21 The law is well settled that there are no rights in a trademark alone and that no rights can be  
22 transferred apart from the business with which the mark has been associated. *See J. T. McCarthy,*  
23 *McCarthy on Trademarks and Unfair Competition*, § 18:2 (4th ed. 2004) (“*McCarthy*”); *see also*  
24 *Mister Donut of America, Inc. v. Mr. Donut, Inc.*, 418 F.2d 838, 842 (9th Cir. 1969). *overruled in*  
25 *part on other grounds by Golden Door, Inc. v. Odisho*, 646 F.2d 347 (9th Cir. 1980); *Berni v.*  
26 *International Gourmet Restaurants, Inc.*, 838 F.2d 642, 646 (2d Cir. 1988) (The “well-established  
27 principle” is that a “mark is not property that may be assigned ‘in gross.’). Accordingly, the law  
28 provides that:

1  
2 When a business is sold as a going concern, the intent to transfer good will and  
3 trademarks to the buyer is presumed. Good will and trademarks are transferred  
4 even though not specifically mentioned in the contract of sale. That is,  
5 trademarks and the good will they symbolize are presumed to pass with the sale  
6 of a business.

7 *McCarthy*, § 18:37; *President Suspender Co. v. MacWillia*, 238 F. 159 (2d Cir. 1916), cert. denied;  
8 see also *Naclox, Inc. v. Lee*, 231 U.S.P.Q. 395, 399 (T.T.A.B. 1986) (intent to transfer good will  
9 and trademarks is presumed even if the trademarks and good will are not expressly mentioned in a  
10 written agreement); *Sun Valley Co. v. Sun Valley Mfg. Co.*, 167 U.S.P.Q. 304, 309 (T.T.A.B.  
11 1970); *Hi-Lo Mfg. Corp. v. Winegard Co.*, 167 U.S.P.Q. 295, 296 (T.T.A.B. 1970). An assignment  
12 in writing is not necessary to pass common law rights in a trademark. *McCarthy*, § 18:4; see also  
13 *Speed Products Co. v. Tinnerman Products, Inc.*, 179 F.2d 778, 782 (2d Cir. 1949); *Gaylord Bros.,*  
14 *Inc. v. Strobel Products Co.*, 140 U.S.P.Q. 72, 74 (T.T.A.B. 1963); *Hi-Lo Mfg. Corp.*, 167 U.S.P.Q.  
15 at 296.

16 Here the undisputed documents and testimony reveal that Registrant first joined Petitioner  
17 as partners in the Rosecrans restaurant business located at 1480 Rosecrans Street on December 31,  
18 1991, then, on January 27, 1992. Petitioner was “deleted” from the partnership. As part of the  
19 acquisition, Petitioner abandoned his Fictitious Business Name Statement in San Diego County for  
20 “Santana’s Mexican Food” so that Registrant (through its predecessor) could file it with the San  
21 Diego County Recorder’s Office and thereby take possession of the service mark as its own. Based  
22 on the evidence presented, Registrant’s predecessor’s, Abelardo and Claudia, understood this to be  
23 a transfer/sale of the SANTANA’S MEXICAN FOOD mark along with the business and associated  
24 goodwill. Based on this understanding, Registrant built its business to now encompass seven  
25 restaurants in San Diego County, and have spent hundreds of thousand of dollars promoting the  
26 mark and goodwill. The Rosecrans restaurant/business at has been under the complete and sole  
27 control of Registrant (and through its predecessors, Abelardo and Claudia) since January of 1992 to  
28 the present, over 16 years. Thus, Registrant has established by undisputed evidence a chain of title  
going back to the first user of the SANTANA’S MEXICAN FOOD mark, the Rosecrans  
restaurant/business at 1480 Rosecrans Street, and so can claim rightful ownership of the mark.

1 *McCarthy*, § 18:15; *Nordco A.S. v. Ledes*, 44 U.S.P.Q.2d 1220 (S.D.N.Y. 1997); *Money Store v.*  
2 *Harriscorp Finance, Inc.* 689 F.2d 666, 216 U.S.P.Q. 11 (7<sup>th</sup> Cir. 1982).

3 It is undisputed that the sale of the Rosecrans restaurant/business, its name and associated  
4 good will was not memorialized by a purchase and sale agreement. However, as set forth above,  
5 there are transactional documents which establish the transfer of the Rosecrans restaurant/business  
6 to Registrant's predecessor (see Recitation of Facts above). In contrast, Petitioner has no  
7 documents indicating that he somehow retained ownership of the mark or became a "licensor" of  
8 the Santana's Mexican Food mark exercising control over its use at the Rosecrans restaurant.<sup>6</sup>  
9 Accordingly, Petitioner has no tangible evidence to rebut the legal presumptions and the  
10 evidentiary record in this matter that the Santana's Mexican Food mark was in fact  
11 transferred/assigned to Registrant's predecessors along with the Rosecrans business and that  
12 Registrant owns the Santana's Mexican Food mark. Although there is a factual dispute as to  
13 whether the transaction was a gift by Petitioner or a purchase by Registrant (through its  
14 predecessor), that dispute is not material to the legal question presented. Even if the transfer of the  
15 Rosecrans business was a "gift." which is denied, such does not alter the result because the  
16 important policies underlying the legal presumption that good will and trademarks are transferred  
17 along with the transfer of a business are aimed at protecting consumers and do not depend on the  
18 price paid for the business. *See McCarthy*, § 18:2 (and authorities cited therein). Neither party has  
19 any other documents related to the Rosecrans sale transaction, and Petitioner has no documents or

---

20 <sup>6</sup> Although Petitioner continued to own his other restaurant in Yucca Valley, the evidence supports the  
21 finding that this restaurant was the second or junior user of the mark. Further, Petitioner failed to establish at  
22 trial that the Yucca Valley restaurant's use of the Santana's Mexican Food mark acquired secondary  
23 meaning. Hence, Petitioner has failed to meet its burden of proof that it he did not transfer the name and  
24 associated good will to Registrant in January 1992. When Petitioner sold that restaurant in 1999 to Arturo  
25 Castaneda, the purchaser obtained the junior user of the mark so is at best an "intermediate junior user" that  
26 has limited area rights because of use prior to issuance of the '458 Registration. *See McCarthy*, § 26:44  
27 (Intermediate junior user's limited area defense). The Yucca Valley restaurant is in a remote location in the  
28 desert in San Bernardino County over 150 miles from San Diego so was not relevant to the business and  
goodwill transferred to Registrant when it acquired the 1480 Rosecrans Street restaurant. [Reg. NOR. Tab  
20]. Thus, to the extent Petitioner does continue to exercise control over the Yucca Valley Restaurant (a  
disputed issue of material fact on Petitioner's motion), that control is irrelevant to Registrant's ownership of  
the marks.

