

ESTTA Tracking number: **ESTTA202094**

Filing date: **04/01/2008**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Orange Bang, Inc.		
Entity	Corporation	Citizenship	CA
Address	13115 Telfair Avenue Sylmar, CA 91340 UNITED STATES		

Attorney information	Aaron T. Borrowman KELLY LOWRY & KELLEY, LLP 6320 Canoga Avenue Suite 1650 Woodland Hills, CA 91367 UNITED STATES aaron@KLKPatentLaw.com Phone:(818) 347-7900		
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Registration Subject to Cancellation

Registration No	2987937	Registration date	08/23/2005
Registrant	Ole Mexican Foods, Inc. 6585 Crescent Drive Norcross, GA 30071 UNITED STATES		

Goods/Services Subject to Cancellation

Class 029. First Use: 2002/11/15 First Use In Commerce: 2002/11/15 All goods and services in the class are cancelled, namely: Cheese, Mexican style food products, namely chorizo, cheese dips, canned peppers, dried peppers, chicharrones, and yogurt-based beverages
Class 030. First Use: 2003/09/00 First Use In Commerce: 2003/09/00 All goods and services in the class are cancelled, namely: Mexican style food products, namely, tortillas, tostadas, gorditas, sopes, tortillas chips, Mexican pastries, Mexican snack foods, namely, corn chips, salsas, mole, dried corn husks, frijoles, pasta, Mexican candies, tamales, and taquitos

Grounds for Cancellation

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

Related Proceedings	92048698
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3315078	Application Date	04/15/2004
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Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	OLÉ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1981/11/05 First Use In Commerce: 1981/11/05 RICE AND MILK-BASED BEVERAGES, NAMELY HORCHATA; AND NON-ALCOHOLIC AND NON-CARBONATED FRUIT JUICE BEVERAGES		

U.S. Application No.	78738452	Application Date	10/21/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OLÉ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1981/11/05 First Use In Commerce: 1981/11/05 NON-ALCOHOLIC FRUIT AND HERBAL JUICE, FRUIT-FLAVORED DRINKS, HERB- FLAVORED DRINKS AND CONCENTRATES THEREFOR; MILK-BASED AND RICE-BASED NON-ALCOHOLIC DRINKS, NAMELY, HORCHATA, AND CONCENTRATES THEREFOR		

Attachments	76586954#TMSN.gif (1 page)(bytes) 78738452#TMSN.jpeg (1 page)(bytes) 51031_Petition for Cancellation.pdf (9 pages)(48227 bytes) 51031_Attachment.pdf (6 pages)(204640 bytes)
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Certificate of Service

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

Signature	/Aaron T. Borrowman, Reg.No. 42,348/
Name	Aaron T. Borrowman
Date	04/01/2008

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

In the matter of:

Orange Bang, Inc.

Petitioner,

v.

Olé Mexican Foods, Inc.

Registrant.

Petition for Cancellation

Cancellation No. _____

Trademark Registration No. 2,987,937

For the mark: **VEROLÉ**

Date registered: August 23, 2005

Trademark Trial and Appeal Board
Commissioner for Trademarks
Via E-File

PETITION FOR CANCELLATION

ORANGE BANG, INC., a California corporation, having its principal place of business at 13115 Telfair Avenue, Sylmar, California 91340 (hereinafter Petitioner), believes that it will be damaged by U.S. Trademark Registration No. 2,987,937, believed to be owned by OLÉ MEXICAN FOODS, INC., a Georgia corporation, having an address of 6585 Crescent Drive, Norcross, Georgia 30071 (hereinafter Registrant), and hereby requests that the Registration be cancelled.

The grounds for cancellation are as follows:

