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

Proceeding	92050998
Party	Plaintiff Oscar Urbina, Jr.
Correspondence Address	Yocel Alonso 130 Industrial Blvd. Suite 110, PO Box 45 Sugar Land, TX 77487-0045 UNITED STATES yocelaw@aol.com
Submission	Opposition/Response to Motion
Filer's Name	Richard B. Biagi
Filer's e-mail	yocelaw@aol.com, pto@nealmcdevitt.com
Signature	/Richard B. Biagi/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In the Matter of Registration No. 3,170,684  
For the Mark ALACRANES MUSICAL  
Registered on November 14, 2006*

OSCAR URBINA, JR.,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92050998
	)	
AGUILA RECORDS, INC,	)	
	)	
Respondent.	)	

**PETITIONER’S RESPONSE TO RESPONDENT’S MOTION TO DISMISS  
FOR FAILURE TO STATE A CLAIM**

Petitioner Oscar Urbina, Jr. (hereinafter “Urbina” or “Petitioner”), by and through his attorneys, hereby responds to Respondent Aguila Records, Inc.’s (“Respondent”) Motion to Dismiss for Failure to State a Claim (“Motion”). For the reasons that follow, Respondent’s Motion should be denied.

**INTRODUCTION**

Respondent’s Motion is premised solely on the erroneous allegation that Petitioner does not have standing to petition for cancellation of the ALACRANES MUSICAL mark. Respondent incorrectly asserts that Petitioner has not shown any “real interest” in the mark or a “reasonable basis for his belief of damage.” Despite these unsupported allegations by Respondent, Urbina undoubtedly has proper standing to bring this Petition for Cancellation. Also, none of the authorities cited by Respondent in its Motion support the dismissal of this Petition.

## ARGUMENT

To survive a motion to dismiss for failure to state a claim, “a pleading need only allege such facts as would, if proved, establish that plaintiff is entitled to the relief sought, that is, that (1) plaintiff has standing to maintain the proceeding, and (2) a valid ground exists . . . for canceling the subject registration.” Trademark Trial and Appeal Board Manual of Procedure § 503.02, citing Young v. AGB Corp., 152 F.3d 1377 (Fed. Cir. 1998). “For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff.” Id. Dismissal is only appropriate if it appears certain that plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim. Id.

Section 13 of the Lanham Act gives standing to petition to cancel to “any person who believes that he is or will be damaged.” 15 U.S.C. § 1064. All that a petitioner need show for standing is the likelihood of damage from the continuing registration of the mark. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20:46 (4th ed. 2009), citing Golden Gate Salami Co. v. Gulf States Paper Corp., 332 F.2d 184 (C.C.P.A. 1964); see also Master Builders, Inc. v. Polymerica, Inc., 2004 WL 407353, Cancellation No. 92030319 (T.T.A.B. 2004). “[T]he public interest is served . . . in broadly interpreting the class of persons Congress intended to be allowed to institute cancellation proceedings.” Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 1030 (C.C.P.A. 1982).

The Federal Circuit has emphasized that there are two judicially-created requirements for standing in *inter partes* cases before the Board: (1) the petitioner must have a “real interest” in the proceedings, and (2) the petitioner must have a “reasonable basis” for the belief of damage.

Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999); Lipton, 670 F.2d at 1029. In light of the facts alleged in the Petition for Cancellation, Urbina has a real interest in these proceedings, and he has an objectively reasonable belief that he will be damaged by Respondent's continued use and registration of the ALACRANES MUSICAL mark.

**A. URBINA HAS A REAL INTEREST IN THESE PROCEEDINGS.**

A real interest is essentially “a personal interest beyond that of the general public.” Harjo v. Pro Football, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. 1994) (petitioners, representing Native Americans, had standing to seek cancellation of REDSKINS for a football team on grounds of disparagement and scandalousness). The real interest requirement seeks to weed out mere intermeddlers who do not raise an actual and real controversy. Ritchie, 170 F.3d at 1095; Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316 (Fed. Cir. 1983). Accordingly, “[t]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding.” Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d 1382, 1385 (T.T.A.B. 1991). Urbina is no ordinary intermeddler with respect to the ALACRANES MUSICAL mark.

