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

Proceeding	92054050
Party	Plaintiff Univision Communications Inc.
Correspondence Address	JORGE ARCINEGA MCDERMOTT WILL & EMERY LLP 2049 CENTURY PARK EAST, SUITE 3800 LOS ANGELES, CA 90077 UNITED STATES jarciniega@mwe.com, ehourizadeh@mwe.com
Submission	Other Motions/Papers
Filer's Name	Ellie Hourizadeh
Filer's e-mail	ehourizadeh@mwe.com, jarciniega@mwe.com
Signature	/s/
Date	03/26/2012
Attachments	First petition to cancel.PDF (6 pages)(80984 bytes)

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

UNIVISION COMMUNICATIONS INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92054050
)	
UNIMUNDO CORP.,)	
)	
Registrant.)	

RE: Registration No. 3889485
MARK: UNIMUNDO
Filed: March 31, 2010
Registration Date: December 14, 2010

FIRST AMENDED PETITION TO CANCEL

Pursuant to the Board’s Order of March 16, 2012, Univision Communications Inc., a Delaware corporation with a place of business at 5999 Center Drive, Los Angeles, California 90045 (“Petitioner”), by and through its attorneys, hereby files a First Amended Petition to Cancel Registration No. 3889485 for the word mark UNIMUNDO (“Mark”) on the grounds that (i) the application for the Mark contains knowingly false material representations of fact by the Registrant, (ii) the Mark is likely to cause consumer confusion with respect to Petitioner’s family of marks and (iii) the Mark dilutes Petitioner’s family of famous marks by blurring and tarnishment.

A. Petitioner Has Standing

1. Petitioner is the leading Spanish-language media company in the United States with a diverse business portfolio that includes television, radio, film, internet, mobile media,

wireless and merchandising. Petitioner has been delivering news and entertainment to Spanish-speaking audiences throughout the United States since at least as early as the late 1970s.

2. Petitioner, directly and through its controlled subsidiaries, owns a family of UNIVISION and “U” marks including Reg. Nos. 1624073, 1672807, 1610165, 2518239, 2518240, 2528166, 2518241, 3568848, 3483636, 3570072, 3736267, 3703908, 3780080, 3714485, 3714486, and 3830142 (collectively “Petitioner’s Registered Marks”).

3. Petitioner’s Registered Marks are famous and widely recognized by Spanish and English-speaking audiences throughout the globe. The public identifies the Petitioner as the source of, or as being in some way associated with, goods and services that bear the Petitioner’s Registered Marks.

B. Registrant Fraudulently Obtained Registration for the Mark

4. On or about March 31, 2010, Unimundo Corp. (“Registrant”) filed an application with the United States Patent and Trademark Office for registration of the word mark UNIMUNDO for “television and internet broadcasting” in International Class 38, based on alleged use in interstate commerce as of March 28, 2010. This application was assigned Serial Number 85003668. The application included a declaration signed by Marcus Fontain, President and CEO of Unimundo Corp., which states under penalty of perjury that Registrant had been using the Mark in commerce as of the filing date of the application.

5. On July 29, 2010, in response to an Office Action, Marcus Fontain filed another declaration reiterating that the Mark had been used as of March 28, 2010 in connection with an “internet broadcasting television network.”

6. On December 14, 2011, the Mark was registered with the USPTO, as Registration No. 3,889,485.

7. Prior to commencing this cancellation proceeding, Petitioner investigated Respondent's alleged use of the Mark using internet search engines and internet archives. Petitioner also carefully reviewed Respondent's website and publication material. Petitioner's investigation revealed that Respondent was not using the Mark on all of the goods and services listed in the application or in declaration filed by Mr. Fontain.

8. Based on Petitioner's investigation, the Mark was not used in connection with "television broadcasting" or an "internet broadcasting television network" as of March 28, 2010 as alleged in the application and the declarations filed by Registrant in support of the application for the Mark.