1 even testimony indicating that he retained ownership of the Santana's Mexican Food mark,  
2 imposed geographic and usage restrictions on its use, or became a "licensor" of the mark exercising  
3 control over its use at the Rosecrans restaurant. Indeed, despite the lengthy Trial Brief by  
4 Petitioner, Petitioner never states that he controls Registrant's restaurant.

5 In sum, Petitioner's argument that he is a licensor of the marks simply doesn't ring true, and  
6 Petitioner has submitted no tangible evidence to rebut the legal presumptions nor meet his  
7 evidentiary burden that the Santana's Mexican Food mark was in fact transferred along with the  
8 Rosecrans business, and that Registrant owns the mark. *See 2 McCarthy*, § 18:2 (and authorities  
9 cited therein). To the contrary, the undisputed facts compel a conclusion that Registrant is the  
10 rightful owner of the mark that is the subject of the '458 Registration (SANTANA'S MEXICAN  
11 FOOD).

12 **3. Petitioner Has Failed To Establish Priority Of Use Through Secondary**  
13 **Meaning – No Evidence Was Offered During Trial On The Issue Of**  
14 **Acquisition Of Secondary Meaning By Petitioner, Hence, Petitioner's Claim Of**  
15 **Senior User Fails.**

16 When determining priority of ownership of a mark that requires secondary meaning, prime  
17 emphasis must be focused on **when, where and how secondary meaning was in fact established**  
18 **in the mark**. In a dispute over priority of use for a mark requiring secondary meaning, mere  
19 priority of use is insufficient. Since rights by secondary meaning are gained solely by public  
20 recognition and association, **the test is not one of who used the mark first chronologically**. The  
21 touchstone is how the buying public has come to interpret the mark in question. The test is which  
22 party has acquired secondary meaning in the mark first. Here, Petitioner claims to be the Senior  
23 user as to the Santana's Mexican Food mark, however, Petitioner has not provided competent  
24 evidence that his use of the Santana's Mexican Food mark at the Yucca Valley restaurant acquired  
25 secondary meaning, to establish priority of use. **It is well established that a Plaintiff in an inter**  
26 **partes proceeding before the Patent and Trademark Office, concerning non-inherently**  
27 **distinctive marks, must establish priority of secondary meaning in order to prevail.**

28 *McCarthy*, §§ 16:34/54-58; *National Color Laboratories, Inc. v. Philip's Foto Co.*, 273 F. Supp.  
1002, 157 U.S.P.Q. 136 (S.D.N.Y. 1976); *Schwartz v. Hampton*, 30 Misc.2d 837, 219 N.Y.S.2d

1 106: 130 U.S.P.Q. 321 (1961): *Family Record Plan, Inc. v. Mitchell*, 172 Cal.App.2d 235. 122  
2 U.S.P.Q. 414 (2d Dist. 1959): *Polaroid Corp. v. Polarad Electronics Corp.*, 182 F. Supp 350, 125  
3 U.S.P.Q. 57 (E.D.N.Y. 1960); *Saratoga Vichy Spring Co., Inc. v. Lehman*, 625 F.2d 1037, 208  
4 U.S.P.Q. 175 (2d. Cir. 1980).

5 That being said. Petitioner has wholly failed to establish that he was the first to obtain  
6 Priority of use. by showing the time and place of acquiring secondary meaning. Consequently,  
7 Petitioner has failed to meet its burden of proof that he is in fact a Senior user of the SANTANA'S  
8 MEXICAN FOOD MARK OR SANTANA'S name.

9 **4. Uncontrolled Licensing by Petitioner- Loss Of Rights In Mark Through**  
10 **Abandonment Or Break In Chain of Priority Of Use.**

11 Uncontrolled licensing may well cause a mark/designation to lose its meaning as a  
12 trademark. This results in the loss of trademark rights, through abandonment. *McCarthy*. §18:48:  
13 *American Foods, Inc., v. Golden Flake, Inc.*, 312 F.2d 619, 136 U.S.P.Q. 286 (5<sup>th</sup> Cir. 1963) Here,  
14 the evidence is straight forward that Petitioner has failed to exercise control over its alleged  
15 licensees. A finding of uncontrolled licensing may result in Petitioner's abandonment of his  
16 purported rights in the mark, or that there has been a break in the chain of continuous use  
17 necessary to prove priority of use over another. *McCarthy*. §18:48; *Yocum v. Convington*, 216  
18 U.S.P.Q. (T.T.A.B. 1982). Abandonment because of uncontrolled licensing is purely an involuntary  
19 forfeiture of trademark rights. *McCarthy*. §18:48

20 Further, Petitioner has no right nor has he ever exercised any type of control over how  
21 Registrant (and its predecessors) operated any of its seven Mexican restaurants from January 1992  
22 until the present. The latter is because Petitioner had no right to control the operations of  
23 Registrant's restaurants named Santana's Mexican Food and/or Santana's Mexican Grill. Also, up  
24 and until the time of the filing of the Petition to Cancel. Petitioner never objected to Registrant's  
25 use of SANTANA'S name. SANANTA'S MEXICAN FOOD mark nor the SANTANA'S  
26 MEXICAN GRILL Mark, nor have any of his purported licensees. including his son, Arturo  
27 Santana Lee and his business associate, Castaneda. As such, Petitioner has abandoned his right to  
28 claim ownership in the Santana's Mexican Food mark. An owner of a trademark has a duty to

1 control the nature and quality of the goods and service of which it represents. *McCarthy*, § 18:42;  
2 *Kidd v. Johson*, 100 U.S. 617; *Siegel v. Chicken Delight, Inc.*, 448 F.2d 43. 171 U.S.P.Q. 269 (9<sup>th</sup>  
3 Cir. 1971).

