ESTTA Tracking number: **ESTTA299678**
Filing date: **08/07/2009**

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

Proceeding	92051265
Party	Plaintiff Manzanilla La Pastora, S.A. de C.V.
Correspondence Address	David A. Bell Haynes and Boone, LLP 2323 Victory Ave, Suite 700 Dallas, TX 75219-7673 UNITED STATES ipdocketing@haynesboone.com, david.bell@haynesboone.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Melissa LaBauve
Filer's e-mail	ipdocketing@haynesboone.com
Signature	/melissalabauve/
Date	08/07/2009
Attachments	LA PASTORA First Amended Petition for Cancellation final.pdf (24 pages)(732549 bytes)

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

	§	
Manzanilla La Pastora, S.A. de C.V.	§	Mark: LA PASTORA
	§	
Petitioner	§	- Reg. No. 3623666
	§	- Registered 5-19-2009
v.	§	
Ricardo A. Lopez	§	Cancellation No. 92051265
Hector Lezama-Lopez	§	
Maria Montserrat Verdugo-Sanchez	§	
	§	
Respondents	§	

FIRST AMENDED PETITION FOR CANCELLATION

Pursuant to Fed. R. Civ. Proc. (15)(a) and TBMP § 507.02, Petitioner hereby submits this First Amended Petition for Cancellation outlining further factual allegations relating the Respondents lack of use of the mark, LA PASTORA. No responsive pleading has been served, and therefore, Petitioner may amend its Petition for Cancellation as a matter of course. In further pleading, Petitioner alleges as follows:

In the matter of Registration No. 3623666 for the trademark LA PASTORA (the "Subject Registration") owned by Ricardo A. Lopez, Hector Lezama-Lopez, and Maria Montserrat Verdugo-Sanchez, all having a listed address of 10265 Rockwood Dr., San Diego, CA 92123, the Petitioner, Manzanilla La Pastora, S.A. de C.V, believes that it is or will be damaged by the Subject Registration and hereby petitions to cancel same.

As grounds therefore, it is alleged that:

1. For approximately seventy years, Petitioner has promoted and sold a wide variety of tea products under its trade name and trademark, LA PASTORA. The brand has become one

of the most popular and widely-sold brands of tea in Mexico. Petitioner owns multiple Mexican trademark registrations containing LA PASTORA for goods, including teas, namely, Mexican trademark registration nos.: 484607, 807088, 1048770, 1048769, 1048768, 1038676, 1038677, 1038678, 807086, 807087, 687168, 649395, 834993, and the significant goodwill associated therewith. Petitioner also owns other Mexican trademark registrations covering various foodstuffs and preparations for foodstuffs, including nos.: 807559, 484608, 811006, 810608, 809683, 837697, 818107, 714299, 712392, 712393, 710333, 809684 and the significant goodwill associated therewith.

2. Petitioner has a pending U.S. application for the mark, LA PASTORA, bearing U.S. Serial No.: 77565470. The Subject Registration is blocking Petitioner's application.

3. Petitioner has established common law trademark rights in its LA PASTORA mark not only in Mexico but also in the U.S. by selling and distributing teas under the LA PASTORA trademark.

4. By virtue of its fame and significant goodwill in Mexico, Petitioner's LA PASTORA trademark is famous and/or well known in the U.S.

5. Respondents filed an intent to use trademark application to register the mark, LA PASTORA with the United States Patent and Trademark Office on July 18, 2007 claiming a bona fide intent to use the mark in connection with, *"Beverages made of tea; Black tea; Flavourings of tea; Fruit teas; Green tea; Herb tea; Herbal tea; Iced tea; Japanese green tea; Lime tea; Mixes in the nature of concentrates, syrups or powders used in the preparation of tea based beverages; Oolong tea; Sage tea; Tea; Tea bags; Tea for infusions; Tea of parched powder of barley with husk (mugi-cha); Tea of salty kelp powder (kombu-cha); Tea pods; Tea substitutes; Tea-based beverages with fruit flavoring; Theine-free tea sweetened with*

sweeteners."