As stated in the Petition for Cancellation, Urbina is an original member of the musical group ALACRANES MUSICAL. See Petition for Cancellation, ¶ 1. Further, as an owner of the group, he has continually used the ALACRANES MUSICAL mark since 1995. Id. Through a contractual agreement, Respondent was allowed to use the ALACRANES MUSICAL mark in connection with the sale of musical recordings. Id. at ¶ 6. Respondent has now falsely claimed ownership and obtained registration of the trademark by breaching its fiduciary duties owed to Petitioner. Id. As a member and owner of the musical group ALACRANES MUSICAL, Urbina unquestionably has sufficient standing to bring this petition for cancellation.

In addition, Urbina has a real interest in the ALACRANES MUSICAL mark because it is well settled that actual ownership of a registered trademark is not necessary to have standing. See Giersch v. Scripps Networks, Inc., 90 U.S.P.Q.2d 1020 (T.T.A.B. 2009) (precedential) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.”). Moreover, there is no requirement that each co-owner of a mark be named as a petitioner. See, e.g., Danzig v. Cyclopiian Music, Inc., 2007 WL 387598, Cancellation No. 92045173 (T.T.A.B. 2007) (non-precedential) (petitioner had standing because he was a founding member and lead vocalist of the band the MISFITS and claimed to be a co-owner of the MISFITS mark).

**B. PETITIONER HAS A REASONABLE BASIS FOR HIS BELIEF THAT HE WILL BE DAMAGED BY THE CONTINUED USE AND REGISTRATION OF RESPONDENT’S MARK.**

As an owner of the ALACRANES MUSICAL mark, Petitioner has a reasonable basis for his belief that he would be damaged by Respondent’s continued use and registration of the mark. The Petition for Cancellation is full of pleadings of damage to Petitioner. Among others, Paragraph 11 of the Petition alleges that “Respondent’s alleged mark is confusingly similar to Petitioner’s ‘Alacranes Musical’ mark for said goods; and such use and registration would support and assist Respondent in the confusing, misleading, and deceptive use of Petitioner’s mark and would give to Respondent color of exclusive statutory rights to such designation in violation of Petitioner’s superior rights.” Petition, ¶ 11. This allegation is more than sufficient to show a reasonable basis for Petitioner’s belief that he will be damaged.

**C. RESPONDENT’S MOTION TO DISMISS INCLUDES EVIDENCE THAT MUST BE STRICKEN.**

In its Motion to Dismiss, Respondent attached as an exhibit a copy of a document allegedly purporting to show that Urbina has acted as a legal representative on behalf of the musical group “Alacranes Musical.” Such evidence was improper to include with a motion to dismiss and should be stricken or, at minimum, excluded from consideration. See, e.g., *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 U.S.P.Q.2d 1251 (T.T.A.B. 2009) (precedential) (“[I]f a motion to dismiss is filed that references matters outside the pleadings, the Board may exclude from consideration the matters outside the pleadings and may consider the motion for whatever merits it presents as a motion to dismiss.”); *Wellcome Foundation, Ltd. v. Merck & Co.*, 46 U.S.P.Q.2d 1478 (T.T.A.B. 1998) (excluding consideration of third-party registrations attached to motion to dismiss).

**CONCLUSION**

For the foregoing reasons, the Petitioner Oscar Urbina, Jr. respectfully requests that the Board deny Respondent’s Motion to Dismiss for Failure to State a Claim. In the alternative, if the Board remains unpersuaded by Petitioner’s arguments, Petitioner requests leave to amend its Petition for Cancellation.

Dated: July 13, 2009

Respectfully submitted,

/s/ Richard B. Biagi

Kevin J. McDevitt  
Richard B. Biagi  
Jeremy M. Roe  
NEAL & MCDEVITT, LLC

1776 Ash Street  
Northfield, IL 60093  
(847) 441.9100 (Telephone)  
(847) 441.0911 (Facsimile)

Yocel Alonso  
130 Industrial Blvd., Suite 110  
P.O. Box 45  
Sugar Land, Texas 77487  
(281) 240.1492 (Telephone)

*Counsel for Petitioner,  
Oscar Urbina, Jr.*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **PETITIONER'S RESPONSE TO RESPONDENT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM** was served on the following counsel of record by First Class Mail and email on July 13, 2009.

Elliott C. Bankendorf, Esq.  
Richard J. Gurak, Esq.  
Yolanda M. King, Esq.  
HUSCH BLACKWELL SANDERS LLP WELSH & KATZ  
120 S. Riverside Plaza, 22nd Floor  
Chicago, Illinois 60606  
[ecbdocket@welshkatz.com](mailto:ecbdocket@welshkatz.com)

/s/ Jeremy M. Roe\_\_\_\_\_

*Counsel for Petitioner,  
Oscar Urbina, Jr.*