4 Accordingly, the Board should deny Petitioner's petition for cancellation of Registrant's  
5 '458 Registration for SANTANA'S MEXICAN FOOD...ES MUY BUENO and other two  
6 registered service marks, '978 Registration and '976 Registration.

7

8 **5. Petitioner Has Failed To Show That Registrant's Does Not Rightfully Own U.S.**  
9 **Registration No. 2,682,978 For SANTANA'S MEXICAN FOOD And Design.**

10 Registrant incorporates herein its arguments, points and authorities set forth above. As set  
11 forth above, Petitioner's claim to ownership of the '978 Registration mark SANTANA'S  
12 MEXICAN FOOD...ES MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO and  
13 Design is completely baseless. The mark includes the distinctive upper and lower "saw tooth"  
14 patterns with the words SANTANA'S MEXICAN FOOD sandwiched between. Registrant created  
15 this service mark in early 1993 by Claudia Vallarta Santana. Petitioner had absolutely no  
16 involvement in the creation or first use of the service mark of the '978 Registration in 1993. (See  
17 Recitation of Facts above).

18 Petitioner does not claim to be the first user of this word mark and design. he only alleges  
19 the same ownership right to the word mark SANTANA'S MEXICAN FOOD refuted above, and he  
20 claims to have "invented" the "California Burrito." Nor does Petitioner claim to be the first user of  
21 the phrase HOME OF FAMOUS CALIFORNIA BURRITO as a trademark. Rather. Petitioner  
22 alleges that because he invented the "California Burrito" when he owned his Yucca Valley  
23 restaurant, it is the "actual" home of the California Burrito. These allegations are irrelevant to  
24 ownership of this mark because invention of a mark or the actual underlying product has no bearing  
25 on priority of use. *See McCarthy*. § 16:11 ("Unlike patent law, rights in trademarks are not gained  
26 through discovery or invention of the mark. but only through actual usage. . . . Many years ago, the  
27 U.S. Supreme Court pointed out that the 'invention' concept of patent law has nothing to do with  
28 trademarks."); *citing United States v. Emil Steffens*. 100 U.S. 82. 25 L. Ed. 550 (1879).

1           Accordingly, the Board should grant summary adjudication in favor of Registrant that it is  
2 the rightful owner of the '978 Registration for SANTANA'S MEXICAN FOOD...ES MUY  
3 BUENO HOME OF FAMOUS CALIFORNIA BURRITO and Design.

4  
5           **6.       Petitioner Has Failed To Show That Registrant's Does Not Rightfully Own The**  
6           **Trademark Of The '976 Registration Which Was First Used By An Employee**  
7           **And Implied Licensee of Registrant.**

8  
9           Registrant incorporates herein its arguments, points and authorities set forth above. The  
10 '976 Registration is for the SANTANA'S MEXICAN GRILL service mark. Petitioner's claim to  
11 this mark is also baseless. Petitioner had no involvement in the creation or first use of this mark.  
12 Registrant, not Petitioner, is the true owner and licensor of this mark, as born out by the undisputed  
13 documentary and testimonial evidence of record. (See Recitation of Facts above).

14           As set forth above, Registrant developed this mark in late 1997 as part of its overall plan to  
15 incorporate all of its restaurants as "Santana's Grill, Inc.," which happened in early April 1998.  
16 Registrant orchestrated the entire set up of the restaurant at El Cajon restaurant in the later part of  
17 1997 with the intention that Arturo Santana Lee (the brother of Abelardo Santana Lee and at that  
18 time one of Registrant's own employees) would own and operate it in the same manner as  
19 Registrant's other restaurants. (See Recitation of Facts above).

20           As recited above, the evidence all supports Registrant's position. In late 1997 Arturo  
21 Santana Lee was still an employee of Registrant. Registrant's predecessor, Abelardo and Claudia,  
22 guaranteed the building lease for Arturo Santana Lee for 10 years, with respect to the El Cajon  
23 restaurant located at 411 Broadway, El Cajon, California. Abelardo and Claudia (Registrant's  
24 predecessor) even arranged for insurance for the 411 Broadway restaurant, and were both listed as  
25 named insureds, doing business as Santana's Mexican Grill, for the El Cajon restaurant from the  
26 very inception of the El Cajon restaurant to the year 2004. Further, the insurance declarations for  
27 the El Cajon restaurant identified Abelardo, Claudia and Arturo Santana Lee as "partners." (See  
28 Recitation of Facts above). Abelardo and Claudia also provided other necessary services, as set

1 forth above. Further, Registrant's predecessor's original address (2067 Cecelia Terrace in San  
2 Diego) was even used on the application for the Fictitious Business Name Statement in San Diego  
3 County for "Santana's Mexican Grill." There would have been no reason for Registrant to have  
4 done all these things if the El Cajon restaurant were not to be run as a licensee of Registrant. The  
5 fact of the matter is that Arturo Santana Lee was Registrant's predecessor's licensee. (See  
6 Recitation of Facts above).

7 Based on these facts, a license from Registrant (through its predecessor) to Arturo Santana  
8 Lee to use the SANTANA'S MEXICAN GRILL mark at El Cajon restaurant can be implied. See  
9 *Villanova Univ. v. Villanova Alumni Educ. Found., Inc.*, 123 F. Supp. 2d 293, 307 (E.D. Pa. 2000)  
10 ("The test for whether or not an implied license existed is based solely on the objective  
11 conduct of the parties."): *McCarthy*, § 18:43; *Birthright v. Birthright, Inc.*, 827 F.Supp. 1114,  
12 1134 (D.N.J.1993) ("[A]n implied license in fact 'arises out of the objective conduct of the parties,  
13 which a reasonable person would regard as indicating that an agreement has been reached.'");  
14 *Basic, Inc. v. Rex*, 167 U.S.P.Q. 696 (T.T.A.B. 1970); *John Anthony, Inc. v. Fashions by John*  
15 *Anthony, Inc.*, 209 U.S.P.Q. 517 (T.T.A.B. 1980) (oral license found). Such an implied license is  
16 terminable at will. *Coach House Restaurant, Inc. v. Coach & Six Restaurant, Inc.*, 934 F.2d 1551.  
17 1563 (11th Cir.1991).