6. Counsel for Petitioner contacted Respondents on or about April 25, 2008 in an effort to amicably resolve this matter. See, Exhibit A. Subsequently, on July 16, 2008, counsel for Respondents, Ms. Kathleen Pasulka-Bown, represented the following to counsel for Petitioner "[a]s I previously informed you my client is not yet using this trademark. In addition no steps are presently being taken to use the mark." See, Exhibit B. But on March 25, 2009, Respondents filed a Statement of Use pursuant to 15 U.S.C. § 1051(d) claiming a date of first use of August 7, 2008, a date of first use approximately three weeks after counsel for Respondents represented that the mark was not in use and that the Respondents were taking "no steps" to use the mark. Respondents' Statement of Use was verified with a declaration pursuant to 37 C.F.R. § 2.20.

7. Respondents' Statement of Use appended a specimen of a logo. See, Exhibit C. The Respondents claimed that the logo was a "label used on [its] products...[and the] website <lapastora.us.com> has pictures of our products and the presentations that we market." Exhibit B. The specimens attached do not appear to be photographs of a label as applied to a product, but rather, appear to be jpeg images of CAD drawings or printer's proofs, which are not acceptable specimens per TMEP § 904.04(a). See, Exhibit D.

8. While Respondents' rudimentary Web site does appear to contain an image of a sample product, the consumer is unable to purchase any products from this Web site. Moreover, despite requests to Respondents' counsel, Respondents have failed to provide any evidence of use of the mark on products, other than the image of the mark on its Web site, and have also failed to supply any evidence of any sales figures to substantiate use of the mark. Moreover, Petitioner's own investigation has not uncovered any use in commerce of the trademark, LA

PASTORA, on any of the products listed in Respondents' application.

9. Indeed, during May and June of 2009, Petitioner and Respondents communicated directly in order to determine whether the parties could reach an amicable resolution of this matter. Respondents made a demand of $330,000.00 USD in return for the voluntary abandonment of U.S. Registration No. 3623666. Respondents represented that this amount was based on the minimum revenue expected within the next ten years and the commercial development of the concept. See, Exhibit E (with English translations inserted). Petitioner requested additional information regarding sales figures that would support such a speculative amount, but to date, this request has gone unanswered. See, Exhibit F (with English translations inserted).

10. Further investigation into the status of the entity, La Pastora, USA, allegedly located in San Diego, California and listed on the Web site at <lapastora.us.com> as the source of Respondents' products bearing the mark, LA PASTORA, revealed no records of existence with the California Secretary of State. La Pastora, USA is not listed in any business directories in the San Diego, California area, and there is no record of any relevant business at the address listed in the subject registration.

11. Petitioner will be damaged if Respondents are permitted to have the Subject Registration remain on record and hereby requests cancellation of U.S. Registration No. 3623666.

12. Upon information and belief, Respondents fraudulently procured the Subject Registration, as they are not currently using the mark in connection with all of the listed goods. Moreover, on August 7, 2008, Respondents were not using the mark in connection with all of the listed goods, as represented in the Respondents' Statement of Use.

13. Upon information and belief obtained from further investigation, as of the filing date of this First Amended Petition for Cancellation, one year after Respondents' represented in a sworn declaration that they were using the mark in connection with a myriad of tea and tea related products, Respondents' products are not yet available for purchase. Further, as of the filing date of this First Amended Petition for Cancellation, Respondents are unable to provide sample products.

14. Upon information and belief, and by Respondents' counsel's own admission, prior to Respondents filing their Statement of Use, Respondents lacked the requisite bona fide intention to use the mark in commerce, as counsel for Respondent stated during the pendancy of the application, that no steps were being taken to use the mark.

15. Respondents also fraudulently filed the application for the Subject Registration, since Respondents' verified application for the Subject Registration states that to the best of the Respondents' knowledge and belief no other person had a right to use the mark in commerce. At all times hereto, Respondents were aware of and knowledgeable of Petitioner's business and significant good will associated with the mark, LA PASTORA.

16. In the event that Respondents commence use of the mark, there is a likelihood of confusion between Respondents' mark and Petitioner's identical mark, LA PASTORA, as a result of Petitioner's use of the mark in the U.S. as well as the substantial good will that Petitioner has built up in the mark as a result of the fame of the mark in Mexico.

17. In the event that Respondents commence use of the mark, LA PASTORA, such use will dilute Petitioner's valuable trademark.