Cause of Action for Cancellation

1. Petitioner has been using its OLÉ mark in interstate commerce since at least November 5, 1981 in association with beverages. More particularly, Petitioner has been using its OLÉ mark since 1981 in association with fruit juice, fruit flavored, herbal flavored, and horchata (rice and milk-based) beverages. Many of these beverages are “Mexican” or “Hispanic” in nature.
2. On April 15, 2004, Petitioner filed an application for OLÉ as a use application used in association with rice and milk-based beverages, namely horchata; and non-alcoholic and non-carbonated fruit juice beverages, claiming a first date of interstate commerce use as November 5, 1981. On October 23, 2007, this application matured into Registration No. 3,315,078.
3. On October 21, 2005 Petitioner filed an application for OLÉ for use in association with non-alcoholic fruit and herbal juice, fruit-flavored drinks, herb-flavored drinks and concentrates therefor; milk-based and rice-based non-alcoholic drinks, namely, horchata, and concentrates therefor, claiming a date of first use in interstate commerce of November 5, 1981.
4. Upon information and belief, taken from Registrant’s web-site, Registrant began its business in 1988, nearly seven (7) years after Petitioner first began using its OLÉ mark in interstate commerce in association with its beverage goods.
5. On October 21, 2005, Petitioner’s attorney sent Registrant’s attorney a letter, informing Registrant of Petitioner’s common-law rights with respect to the trademark OLÉ in association with non-alcoholic fruit and herbal juice, and flavored beverages and horchata since at least as early as 1981. Petitioner’s

attorney had recently become aware of several pending applications filed by Registrant which included the term “OLÉ”, and which were directed to fruit juice drinks and horchata. Petitioner requested that Registrant expressly withdraw or abandon the applications and any other applications incorporating the term OLÉ and which were directed to these type of beverage goods, and not to use the OLÉ mark in association with such goods in commerce due to Petitioner’s superior rights. Subsequently, Registrant requested proof of Orange Bang’s usage, which Orange Bang provided to Registrant. Over time, the pending intent-to-use applications of Registrant were abandoned by virtue of failure to file a Statement of Use.

6. In an Office Action dated July 6, 2007, in connection with Petitioner’s U.S. Trademark Application Serial No. 78/738,452, Registrant’s Registration Nos. 2,740,014 OLÉ DELI; 2,808,204 OLÉ DELI; 2,969,695 OLÉ MEXICAN FOODS; 3,161,729 OLÉ; and 3,223,608 OLÉ were cited by the Examining Attorney who refused to register Petitioner’s mark on the grounds of likelihood of confusion with Registrant’s prior Registrations. The Examining Attorney asserted that “the goods in connection with which the marks are used are related. The applicant’s non-alcoholic fruit and herbal juice, fruit-flavored drinks, herb-flavored drinks and concentrate therefor; milk-based and rice-based non-alcoholic drinks, namely, horchata, and concentrates therefor are particularly closely related to the cited registrant’s yogurt-based beverages that are also related to the registrant’s other food items: beverages and foods often travel in the same channels of trade.”
7. On October 22, 2007 Petitioner’s attorney sent Registrant’s attorney a letter, indicating the issuance of U.S. Registration No. 3,315,078 to Petitioner, and again reasserting its common law rights in the mark OLÉ for fruit juice, fruit flavored, herbal flavored, and horchata beverages and the like. As Registrant had not taken any action in amending its Registrations, including the present Registration being petitioned for cancellation, since Petitioner’s October 21, 2005

letter, Petitioner once again asked that Registrant amend the identification of goods to remove the references to yogurt-based beverages and herbal teas, and enter into a Consent Agreement whereby Registrant would agree not to use any OLÉ trademarks in association with beverages, and Petitioner would agree not to use its OLÉ mark in association with Mexican food items.

8. Between October 22, 2007 and the end of 2007, Petitioner's attorney and Registrant's attorney exchanged correspondence by mail and telephone relating to Petitioner's demands. On January 4, 2008, in order to suspend its U.S. Application Serial No. 78/738,452, Petitioner filed a Petition for Cancellation, later granted Cancellation No. 92048698. Approximately two weeks later, Petitioner sent a letter to Registrant's attorney setting forth settlement terms based upon the prior correspondence and believing that Registrant wanted to amicably settle the dispute and resolve any potential for confusion. Petitioner further granted an extension of 30 days to respond to the Petition for Cancellation so that there would be sufficient time to finalize settlement before an Answer to the Petition for Cancellation was due.
9. On March 7, 2008, Registrant filed a Section 7 Request, requesting that its listing of goods be amended, particularly to delete reference to the yogurt-based beverage and herbal tea goods.
10. On March 19, 2008, Registrant filed an Answer, Counterclaim and Motion to Amend in the Cancellation No. 92048698 proceeding.
11. On March 19, 2008, Registrant also filed a trademark application for OLÉ MEXICAN FOODS EST. 1988 (subsequently granted serial number 77/426,608, for dairy-based and fruit-based non-alcoholic beverages, claiming a date of first use in interstate commerce of December, 2007.