18 The facts here are very similar to those presented in *Woodstock's Enter. Inc. (California) v.*  
19 *Woodstock's Enter. Inc. (Oregon)*, 43 U.S.P.Q.2d 1440, 1447-48 (T.T.A.B. 1997), in which the  
20 Board dismissed the cancellation finding an implied license because registrant assisted petitioner in  
21 opening its restaurants and petitioner's restaurants were run by a former employee of registrant  
22 who was trained by registrant. As set forth above, Registrant (through its predecessor) greatly  
23 assisted Arturo Santana Lee in setting up the El Cajon restaurant and training its new employees,  
24 and Arturo Santana Lee was himself an employee of Registrant. Terminating the implied license  
25 became necessary in this case because Arturo Santana Lee ultimately rejected Registrant's quality  
26 control efforts and stopped operating the El Cajon restaurant in a manner consistent with  
27 Registrant's other restaurants. (See Recitation of Facts above).

28

1 In sum. Petitioner has failed to establish that he has a claim to the SANTANA'S  
2 MEXICAN GRILL mark and that a reasonable trier of fact must conclude on this evidentiary  
3 record before the Board that Registrant owns this mark. Moreover, Petitioner has no standing in  
4 this proceeding to assert alleged ownership rights of any third parties. such as Arturo Santana Lee.  
5 See *McCarthy*. § 20:47 ("possible rights of a third party do not give petitioner standing to cancel  
6 the registration"); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 1340 (Fed. Cir. 1984).

7 Accordingly, the Board should deny Petitioner's petition to cancel and find in favor of  
8 Registrant that it is the rightful owner of the '976 Registration for SANTANA'S MEXICAN  
9 GRILL.

#### 10 **7. There Has Been No Fraud In Obtaining The Subject Registrations**

11 As set forth in detail above, Registrant (and its predecessor, Claudia) had every reason to  
12 believe that it was the rightful owner of the subject trademarks when it filed for the registrations, so  
13 there was no fraud. As a leading legal commentator on trademark law and practice has observed,  
14 "fraud in trademark registration procurement, though often alleged, is seldom proven." *McCarthy*,  
15 § 31:68. This case is no exception.<sup>7</sup>

16 Registrant has been using the subject trademarks for many years without objection and built  
17 a very successful business around them. Only after Registrant filed a lawsuit in U.S. District Court,  
18 Southern District in November 2003 (Registrant respectfully requests that the TTAB take judicial  
19 notice of the filing date), when Registrant was compelled to enforce its rights in order to protect its  
20 marks and its business, has this specious challenge to the registrations arisen. On this record, no  
21 reasonable trier of fact could find fraud. See *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 996 (9th  
22 Cir. 2001) (affidavit could not be fraudulent if the affiant had a good faith belief to claim of  
23 ownership of the mark; summary judgment was proper). As the TTAB is aware, fraud will not lie  
24 if it can be proven that the statement, though false, was made "with a reasonable and honest belief  
25

---

26 <sup>7</sup> To demonstrate that a federal trademark has been fraudulently procured, a challenging party must adduce  
27 evidence that the registrant actually knew or believed someone else had the right to the mark. *Marshall v.*  
28 *Treadwell* 240 F.3d 184; 57 U.S.P.Q. 2d (3d Cir. 2001).

1 that it was true. *Woodstock Enterprises, Inc. v. Woodstock Enterprises, Inc.* 43 U.S.P.Q.2d. 1440  
2 (TTAB 1997).

3  
4 **8. Fraud In Obtaining A Trademark Registration Must Be Proven By A Very**  
5 **High Standard Of Evidence That Petitioner Can Never Satisfy In This Case**

6 Fraud requires proof of a knowingly false statement material to registration of the mark that  
7 was made with intent to deceive the Trademark Office. *See Metro Traffic Control, Inc. v. Shadow*  
8 *Network Inc.*, 104 F.3d 336, 340 (Fed. Cir. 1997) (false statements not fraudulent unless made with  
9 the intent to mislead); *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352 (Fed. Cir. 1999). Both  
10 the courts and the Trademark Board regard charges of fraud in procurement of a trademark  
11 registration as a disfavored defense. *McCarthy*, § 31:68. Accordingly, fraud must be established  
12 by a very high clear and convincing standard of proof:

13  
14 Fraud in a trademark cancellation is something that must be "proved to the hilt" with  
15 little or no room for speculation or surmise; considerable room for honest mistake,  
inadvertence, erroneous conception of rights, and negligent omission; and any  
doubts resolved against the charging party.

16 *Yocum v. Covington*, 216 U.S.P.Q. 210, 216 (T.T.A.B. 1982); *Bonaventure Associates v. Westin*  
17 *Hotel Co.*, 218 U.S.P.Q. 537, 540 (T.T.A.B. 1983); *McCarthy*, § 31:68. Proof of a false statement  
18 alone does not constitute fraud without evidence of bad intent and materiality, and a reasonable  
19 belief in the truth of even a false statement defeats a charge of fraud.

20  
21 Intent to deceive must be "willful." If it can be shown that the statement was a  
22 "false misrepresentation" occasioned by an "honest" misunderstanding,  
23 inadvertence, negligent omission or the like rather than one made with a willful  
24 intent to deceive, fraud will not be found. . . . Fraud, moreover, will not lie if it can  
be proven that the statement, though false, was made with a reasonable and honest  
belief that it was true . . . or that the false statement is not material to the issuance or  
maintenance of the registration.

