Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA470326**

Filing date: **05/02/2012**

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 90067-3208 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	05/02/2012
Attachments	Opposition to Motion to Dismiss.pdf (6 pages)(98177 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

OPPOSITION TO UNIMUNDO'S MOTION TO DISMISS UNIVISION'S FIRST AMENDED PETITION TO CANCEL[1]

I. INTRODUCTION

Unimundo Corp.'s motion to dismiss Univision Communication Inc.'s First Amended Petition to Cancel and Unimundo's untimely and procedural defective Supplemental Memorandum of Law In Support of Motion to Dismiss Petitioner's First Amended Petition; Alternatively Motion for An Order To Strike Any Reference to Telemundo (collectively "Motion to Dismiss the Amended Petition") are wholly without merit. The parties have already submitted arguments related to standing and Univision's likelihood of confusion and dilution claims. On March 16, 2012, the Board issued an order ("Order") denying Unimundo's initial motion to dismiss. In that Order, the Board confirmed that Univision has standing to assert its

[1] This Opposition is also directed to the issues raised in Unimundo's untimely and procedural defective Supplemental Memorandum of Law In Support of Motion to Dismiss Petitioner's First Amended Petition; Alternatively Motion for An Order To Strike Any Reference to Telemundo, which fails to state any supplemental arguments, facts or legal basis and thus should be denied on that basis alone.

claims and Univision's likelihood of confusion and dilution claims are legally sufficient. The Order also afforded Univision an opportunity to file its Amended Petition restating its fraud claim with more specificity.

Unimundo filed its Motion to Dismiss the Amended Petition raising the issues that the Board already considered and rejected. Given that Univision's Amended Petition properly asserts a claim for fraud and the Board has already issued the Order confirming Univision's standing and right to assert its other claims, Unimundo's Motion to Dismiss the Amended Petition should be denied.

II. THE BOARD HAS ALREADY CONFIRMED THAT UNIVISION HAS PROPERLY ASSERTED STANDING

On June 30, 2011, Unimundo filed a motion to dismiss alleging that Univision's initial Petition to Cancel failed to properly assert standing. On July 18, 2011, Univision filed an opposition to that motion. On March 16, 2012, the Board issued its Order denying Unimundo's motion and confirming that Univision's initial Petition to Cancel properly asserts standing. See pg. 3 of the Order.

In addition to restatement of the fraud claim, the Amended Petition restates Univision's other allegations and claims as stated in the initial Petition to Cancel.[2] For purposes of standing, Univision's Amended Petition is exactly the same as Univision's initial petition. The Amended Petition does not raise any new standing issues. Since the Amended Petition does not raise any new standing issues and the Board has already considered and denied Unimundo's motion to

[2] Under the Federal Rules of Civil Procedure, "an amended complaint supersedes the initial complaint and becomes the operative pleading in the case," *Lowery v. Ala. Power Co.*, 483 F.3d 1184, 1219 (11th Cir. 2007). Thus, failure to include all claims and allegations in the Amended Petition would result in exclusion of any unasserted claims.

dismiss for lack of standing, Unimundo's Motion to Dismiss the Amended Petition should be denied.

III. THE BOARD HAS ALREADY CONFIRMED THAT UNIVISION HAS PROPERLY PLED ITS CLAIM FOR LIKELIHOOD OF CONFUSION AND DILUTION

The Order confirms that Univision's initial Petition to Cancel properly asserts claims for likelihood of confusion and dilution. The Order confirms that Univision's claim for likelihood of confusion is "legally sufficient" and that Univision's dilution allegations "are sufficient to state a legally sufficient dilution claim under Trademark Act Section 43 (c)." See pgs. 3-4 of the Order. No changes were made to Univision's likelihood of confusion and/or dilution claims in the Amended Petition (they were simply restated). Accordingly, Univision's likelihood of confusion and dilution claims, as stated in the Amended Petition, do not raise any new issues to be decided by the Board and thus, Unimundo's Motion to Dismiss the Amended Petition should be denied.

IV. UNIVISION'S AMENDED FRAUD CLAIM IS LEGALLY SUFFICIENT TO STATE A CLAIM FOR FRAUD ON THE TRADEMARK OFFICE

In response to Unimundo's initial motion to dismiss, the Board granted Univision leave to amend its fraud claim to include specific facts upon which the pleadings of 'on information and belief' were based. Order, pg. 4. Univision amended its fraud claim in accordance with the Order.

To properly state the necessary fraudulent intent, pleadings of fraud made 'on information and belief' must include specific facts upon which the belief is reasonably based. *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009), and

Mechatzer Lowenbrau Benedikt Wei KG v. White Gold, LLC, 95 USPQ2d 1185, 1187 (TTAB 2010). In *Mechatzer*, the allegations of 'information and belief' were based on the results of an investigation which petitioner alleged revealed that respondent was not using its marks on all of the goods listed in the Statement of Use at the time the Statement of Use was filed. *Mechatzer*, 95 USPQ2d at 1187.

Similarly, the Amended Petition identifies investigations done by Univision prior to commencement of the cancellation proceeding. The Amended Petition states that Univision investigated Unimundo's alleged use using internet search engines and internet archives (after all, Unimundo claims that its mark was used in connection with internet broadcasting television network). The Amended Petition also states that the results of Univision's investigation reveal that the Mark was not used by Unimundo on all of the goods and services listed in the application or the declaration filed by Unimundo's President and CEO. The Amended Petition also includes allegations that Unimundo knowingly made false, material misrepresentations of fact in procuring the registration with the intent to defraud the USPTO. These allegations are sufficiently specific and particular under Fed. R. Civ. P. 9(b) and related TTAB decisions. *See Mechatzer Lowenbrau Benedikt Wei KG v. White Gold, LLC*, 95 USPQ2d 1185, 1887 (TTAB 2010). Nothing more is required to properly plead a fraud claim. Accordingly, Unimundo's Motion to Dismiss the Amended Petition should be denied.

V. CONCLUSION

For the foregoing reasons, Univision Communication Inc. respectfully requests the Board to deny Unimundo's motion to dismiss the Amended Petition and Unimundo's Supplemental Memorandum of Law and Alternatively Motion to for an Order to Strike. In the event that the Board grants Unimundo's motion, Univision requests leave to file a second amended petition.

Respectfully submitted,

UNIVISION COMMUNICATIONS INC.

Dated: May 2, 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 OPPOSITION TO UNIMUNDO'S PETITION TO CANCEL UNIVISION'S FIRST AMENDED PETITION upon Registrant by depositing one copy in First Class mail, in the United States mail, postage prepaid, on **May 2, 2012** addressed as follows:

Marcus Fontain
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.