WHEREFORE, Petitioner requests that the Board cancel United States Trademark Registration No. 3623666 and requests such other and further relief as is deemed just and proper.

This Petition for Cancellation is being filed electronically, so no duplicate copy is in order. The fee required by § 2.6(a)(16), if any, will be paid simultaneously with filing.

Respectfully submitted,

Melissa S. LaBauve
David Bell
HAYNES AND BOONE, LLP
Attorneys for Applicant

Date: August 7, 2009

By: _____

HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, TX 75219-7673
Telephone: (214) 651-5248
Facsimile: (214) 200-0853
ipdocketing@haynesboone.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this day of August 7, 2009, the foregoing *Petition for Cancellation* was served on the following correspondent of record for the Registrants, with a courtesy copy to Registrants' counsel, in the manner indicated below:

Ricardo A Lopez .....via first class mail, postage prepaid
10265 Rookwood Dr
San Diego, CA 92123

Kathleen Pasulka-Bown .....via first class mail, postage prepaid
Procopio, Cory, Hargreaves & Savitch LLP
530 B Street, Suite 2100
San Diego, CA 92101

Melissa LaBauve, Attorney for Applicant

EXHIBIT A

Conley, Justina

From: Conley, Justina
Sent: Friday, April 25, 2008 3:28 PM
To: 'montserrat_2000@hotmail.com'; 'helezama@hotmail.com'; 'ralsd@yahoo.com'
Subject: Infringement of LA PASTORA Trademark
Attachments: Infringement of La Pastora.pdf; Nature Bkgrd.jpg

Dear Sir or Madam,

Please see attached sent on behalf of David Bell of Haynes and Boone.

Thank you.

Best regards,
Justina Conley
IP Projects Specialist and
Legal Secretary to David Bell and Manjula Variyam
Haynes and Boone, LLP
Telephone: 214.651.5287
Fax: 214.200.0942
justina.conley@haynesboone.com
Before printing this email, think about the environment.

haynesboone

April 25, 2008

URGENT: Please respond by May 9, 2008

Via Certified Mail/Return Receipt Requested;
Via U.S. First Class Mail; and
Via E-Mail at montserrat_2000@hotmail.com, helezama@hotmail.com, and ralsd@yahoo.com

Ms. Maria Montserrat Verdugo-Sanchez
Mr. Hector Lezama-Lopez
Mr. Ricardo A Lopez
10265 Rookwood Dr.
San Diego, California 92123

Re: Infringement of LA PASTORA Trademark

Dear Madam and Sirs:

Our firm represents Manzanilla La Pastora, S.A. de C.V. ("La Pastora") in connection with the protection and enforcement of its intellectual property. We are writing to you regarding your recent United States trademark application for the mark LA PASTORA, which clearly infringes upon our client's rights. We must demand that you withdraw this application and agree to cease all use of our client's trademarks.

As you certainly know, for approximately seventy years, our client has been promoting and selling a wide variety of tea products under its trade name and trademark LA PASTORA. The brand has become one of the most popular and widely-sold brands of tea in Mexico. In fact, Superbrands, Ltd, one of the leading institutions on analyzing international brands, recently recognized LA PASTORA in its internationally distributed publication entitled Mexico's Leading Brands. As further evidence of our client's rights, our client owns multiple Mexican trademark registrations for its LA PASTORA mark.

Our client has also developed significant, enforceable trademark rights in this mark not only in Mexico, but also in the U.S. The company has also been selling and distributing teas under the LA PASTORA trademark throughout the U.S. for nearly a decade, reaching American consumers both through stores and on airline flights, for instance. Such use predates the July 18, 2007 filing date of your U.S. trademark application for this mark. For additional information on our client and its products, you may visit the company's website at *www.lapastora.com.mx*.

It has recently come to our attention that you have filed at least U.S. Trademark Application Serial No. 77/232,603 for the mark LA PASTORA. Your proposed or current use of the mark LA PASTORA in connection with directly competitive products – namely, a wide range of tea products – is likely to cause confusion among customers by falsely suggesting that you or your products are approved, endorsed, or licensed by or otherwise associated with our client. Such likelihood of confusion constitutes trademark infringement, trade name infringement, unfair competition, and other actionable wrongs.