9. Upon information and belief, and upon the results of Petitioner's investigation, the verified statements signed by Marcus Fontain, President and CEO of Unimundo Corp., and submitted with and in connection to the application for the Mark contain knowingly false material misrepresentations of fact and such statements were made with the intent to deceive the United States Patent and Trademark Office ("USPTO") and therefore constitute fraud in the procurement of a registration. Specifically, Respondent knew that the Mark was not in use in connection with all of the goods and services identified in the application at the time the application was filed and the verified statements were submitted, and Respondent made such false, material misrepresentations of fact with the intent to deceive the USPTO.

10. But for these material and willful misrepresentations, the Mark would not have been registered for all the goods and services listed in the registration certificate.

11. Based on the acts described herein, Respondent committed fraud in its efforts to procure registration of the Mark.

C. The Mark is Likely to Cause Consumer Confusion with Petitioner’s Registered and Senior Marks

12. Upon information and belief, the registration of the Mark is a blatant attempt to capitalize on the goodwill and tremendous name recognition of the Petitioner. In a baldly crude fashion, Registrant has attempted to get a free ride by combining Petitioner’s Registered Marks with the name of the second largest Spanish language television broadcaster in the US – Telemundo. Consumers who see the “Frankenstein” mark that Registrant has created are likely to think either that the Mark is affiliated with Petitioner or that the Mark and its related services are a joint venture between Petitioner and Telemundo.

13. Registration and use of the Mark has and will continue to cause damage and harm to the Petitioner.

D. The Mark is Likely to Dilute Petitioner’s Famous Marks by Blurring and Tarnishment

14. Registration and use of the Mark is a misappropriation of Petitioner’s unique, valuable and exclusive rights to the Petitioner’s Registered Marks. Registration of the Mark on the principal register has and will likely continue to cause damage and harm to the Petitioner as a result of, amongst other things, dilution by blurring and tarnishment.

15. Petitioner’s Registered Marks became famous long before Registrant filed its application for the Mark.

16. Registrant’s use of the Mark in connection with marketing, distribution, and promotion of Registrant’s website and services, which do not include the services cited in the application, is likely to cause dilution by blurring by impairing the distinctiveness of Petitioner’s Registered marks.

17. Registrant's use of the Mark in connection with marketing, distribution, and promotion of Registrant's website and services, which do not include the services cited in the application, is likely to cause dilution by tarnishment by harming the reputation and goodwill associated with Petitioner's Registered Marks.

WHEREFORE, Petitioner prays that said Registration No. 3889485 be cancelled and this petition be sustained in favor of Petitioner, with costs and legal fees awarded, if appropriate, pursuant to the Federal Rules of Civil Procedure and the Rules of the PTO and the TTAB.

The requisite filing fee prescribed by 37 C.F.R. § 2.6(a)(17), should be charged to Deposit Account No. 501946. If there are any additional fees due in connection with this Petition to Cancel, they should also be charged to Deposit Account No. 501946, and any excess fees should be credited to same.

All correspondence relating to this matter should be directed to the undersigned attorneys for Petitioner.

Respectfully submitted,

UNIVISION COMMUNICATIONS INC.

Dated: March 26, 2012

By: _____/s/_____
Ellie Hourizadeh
Attorneys for Petitioner

MCDERMOTT WILL & EMERY LLP
2049 Century Park East, 38th Floor
Los Angeles, CA 90067-3208
Telephone: (310) 551-9321
Facsimile: (310) 277-4730

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing FIRST AMENDED PETITION TO CANCEL upon Registrant by depositing one copy thereof via First Class Mail, in the United States mail, postage prepaid, on **March 26, 2012** addressed as follows:

**UNIMUNDO CORP.
14859 Moorpark St., Unit 103
Sherman Oaks, CA 91403-2591**

By: _____/s/_____
Ellie Hourizadeh
McDermott Will & Emery LLP
2049 Century Park East, Suite 3800
Los Angeles, CA 90067
Tel: (310) 551-9321
Fax: (310) 277-4730
Email: ehourizadeh@mwe.com

Attorneys for Petitioner
Univision Communications Inc.