25 *McCarthy*, § 31:66, citing *Smith International, Inc. v. Olin Corp.*, 209 U.S.P.Q. 1033, 1043  
26 (T.T.A.B. 1981). Based on these high requisite standards of proof and the record in this case as set  
27 forth above, Petitioner's allegations of fraud are frivolous and should be dismissed.



1 Where there is reasonable doubt as to who is the owner of a mark, it is not fraud to  
2 state in the application oath that one "believes himself, or the firm, corporation or  
3 association in whose behalf he makes the verification, to be the owner of the mark  
4 sought to be registered." The Trademark Board has noted that the application oath  
5 is phrased in terms of a "belief" of the applicant, such as to "preclude a definitive  
6 statement by the affiant that could be ordinarily used to support a charge of fraud."  
7 The Board concluded that if the applicant had an honest and good faith belief that it  
8 was the owner of the mark when it signed the application oath, then this is sufficient  
9 to negate any inference of fraud.

6 *McCarthy*, § 31:71; citing *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 U.S.P.Q. 327, 329-  
7 30 (T.T.A.B. 1976). See also *Woodstock's (California)*, 43 U.S.P.Q.2d at 1443-44.

8 Registrant's declarations in three subject applications were the same and are expressed in  
9 terms of Registrant's belief that it is the owner of the marks.

10  
11 I, Claudia Santana, declare as follows: I am properly authorized to execute  
12 this application and declaration on behalf of said Applicant; I believe Applicant to  
13 be the owner of the mark sought to be registered, or, if the application is being filed  
14 under Section 1051(b) of Title 15 of the United States Code. I believe that Applicant  
15 is entitled to use the mark in commerce and that the Applicant has to the best of my  
16 knowledge and belief, no other person, firm, corporation or association has the right  
17 to use the mark in commerce either in the identical form or in such near resemblance  
18 thereto as to be likely, when used on or in connection with the goods or services of  
19 any other person, to cause confusion or to cause mistake, or to deceive: all  
20 statements made herein of my own knowledge are true: all statements made on  
21 information and belief are believed to be true: these statements were made with the  
22 knowledge that willful, false statements and the like so made are punishable by fine  
23 or imprisonment, or both, under Section 1001 of Title 18 of the United States Code,  
24 and that such willful, false statements may jeopardize the validity of the application  
25 or document or any resulting registration.

19 As set forth above, Registrant is the owner of the subject marks, and certainly the objective  
20 evidence establishes that Registrant could at least have a reasonable belief that it was the exclusive  
21 owner when it applied for registration, and that no others had superior rights. No reasonable trier of  
22 fact should conclude otherwise.

24 **11. Any Alleged Misstatements By Registrant Of The Dates Of First Use Of The**  
25 **Subject Trademarks Do Not Constitute Fraud**

26  
27 Petitioner has also asserts in his trial brief that Registrant committed fraud in stating  
28 erroneous dates of first use in the applications for registration of the subject marks, particularly

1 with respect to the '978 Registration that issued with the incorrect date. As discussed above, that  
2 mistake was corrected by the Registrant by a Request for Corrected Registration Certificate under  
3 37 C.F.R. § 2.175 submitted to the PTO in October 2003. In any event, this basis for alleged fraud  
4 also fails as a matter of law. "The Trademark Board has consistently held for some years that a  
5 misstatement of the date of first use in a use-based application is not fraudulent as long as there has  
6 been some valid use of the mark prior to the filing date. That is, the exact date of claimed first use  
7 is immaterial to the grant of a registration, just so long as the first use in fact preceded the  
8 application date." *McCarthy*, § 31:74; citing, among others, *Western Worldwide Enter. Group, Inc.*  
9 *v. Qinqdao Brewery*, 17 U.S.P.Q.2d 1137, 1141 (T.T.A.B. 1990) (the Trademark Board has  
10 repeatedly held that for a use-based application, an erroneous date of first use does not constitute  
11 fraud so long as there was some valid use of the mark prior to the filing). As set forth above,  
12 Registrant contends that the subject registrations, as corrected, do now accurately state the "on or  
13 before" use dates for the subject marks. But even if these dates are not correct, there can be no  
14 fraud as a matter of law. Here, Claudia reasonably believed that she was entitled to claim date of  
15 first use dating back to the when the Rosecrans restaurant first started to use the SANTANA'S  
16 MEXICAN FOOD name, such being 1988. (See Recitation of Facts above).

17  
18 **12. There Is No Obligation To Disclose Use By Others If Registrant Has A Good**  
19 **Faith Belief That It Owns The Subject Trademark**  
20

21 Finally, Petitioner has also generally alleged that Registrant committed fraud in procuring  
22 the subject registrations by not disclosing the use of the marks by others. These fraud allegations  
23 also fail as a matter of law, because there is no obligation to disclose use by others if the applicant  
24 has a good faith belief that it is the senior user. *See generally McCarthy*, §§ 31:75-31:77. To  
25 establish such a fraud claim, Petitioner would have to prove by clear and convincing evidence not  
26 only that the other user had rights in the mark superior to Registrant, but also that Registrant knew  
27 that the other user had rights superior to Registrant's and intended to procure a registration to  
28

1 which Registrant was not entitled. *McCarthy*, § 31:75, citing *Ohio State Univ. v. Ohio Univ.*, 51  
2 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 1999).

3 A good faith belief that Registrant has superior rights to the marks again defeats any claim  
4 of fraud, even with respect to any junior users who may have limited common law rights in certain  
5 areas:

6  
7 **If applicant has a good faith belief that it is the senior user, then the oath**  
8 **cannot be fraudulent.** Any alleged failure to disclose use by junior users is  
9 irrelevant and could not be material to the grant of a federal registration. In the  
10 absence of a court holding or a concurrent use proceeding, the senior user is entitled  
11 to an unrestricted federal registration notwithstanding the existence of junior users  
12 who might have common law rights of use in certain parts of the United States.  
13 That is, the signing of the oath and non-disclosure of believed junior users is not  
14 material to the grant of a federal registration. If such use by others was disclosed to  
15 the PTO examiner, it would not affect the grant of a registration. Therefore, a prior  
16 user has no duty to disclose to the PTO the subsequent use of others.