Your activity may entitle our client to obtain an injunction against any of your use of our client's LA PASTORA mark, the destruction of any materials bearing the mark, and money damages against you. La Pastora considers your bad faith attempts to trade off of its goodwill to constitute a serious violation of its rights and to be very damaging to its business and reputation. We have been instructed to take all steps necessary to stop this activity.

Certified Article Number
7160 3901 9845 3050 7882
SENDERS RECORD

Haynes and Boone, LLP
Attorneys and Counselors
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Phone: 214.651.5000
Fax: 214.651.5940
www.haynesboone.com

In an effort to resolve this matter agreeably, we demand that you and each and every person or company affiliated with you:

(1) **Immediately** take all steps to expressly abandon U.S. Trademark Application Serial No. 77/232,603 and all other trademark applications that you have filed for the LA PASTORA mark, and forward to my attention both the abandonment requests when filed and notices of abandonment once received from the Trademark Offices;

(2) **Immediately and permanently** cease any and all use of the LA PASTORA mark in connection with your products, advertisements, catalogs, promotional brochures, websites, domain names, and other materials that display, use, or incorporate the mark or any similar variation thereof;

(3) Advise us in writing by **May 9, 2008**, of your compliance with the foregoing demands and your intent to comply with the following demands by executing and returning Page 3 of this letter; and

(4) In order for us to calculate the magnitude of our client's money damages to date as a result of your trademark infringement, furnish us with the following information and materials by **May 9, 2008**:

(a) The countries in which you have commenced use of the LA PASTORA mark, and the date of first use in each;

(b) Copies of all of your form letters, catalogs, promotional brochures, website content, advertisements and other material that display the mark LA PASTORA;

(c) Information regarding any complaints you have received from any customers or any other parties regarding the products offered by you under the mark LA PASTORA;

(d) Information regarding any instances of confusion, including but not limited to misdirected emails and phone calls, of which you are aware relating to the use of the LA PASTORA mark by both our client and you; and

(e) Your gross revenues from the sale of any products marketed under the mark LA PASTORA.

Please do not destroy any copies of any materials or correspondence related to these issues, as such would constitute spoliation of evidence. Any materials on hard drives of computers, such as e-mails and accounting information, should also be preserved since this evidence will be relevant if we cannot resolve these issues amicably.

Our client will consider waiving its rights to collect money damages if you agree to the above demands. If you fail to comply by the listed date, however, we will proceed accordingly without further notice to you. This may include, among other steps, filing a cancellation action against any trademark registration to issue from your pending application(s).

If you have any remaining doubts about our client's ability to enforce its rights in this matter, we urge you to immediately seek experienced trademark counsel.

Should you wish to discuss this matter, please contact the undersigned.

Sincerely,

David A. Bell
Direct Phone Number: (214) 651-5248
Direct Fax Number: (214) 200-0853
david.bell@haynesboone.com

cc: Manzanilla La Pastora, S.A. de C.V.

D-1640504_1.DOC

Maria Montserrat Verdugo-Sanchez, Hector Lezama-Lopez, Ricardo A Lopez, and each and every person or company affiliated with them, accept and agree to take all actions outlined in paragraphs numbered (1) and (2) in this letter.

MARIA MONTSERRAT VERDUGO-SANCHEZ

Signed:_____

Date:_____

HECTOR LEZAMA-LOPEZ

Signed:_____

Date:_____

RICARDO A LOPEZ

Signed:_____

Date:_____

2. Article Number

7160 3901 9845 3050 7882

3. Service Type CERTIFIED MAIL

4. Restricted Delivery? (Extra Fee) X ☐ Yes

1. Article Addressed to:

Maria Montserrat Verdugo-Sanchez
Hector Lezama-Lopez Ricardo A Lopez
10265 Rookwood Drive
San Diego, CA 92123
US

COMPLETE THIS SECTION ON DELIVERY

A. Received by (Please Print Clearly) Alec López

B. Date of Delivery 05-13-08

C. Signature

X

☐ Agent
☐ Addressee

D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☐ No

RECEIVED

MAY 06 2008

HAYNES AND BOONE, LLP

CERT00054418

PS Form 3811, January 2005 Domestic Return Receipt

EXHIBIT B

From: Pasulka-Brown, Kathleen A. [mailto:kap@procopio.com]
Sent: Wednesday, July 16, 2008 2:41 PM
To: Bell, David
Cc: Castilla, Marco
Subject: RE: La Pastora trademark- Manzanilla La Pastora SA de CV

Dear David,

As I previously informed you my client is not yet using the trademark. In addition no steps are presently being taken to use the mark so there is no real urgency at this time.