12. Upon information and belief, based in part on Registrant's Answer, Counterclaim, and Motion to Amend in Cancellation No. 92048698, Registrant began use of the "OLÉ" corporate name, trade name and trademark in commerce in 1988 in connection with tortillas and tortilla chips. Since that date, Registrant has expanded the use of its "OLÉ" mark to a wide variety of other food products, including but not limited to, chorizo, cheeses, tostadas, and other Mexican style food products. However, it wasn't until December of 2007 that Registrant began using its "OLÉ" mark in connection with yogurt-based beverages. (See paragraphs 13, 14 and 26 of Registrant's Answer in Cancellation No. 92048698, attached hereto).

13. Upon information and belief, Registrant has never used the mark of U.S. Registration No. 2,987,937 in association with herbal teas or yogurt-based beverages.

14. On February 21, 2003, Registrant applied for the trademark VEROLÉ indicating that it had adopted and was using the trademark for:
 - Mexican style food products, namely, chorizo, cheeses and cheese dips, canned peppers, dried peppers, chicharrones in International Class 29, Registrant indicated that the trademark was first used on the goods in Class 29 in November of 2002;
 - and had a bona fide intention to use the mark in commerce or in connection with tortillas, tostadas, gorditas, sopas, tortilla chips, Mexican pastries, Mexican snack foods, salsas, molé, dried corn husks, frijoles, pasta, Mexican candies, tamales, taquitos in International Class 30;
 - and had a bona fide-intention to use the mark in commerce on or in connection with non-alcoholic drinks, namely, juices

and fruit drinks, herbal teas, horchata, and yogurt-based beverages in International Class 32.

15. On November 1, 2003, in response to an Office Action, Registrant requested that the identification of goods in the application be amended as follows:
 - Class 29: Cheese, Mexican style food products, namely, chorizo, cheeses dips, canned peppers, dried peppers, chicharrones and yogurt-based beverages.
 - Class 30: Mexican style food products, namely, tortillas, tostadas, gorditas, sopes, tortilla chips, Mexican pastries, Mexican snack foods, namely, corn chips, salsas, molé, dried corn husks, frijoles, pasta, Mexican candies, tamales and taquitos.
 - Class 32: Non-alcoholic drinks, namely, juices and fruit drinks, herbal teas and non-dairy based fruit flavored horchata.

16. Subsequent to publication and a Notice of Allowance, on October 20, 2004, applicant filed a combined Statement of Use under 37 CFR §2.88, indicating that the trademark was first used in connection with the Class 29 goods as set forth in the original application (November 15, 2002), and that the trademark was first used in connection with the goods in Class 30 in September of 2003, and was as of that date in use in such commerce with all the goods in Class 30 listed in the Notice of Allowance. Registrant further requested division of the application such that the goods in International Class 32 would be the subject of a new application.

17. Registrant knew, or should have known, on February 21, 2003 when it filed its Section 1(a) use application, or on October 20, 2004 when it filed its combined Statement of Use, that it was not using this mark in interstate commerce in

association with all of the goods listed in the application, and more particularly, yogurt-based beverages.

18. As such, Petitioner asserts that Registrant has committed fraud on the United States Patent and Trademark Office, and that U.S. Registration No. 2,987,937 was void *ab initio*, or before registration, and should be cancelled. Petitioner believes that it would be damaged by the continued Registration of the VEROLÉ mark as currently registered, and the subject Registration should be cancelled because Registrant fraudulently provided an over broad and incorrect recitation of goods in filing its application.
19. Petitioner has been continuously using its OLÉ mark in association with the above-identified beverages for at least twenty-six (26) years, or approximately twenty-one (21) years longer than Registrant has been using its VEROLÉ mark in association with its goods.
20. Petitioner believes that it will be damaged by the continued registration of the VEROLÉ mark as currently registered, and hereby petitions to cancel the same due to the likelihood of confusion between Petitioner's OLÉ mark and Registrant's VEROLÉ mark, both used in association with food goods, and more particularly both allegedly used in association with beverage goods.

* * * *

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained and that U.S. Registration No. 2,987,937 be cancelled.

Please recognize as attorneys of record of Petitioner, ORANGE BANG, INC., in this proceeding: all attorneys associated with the law firm of KELLY LOWRY & KELLEY, LLP, all members of the Bar of the State of California, at the following address:

KELLY LOWRY & KELLEY, LLP
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367

Please address communications to Aaron T. Borrowman. Phone Number
(818) 347-7900.