17 *McCarthy*, § 31:77, citing, among other authorities, *Giant Food, Inc. v. Malone & Hyde, Inc.*, 522  
18 F.2d 1386, 1394 (C.C.P.A. 1975); *Citibank, N.A. v. Citibanc Group, Inc.*, 215 U.S.P.Q. 884, 901  
19 (N.D. Ala. 1982), aff'd, 724 F.2d 1540 (11th Cir. Ala. 1984) (common law rights of junior users  
20 need not be disclosed: their rights are not material to registration to the senior user); *Capital*  
21 *Speakers, Inc. v. Capital Speakers Club*, 41 U.S.P.Q.2d 1030, 1033 (T.T.A.B. 1996) (“As the prior  
22 user, respondent was under no obligation to disclose to the PTO petitioner’s subsequent use when  
23 respondent applied to register its mark.”).

24 As set forth above, Registrant is the owner of the subject marks, and certainly the objective  
25 evidence establishes that Registrant could at least have a reasonable belief that it was the senior  
26 user of the subject marks. Accordingly, the Board should deny Petitioner’s petition to cancel and  
27 find in favor of Registrant that there was no fraud in procuring the subject registrations.

28 **V. CONCLUSION**

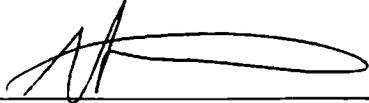
For the foregoing reasons, Registrant respectfully requests that the Board deny, jointly and  
severally Petitioner’s petition to cancel its three service mark Registrations and find in favor  
of dismissing Petitioner’s Consolidated Cancellation in its entirety.

In the alternative, for the foregoing reasons, Registrant respectfully requests that the Board  
find in Registrant’s favor on one or more of the following separate issues:

- 1           1.     That Registrant is the owner of the mark SANTANA'S MEXICAN FOOD...ES  
2           MUY BUENO that is the subject of the '458 Registration;  
3           2.     That Registrant is the owner of the mark SANTANA'S MEXICAN FOOD...ES  
4           MUY BUENO HOME OF FAMOUS CALIFORNIA BURRITO and Design that is  
5           the subject of the '978 Registration;  
6           3.     That Registrant is the owner of the mark SANTANA'S MEXICAN GRILL. that is  
7           the subject of the '976 Registration;  
8           4.     That Registrant has not committed fraud in the procurement of any of the '458, '978  
9           and '976 Registrations.

10 Dated: August 13, 2008

BREMER WHYTE BROWN & O'MEARA LLP

11  
12 By: 

Nicole Whyte, Esq.  
Michael A. Sandstrum, Esq.  
Attorneys for Registrant  
SANTANAS GRILL, INC.

13  
14  
15  
16 **CERTIFICATE OF SERVICE**

17  
18           It is hereby certified that a copy of the foregoing **Registrant's Trial Brief** has been  
19 sent is 13<sup>th</sup> day of August, 2008. by first class mail, postage prepaid, to Cris Armenta, 11900  
20 Olympic Blvd., Suite 730, Los Angeles, CA 90064.

21   
22 Michael A. Sandstrum

**TAB 1**

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,631,458

Registered Oct. 8, 2002

SERVICE MARK  
PRINCIPAL REGISTER

SANTANA'S MEXICAN FOOD...ES MUY BUENO

SANTANA'S GRILL, INC. (CALIFORNIA COR-  
PORATION)  
2067 CECELIA TERRACE  
SAN DIEGO, CA 92110

FOR: RESTAURANT SERVICES, IN CLASS 42  
(U.S. CLS. 100 AND 101).

FIRST USE 0-0-1988; IN COMMERCE 0-0-1988.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "MEXICAN FOOD", APART FROM  
THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF "ES MUY  
BUENO" IS "IT'S VERY GOOD".

SER. NO. 76-345,538, FILED 12-5-2001.

SHAVELL MCPHERSON, EXAMINING ATTORNEY

RESPONDENT'S EXHIBIT NO. 24  
GALLEGO V. SANTANA'S

Case No. 92043152

EXHIBIT 1 PAGE 1 OF 4

## **TAB 2**

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office  
Amended

Reg. No. 2,682,978

Registered Feb. 4, 2003

OG Date Feb. 17, 2004

SERVICE MARK  
PRINCIPAL REGISTER



SANTANA'S GRILL, INC. (CALIFORNIA CORPORATION)  
2067 CECILIA TERRACE  
SAN DIEGO, CA 92110

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MEXICAN FOOD" AND "CALIFORNIA BURRITO", APART FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF "ES MUY BUENO" IS "IT'S VERY GOOD".

FOR: RESTAURANT SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).  
FIRST USE 0-0-1993; IN COMMERCE 0-0-1993.  
SER. NO. 76-345,542, FILED 12-5-2001.

*In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Feb. 17, 2004.*

DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE

Claudia Vallarta  
Respondent's Ex. 55  
Gallego v Santana's  
4/4/08 - 1 pg  
V.R. Weiss, CSR

## **TAB 3**

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

**United States Patent and Trademark Office**

Reg. No. 2,634,976

Registered Oct. 15, 2002

**SERVICE MARK  
PRINCIPAL REGISTER**

**SANTANA'S MEXICAN GRILL**

SANTANA'S GRILL, INC. (CALIFORNIA COR-  
PORATION)  
2067 CECELIA TERRACE  
SAN DIEGO, CA 92110

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "MEXICAN GRILL", APART FROM  
THE MARK AS SHOWN.

FOR: RESTAURANT SERVICES, IN CLASS 42  
(U.S. CLS. 100 AND 101).

SER. NO. 76-345,537, FILED 12-5-2001.

FIRST USE 7-0-1998; IN COMMERCE 7-0-1998.

SHAVELL MCPHERSON, EXAMINING ATTORNEY

Claudia Vanapia  
Respondent's Ex. 53  
Gallego v Santana's  
4/4/08 - 1 pg  
V.R. Weiss, CSR

Case No. 92043152

**TAB 4**



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:**  
 (Please check all applicable)

ZUC NO.