As you know use in Mexico is largely irrelevant here in the US. Your client let their US registration lapse and my client has not seen evidence of current use of the mark in the United States. Therefore it is important for me to have a bit more information about your client's actual sale of the product in the United States, with dates, in stores, so that I can confidently advise my client how to address your demand.

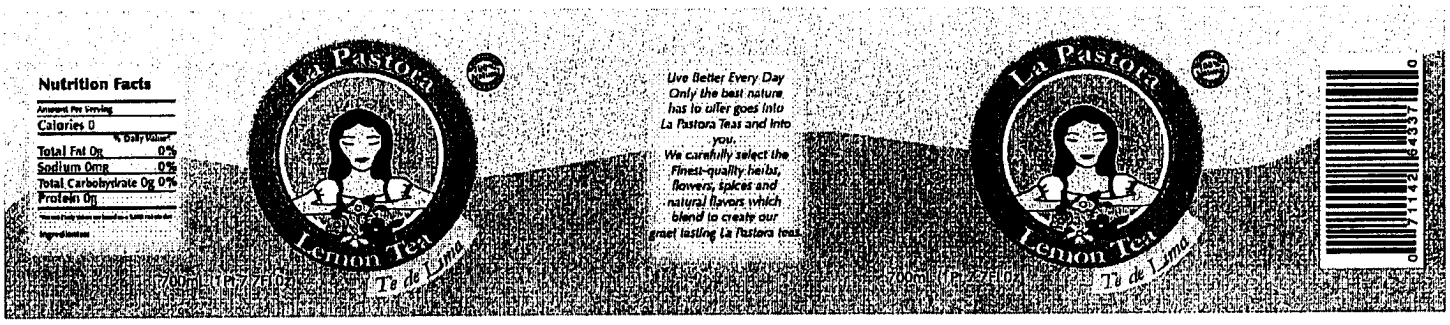
As you know my client effectively acquired constructive use rights when their application was filed. It would have appeared to my client as well as others that the combination of letting the US registration go along with the product not appearing to be sold in the US, that your client had abandoned its trademarks rights both in actually and legally.

EXHIBIT C


La Pastora
Lemon Tea
Te de Lima


La Pastora
Hibiscus Tea
Te de Jamaica

EXHIBIT D


Nutrition Facts
Amount Per Serving
Calories 0
% Daily Value*
Total Fat 0g 0%
Sodium 0mg 0%
Total Carbohydrate 0g 0%
Protein 0g
Ingredients
La Pastora
Lemon Tea
Té de Limón
700ml (1Pt 7Fl Oz)
Live Better Every Day
Only the best nature has to offer goes into La Pastora Teas and into you.
We carefully select the Finest-quality herbs, flowers, spices and natural flavors which blend to create our great tasting La Pastora teas.
La Pastora
Lemon Tea
Té de Limón
700ml (1Pt 7Fl Oz)
0 71142 64337 0