A payment in the amount of \$600.00 covering the requisite fee, accompanies
this Petition for Cancellation.

Date: April 1, 2008

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

/Aaron T. Borrowman, Reg.No. 42,348/

Aaron T. Borrowman, Reg. No. 42,348

Attorneys for Petitioner

ORANGE BANG, INC.

ATB:nh
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the attached Petition for Cancellation to be served on this date via U.S. first-class mail, postage prepaid, upon Registrant, as follows:

Olé Mexican Foods, Inc.
6585 Crescent Drive
Norcross, GA 30071

Paul S. Owens, Esq.
Paul Owens & Associates
P.O. Box 15310
Atlanta, GA 30333-0310

Dated: April 1, 2008

/ Nancy Hoover /
Nancy Hoover
for KELLY LOWRY & KELLEY, LLP

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

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In the Matter of Trademark Registration
No.: 3,223,608

For the Mark: OLÉ

Date of Filing: April 3, 2007

Orange Bang, Inc.,

Petitioner,

vs.

Cancellation No.: 92048698

Olé Mexican Foods, Inc.,

Respondent.

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ANSWER, COUNTERCLAIM, AND MOTION TO AMEND BY OLÉ MEXICAN
FOODS, INC.

Registrant, Olé Mexican Foods, Inc. (“Olé ”), through its attorney, hereby answers the above-captioned Petition for Cancellation herein, as follows:

1. Olé admits the allegations of paragraph 1.
2. Olé admits the allegations of paragraph 2, except that it denies that its Registration No. 3,223,608 was the sole basis for refusing to register the OLÉ mark in Orange Bang’s Application No. 78/738,452.
3. Olé admits the allegations of paragraph 3.

4. Olé is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 4 of the Petition.

5. Olé is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 5 of the Petition.

6. Olé is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 6 of the Petition.

7. Olé denies each and every allegation of paragraph 7 upon information and belief, except that Olé admits that it has made a motion herein to amend the identification of goods for its Registration No. 3,223,608.

8. Olé denies each and every allegation of paragraph 8 upon information and belief, except that Olé admits that it has made a motion herein to amend the identification of goods for its Registration No. 3,223,608.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE

9. The Petition fails to state a claim upon which relief may be granted.

AS AND FOR A SECOND AFFIRMATIVE DEFENSE

10. The Petition should be denied on the ground of laches.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE

11. The Petition should be denied on the ground that Petitioner lacks standing to bring this cancellation.

AS AND FOR A COUNTERCLAIM FOR PARTIAL CANCELLATION AND/OR
RESTRICTION OF ORANGE BANG'S REGISTRATION NO. 3,315,078

12. Olé Mexican Foods, Inc. ("Olé") is a corporation organized under the laws of Georgia, and having a business address at 6585 Crescent Drive, Norcross, Georgia 30071.

13. Olé began use of the corporate name, trade name, and trademark OLÉ in commerce in 1988 in connection with tortillas and tortilla chips.

14. Since 1988, Olé has expanded use of its OLÉ mark to a wide variety of other food products, including but not limited to, chorizo, cheeses, tostadas, and other Mexican style food products sold through supermarkets and other retail food stores for later consumption off the premises.

15. Olé has also expanded its use of its OLÉ mark on the aforementioned Mexican food products for sale in bulk to institutions, such as hospitals and schools.

16. Orange Bang, Inc. (“Orange Bang”) is a California corporation having its principal place of business at 13115 Telfair Avenue, Sylmar, California 91340.

17. On July 7, 2007, the Examining Attorney cited Olé’s Registration No. 3,223,608, along with four other registrations owned by Olé for marks incorporating the mark OLÉ, against Orange Bang’s Application No. 78/738,452, on the ground of a likelihood of confusion.

18. On October 22, 2007, counsel for Orange Bang wrote to counsel for Olé alleging, inter alia, that due to Orange Bang’s first use of the mark OLÉ in 1981, “this places Orange Bang in a superior position with respect to ownership and rights of the OLÉ trademark, and creates the possibility of Petitions for Cancellation with respect to the cited registrations [owned by Olé for marks incorporating the OLÉ trademark], along with many of Olé Mexican Foods’ other trademark registrations which incorporate the term OLÉ.”