- 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 SUITE  
SAN DIEGO CA 92106 (615) 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] [Signature] X 1-27-92  
 OWNER'S SIGNATURE 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 \_\_\_\_\_

TR-1027 (Rev. 8-80)

86015722

Case No. 92043152

RESPONDENT'S EXHIBIT NO. 10  
 GALLEGO V. SANTANA'S

SG00053

SG00053

## **TAB 5**

October 11, 1991

Dr. George Farres  
3358 F. Street  
San Diego, California 92102

Claudia Vallarta  
Respondent's Ex. 29  
Gallego v Santana's  
4/4/08 - 1 pg  
V.R. Weiss, CSR

Dear Dr. George Farres:

This is the letter of what we agreed to do in our conver-  
sation today regarding the contract for rent of the  
property located at 1480 Rosecrans Street corner with Hugo.

Term of lease: Five (5) years; with an option to extend  
for five (5) more.

Rent: Rent to be \$3,500.00 per month starting  
January 7th, 1992 and to remain the same  
for this year.  
2nd year  
Starting January 7th, 1993 rent to be  
\$4,000.00 per month and to remain the  
same for this year.  
3rd, 4th & 5th year;  
There will be a 5% percent increase  
annually for each year.

Before the 5th year is over (1996) we will  
get together to discuss about the 5 year  
option.

Lease document: The lease is to be an INDUSTRIAL/  
COMMERCIAL LEASE, NNN (Triple Net).

Premises: Premises are to be taken in it's PRESENT  
CONDITION (AS IS), including all equipment  
and building.

Very truly yours,

*C Vallarta*  
CLAUDIA VALLARTA-SANTANA

*Dr. George Farres*  
DR. GEORGE FARRES

*A. Santana*  
ABELARDO SANTANA

*C Vallarta*  
CLAUDIA VALLARTA-SANTANA

All terms & conditions of previous 12-10-91  
Lease are in effect.

*C Vallarta*      *G. Farres*

**TAB 6**



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:**

ZUC NO.

(Please check all applicable)

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

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 (619) 226-879  
CITY STATE ZIP CODE PHONE #

CURRENT MAILING ADDRESS:

SAN  
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: ABELARDO SANTANA-LEE  
 Residence Address: 5810 RILEY ST #1  
SAN DIEGO, CA 92110

S.S. or Fed. Emp. I.D. No.

Name: CLAUDIA VALLARTA-SANTANA  
 Residence Address: 5810 RILEY ST #1  
SAN DIEGO, CA 92110

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 Contractors 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.)

[Signature]  
 OWNER'S SIGNATURE: \_\_\_\_\_ DATE: 12-31-91

(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: 12.00

TA-1227 (Rev. 6-90)

Case No. 92043152

Claudia Vallarta  
 Respondent's Ex. 31  
 Gallego v Santana's  
 4/4/08 - 1 pg  
 V.R. Weiss, CSR

86015722

**TAB 7**

PLEASE PRINT OR TYPE  
FIRMLY. YOU ARE MAKING  
MULTIPLE COPIES!

ANNETTE J. EVANS  
RECORDER/COUNTY CLERK  
P.O. Box 1750  
San Diego, California 92112-4147  
(619) 531-5210

This Space For Use of County Clerk

FILED  
Annette J. Evans, Clerk  
JAN 09 1992

SEE REVERSE SIDE  
FOR INSTRUCTIONS

FILING FEE  
\$13.00 - FOR FIRST BUSINESS NAME ON STATEMENT  
\$ 2.00 - FOR EACH ADDITIONAL BUSINESS NAME  
FILED ON SAME STATEMENT AND DOING  
BUSINESS AT THE SAME LOCATION  
\$ 2.00 - FOR EACH ADDITIONAL OWNER IN EXCESS  
OF ONE OWNER

FICTITIOUS BUSINESS NAME STATEMENT

THE NAME[S] OF THE BUSINESS[ES]:

(1) SANTANA'S MEXICAN FOOD  
(Print Fictitious Business Name[s] on Line Above)

(2) LOCATED AT: 1480 ROSECRANS ST.  
(Street Address of Business - If No Street Address Assigned - Give Exact Location of Business Plus P.O. Box or Rural Route)  
IN: SAN DIEGO, CA 92106  
(City and Zip)

IS [ARE] HEREBY REGISTERED BY THE FOLLOWING OWNER(S):

(3) #1 ABELA KTO SANTANA-LEE  
(Full Name - Type/Print)

5810 RILEY ST.  
(Residence address if not incorporated)  
(State of incorporation if incorporated)

SAN DIEGO, CA 92110  
(City and Zip)

#2 CLAUDIA VALLARTA-SANTANA  
(Full Name - Type/Print)

5810 RILEY ST.  
(Residence address if not incorporated)  
(State of incorporation if incorporated)

SAN DIEGO, CA 92110  
(City and Zip)

#3  
(Full Name - Type/Print)

(Residence address if not incorporated)  
(State of incorporation if incorporated)

(City and Zip)

#4  
(Full Name - Type/Print)

(Residence address if not incorporated)  
(State of incorporation if incorporated)

(City and Zip)

(4) This business is conducted by:  an Individual  Individuals - Husband and Wife  a General Partnership  
 a Limited Partnership  a Corporation  a Business Trust  Co-Partners  a Joint Venture  
 an Unincorporated Association - other than a Partnership  Other (Specify)

(5) THE REGISTRANT COMMENCED THE TRANSACTION OF BUSINESS ON: JAN 1, 1992

SIGNATURE OF REGISTRANT: [Signature]

CLAUDIA VALLARTA-SANTANA  
(Print name of person signing and, if a Corporate Officer, also state title)

THIS STATEMENT WAS FILED WITH ANNETTE J. EVANS, RECORDER/COUNTY CLERK OF SAN DIEGO COUNTY  
ON DATE INDICATED BY FILE STAMP ABOVE.