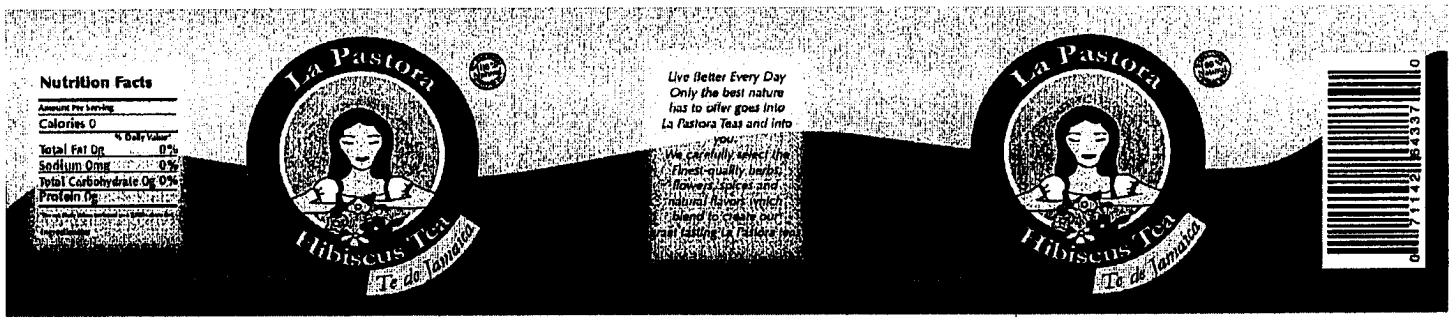

Nutrition Facts
Amount Per Serving
Calories 0
% Daily Value*
Total Fat 0g 0%
Sodium 0mg 0%
Total Carbohydrate 0g 0%
Protein 0g
La Pastora
Hibiscus Tea
Té de Jamaica
Live Better Every Day
Only the best nature
has to offer goes into
La Pastora Teas and into
you.
We carefully select the
finest-quality herbs,
flowers, spices and
natural flavors which
blend to create our
mouthwatering La Pastora
La Pastora
Hibiscus Tea
Té de Jamaica

EXHIBIT E

De: ralsd@yahoo.com [mailto:ralsd@yahoo.com]
Enviado el: Martes, 16 de Junio de 2009 10:19 a.m.
Para: 'LIC. CARLOS BARRA G.'
CC: 'Hector L'
Asunto: RE: Información
Importancia: Alta

Hola Carlos,
Hello Carlos
Perdón por la tardanza en darte una respuesta, la verdad que ha sido una decisión difícil ya que nuestra intención desde un principio es la comercialización de productos en EU y no en vender la marca.
Sorry for the delay in responding to you, but it has been a truly difficult decision since our foremost intention is to commercialize our products in the USA, and not to sell the trademark (brand).

Después de platicas con Héctor y nuestros abogados, pensamos que el valor actual de la marca, el desarrollo y la pagina de Internet es de $330,000 USD.
After talking to Hector and our attorneys, we believe that the current value of the trademark (brand), the development, and the internet webpage, is $330,000.00 USD.

Este rublo comprende no solo el trabajo que hemos hecho en el desarrollo comercial del concepto sino también el mínimo retorno esperado por los siguientes 10 años.
This cost comprises not only the work that we have done in terms of commercial development of the concept, but also the minimum return (revenue) expected within the next 10 years.

Nos daria mucho gusto sentarnos contigo para platicar de lo que esto implica o cuales fueran los siguientes pasos a seguir. Estas bienvenido cuando gustes a San Diego.
We would be very glad to sit down with you and talk about the implications and future steps to follow from here. You're welcome to come to San Diego any time you like.

Saludos y quedamos en espera de tus comentarios,
Regards, and looking forward to hearing your comments,

Ricardo A. Lopez

EXHIBIT F

De: LIC. CARLOS BARRA G. [mailto:cbarra@youngestcorp.com]
Enviado el: Viernes, 19 de Junio de 2009 03:54 p.m.
Para: 'ralsd@yahoo.com'
Asunto: RE: Información

Hola Ricardo
Hi, Ricardo:

Me da gusto saludarte; en base al mail recibido el día 16 de junio, las oficinas de la pastora me están pidiendo si nos pudieras desglosar como calcularon los $ 330,000 USD.
Glad to talk to you again; based on the e-mail received on June 16th, the offices of "La Pastora" are asking me if you could itemize the total cost of $ 330,000.00 that you calculated.

En particular cuanto han sido tus gastos al a fecha, cuando piensas sacar el producto al mercado y a qué precio, cual sería tu proyectado de ventas anual , que tipo de distribución utilizarías y en que Estados los comercializarías.
Particularly, they would like to know: your personal bills up to date, when do you expect to have the product in the market and at what price (of the product), what would be your annual sales projection, what type of distribution venues would you use, and in which States do you plan to commercialize the product.

Con estos elementos me ayudarías mucho para poder obtener una respuesta de la pastora.
With these elements, you would help me a lot in order to obtain an answer from "La Pastora".

Espero tu respuesta en la brevedad esperando llegar a un buen arreglo
I'm looking forward to receiving your prompt response, hoping to reach an agreement.

Saludos
Regards,

Carlos Barra