19. Orange Bang brought the within action to cancel Olé’s registration for its OLÉ trademark (Reg. No. 3,223,608) on January 4, 2008.

20. Orange Bang is the owner of the following registration:

Mark: OLÉ

Reg. No.: 3,315,078

Reg. Date: October 27, 2007

Goods: rice and milk-based beverages, namely horchata; and non-alcoholic and non-carbonated fruit juice beverages.

Date of First Use Anywhere and In Commerce: November 5, 1981.

21. Upon information and belief, Orange Bang uses its OLÉ mark only in connection with beverages distributed through beverage dispensers in convenience stores and fast-food restaurants by the glass or cup for immediate consumption on or off the premises, and on the packaging for concentrates for such beverages sold to such convenience stores and fast-food restaurants.

22. Upon information and belief, Orange Bang does not use its OLÉ mark on beverages distributed through supermarkets and other retail food stores for later consumption off the premises.

23. Upon information and belief, Orange Bang does not use its OLÉ mark on beverages distributed to institutions, such as hospitals and schools.

24. Olé believes it will be injured by Orange Bang's Registration No. 3,315,078 since it will give Orange Bang colorable right to use the OLÉ mark in connection with products sold through supermarkets and other retail food stores.

25. Olé proposes that the identification of goods in Orange Bang's Application No. 3,315,078 be amended as follows: "non-alcoholic fruit and herbal juice, fruit-flavored drinks, herb-flavored drinks and concentrates therefor; milk-based and rice-based non-alcoholic drinks, namely, horchata, and concentrates therefor, *all for consumption on or off the premises of convenience stores and fast-food restaurants.*" Entry of the foregoing restriction is necessary to avoid a likelihood of confusion between the parties' respective trademarks.

MOTION TO AMEND OLÉ'S REGISTRATION NO. 3,223,608

26. At the time of filing the use-based application (Appl'n No. 76/619,200) for the above-captioned OLÉ mark that matured into Reg. No. 3,223,608, Olé was using the OLÉ mark in connection with dairy-based beverages. In December, 2007, Olé began using its OLÉ mark in connection with yogurt-based beverages.

27. At the time of filing the use-based application (Appl'n No. 76/619,200) for the above-captioned OLÉ mark that matured into Reg. No. 3,223,608, Olé was using the OLÉ mark in connection with horchata and with tamarindos, jamaica, and other spices and herbs for use in beverages.

28. The above-captioned Registration No. 3,223,608 is for use of the OLÉ mark in connection with, inter alia, "yogurt-based beverages" in Class 29 and "herbal teas" in Class 30. To the extent that these identifications may be considered inaccurate by the Trademark Trial and Appeal Board, Olé requests that these identifications of goods be revised or amended.

29. The \$300.00 fee required by 37 C.F.R. § 2.6 is electronically submitted herewith.

WHEREFORE, Olé respectfully prays that the Trademark Trial and Appeal Board:

(a) Dismiss Orange Bang's Petition for Cancellation of Registration No. 3,223,608;

(b) Grant Olé's Counterclaim for restriction or partial cancellation of Orange Bang's Registration No. 3,315,078;

(c) Amend the identification of "yogurt-based beverages" and "herbal teas" in Olé's Registration No. 3,223,608 insofar as such identifications are inaccurate; and,

(d) Grant such other and further relief as to the Trademark Trial and Appeal Board seems just.

Dated: March 19, 2008

Respectfully submitted,

/paul s. owens/

Paul S. Owens, Esq.

Attorney for Registrant--Olé Mexican Foods, Inc.

Paul Owens & Associates

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E-mail: psowens@bellsouth.net

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Answer has been served upon Aaron T. Borrowman, Esq., attorney of record for the Petitioner, at Kelly Lowry & Kelley, LLP, 6320 Canoga Hills, California 91367, the address designated by said attorney for that purpose, by causing to be mailed a true copy thereof in a sealed envelope, postage prepaid, and deposited with the United States Postal Service as first-class mail on Wednesday, March 19, 2008.

/paul s. owens/

Paul S. Owens, Esq.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above Answer by Olé Mexican Foods, Inc. to Petition for Cancellation No. 92048698 is being electronically filed with the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals ("ESTTA") on Wednesday, March 19, 2008.

/paul s. owens/

Paul S. Owens, Esq.