THE FILING OF THIS STATEMENT DOES NOT OF ITSELF AUTHORIZE THE USE IN THE STATE OF A FICTITIOUS BUSINESS NAME IN VIOLATION OF THE RIGHTS OF ANOTHER UNDER FEDERAL, STATE, OR COMMON LAW (see section 14400 et seq., Business and Professions Code) THIS FICTITIOUS BUSINESS STATEMENT NAME EXPIRES FIVE (5) YEARS FROM THE DATE IT WAS FILED IN THE OFFICE OF THE COUNTY CLERK. IF YOU INTEND TO CONTINUE BUSINESS UNDER THIS NAME A NEW FICTITIOUS BUSINESS NAME STATEMENT MUST BE FILED PRIOR TO.

JAN 09 1992

Case No. 92043152

Claudia Vallarta  
Respondent's Ex. 32  
Gallego v Santana's  
4/4/08 - 2 pgs  
V.R. Weiss, CSR

[Signature]

ASSIGNED FILE NO. 3200475

SG00002

## **TAB 8**

PLEASE PRINT OR TYPE

This Space For Use of Recorder/County Clerk

ANNETTE J. EVANS  
RECORDER/COUNTY CLERK  
P.O. BOX 1750 SAN DIEGO, CA 92112-4147  
(619) 531-5210

F Annette J. Evans, Clerk D  
JAN 09 1992  
COUNTY

SEE REVERSE SIDE  
FOR INSTRUCTIONS

FILING FEE - \$5.00  
FOR EACH BUSINESS NAME

STATEMENT OF ABANDONMENT OF USE OF FICTITIOUS BUSINESS NAME

In reference to the activity doing business as:

(1) SANTANA'S MEXICAN FOOD  
(Fictitious Business Name[s])

(2) Located At: 1480 ROSECRANS ST  
(Street Address - If No Street Address Assigned - Give Exact Location of Business Plus P.O. Box or Rural Route)  
SAN DIEGO CA 92106  
(City and Zip Code)

The following registrant(s) has (have) abandoned use of the fictitious business name:

(3) #1. ARTURO SANTANA-GALLEGO #2. \_\_\_\_\_  
(Full Name - Type/Print) (Full Name - Type/Print)

3211 HUGO ST \_\_\_\_\_  
(Residence Address of State of Incorporation) (Residence Address or State of incorporation)

SAN DIEGO, CA 92106 \_\_\_\_\_  
(City and Zip Code) (City and Zip Code)

#3. \_\_\_\_\_ #4. \_\_\_\_\_  
(Full Name - Type/Print) (Full Name - Type/Print)

\_\_\_\_\_  
(Residence Address or State of Incorporation) (Residence Address or State of Incorporation)

\_\_\_\_\_  
(City and Zip Code) (City and Zip Code)

The fictitious business name referred to above was filed in San Diego County on

8-25 19 88, and assigned File No. 8805855

(4) Signature of registrant: [Signature]

ARTURO SANTANA-GALLEGO  
(Printed Name of Person Signing and if a Corporate Officer, also State Title)

This statement was filed with the Recorder/County Clerk of San Diego County on date indicated by file stamp above.

NEW ASSIGNED NO. 9200474

STATEMENT OF ABANDONMENT OF USE OF FICTITIOUS BUSINESS NAME

Form RCC 233 (Rev. 12/91)

Claudia Viana  
Respondent's Ex. 33  
Gallego v Santana's  
4/4/08 - 1 pg  
V.R. Weiss, CSR

Case No. 92043152

SG00001

File No: 92 00475

IN THE SUPERIOR COURT OF THE STATE OF CALIFORNIA  
IN AND FOR THE COUNTY OF SAN DIEGO  
CERTIFICATE OF PUBLICATION

SANTANA'S MEXICAN FOOD  
Clavdia Vallarta-Santana  
1480 Rosecrans St.  
San Diego, CA 92106-

FEB 14 1992  
County Clerk (D)

Affidavit of Publication  
Heartland News Legal Transcript  
10010 Campo Rd. (P.O. Box 188)  
Spring Valley, CA 92077  
(619) 670-6194

I, Paul D. Clark hereby certify that The Heartland News is weekly newspaper of general circulation within the provision of the Government Code of the State of California, printed and published in The County of San Diego, State of California, on the

FICTITIOUS BUSINESS NAME STATEMENT

FICTITIOUS BUSINESS  
NAME STATEMENT  
File No. 92 00475

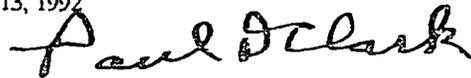
The name of the business: SANTANA'S MEXICAN FOOD, located at: 1480 Rosecrans St., San Diego, CA 92106-, is (are) hereby registered by the following owner(s): Abelardo Santana-Lee 5801 Riley St. San Diego CA 92110- Clavdia Vallarta-Santana 5810 Riley St. San Diego CA 92110- This business conducted by: Individuals-Husband and Wife. The registrant commenced the transaction of business on 1/1/92. s/s: Clavdia Vallarta-Santana ; This statement was filed with Annette J. Evans, County Clerk of San Diego County on Jan. 9, 1992. Jan. 23, 20, Feb. 6, 13, 1992.

to which this certificate is annexed is a true and correct copy published in said newspaper on

Jan. 23, 20, Feb. 6, 13, 1992

I certify under penalty of perjury that the foregoing is true and correct, at Spring Valley, California, on

Feb. 13, 1992



Signature

File No: 92 00475

Case No. 92043152

SG00003

SG00003

**TAB 9**



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

Business Tax Certificate No.  
86015722

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

**REPORTING CHANGE IN:**  
 (Please check all applicable)

ZUC NO. \_\_\_\_\_

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

Case No. 92043152

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:  
1430 ROSECRAVNS ST.  
 NUMBER STREET SUITE  
SAN DIEGO CA 92106 (615) 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: \_\_\_\_\_ DATE: 1-27-92

(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 \_\_\_\_\_

TR-1827 (Rev. 6-90)

Claudia Vallarta  
 Respondent's Ex. 34  
 Gallego v Santana's  
 4/4/08 - 1 pg  
 V.R. Weiss, CSR

SD # 86015722

**TAB 10**



... Es Muy Bueno

Benito Santana Lee  
Respondent's Ex. 28  
Gallego v Santana's  
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V.R. Weiss, CSR

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