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

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|------------------------|---|
| Proceeding | 92054050 |
| Party | Plaintiff Univision Communications Inc. |
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| Date | 07/18/2011 |
| Attachments | Opposition to motion to dismiss.pdf (7 pages)(412257 bytes) |

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

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|--------------------------------|---|---------------------------|
| 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

I. INTRODUCTION

Univision Communication Inc.’s Petition to Cancel (“Petition”) states valid and legally cognizable claims against Unimundo Corp (“Unimundo”). Unimundo, argues that the Petition should be dismissed because Univision has failed to set forth elements necessary to state a claim. Unimundo, however, is required by Rule 12(b)(6) and 37 CFR 2.127(a) to identify what elements of what claims it purports were not properly alleged by Univision, and Unimundo categorically fails to do so. All that Unimundo does is to throw up in the air a disjointed number of ad hominem (and false) attacks against Univision’s financial condition, Univision’s operations and Univision’s attorneys. Failure to comply with the pleading requirements is sufficient grounds to deny Unimundo’s motion.

Even if the Board were to overlook the apparent deficiency of Unimundo's motion, the motion must be denied because Univision has asserted facts sufficient to demonstrate standing and valid grounds for its claims.

II. LEGAL STANDARD

A motion to dismiss for failure to state a claim is solely a test of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege facts that, if proven, would establish that the plaintiff has (1) standing to maintain the proceeding and (2) a valid basis for cancelling the subject registration. Trademark Board Manual of Procedure ("TBMP") § 503.02. A plaintiff need not prove its allegations in its complaint. Whether or not a plaintiff can prove the allegations set forth in a petition to cancel is a matter to be determined at the final hearing, not on a motion to dismiss. *Id.* The party moving for dismissal has the burden to prove that no claim has been stated. To prevail, the movant must show beyond a doubt that the plaintiff can prove no set of facts in support of his claim that would entitle him to relief. *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952 (TTAB 2009). Unimundo has failed to meet this burden. Apart from denying the allegations and making conclusory statements that Univision has purportedly failed to properly assert a claim, Unimundo does not present any facts, argument or law to support its argument. The Petition sets forth all the facts necessary to establish standing and a claim for likelihood of confusion, dilution and fraud. Accordingly, Unimundo's motion should be denied.

III. UNIVISION HAS PROPERLY ASSERTED STANDING

A petition to cancel may be brought by any person who believes he is or will be damaged by the registration of a mark. *See* 15 U.S.C. §1064. In order to meet the standing requirement, a plaintiff need only show that it has a real interest, i.e., a personal stake, in the outcome of the

proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). Here, the Petition identifies the parties and their respective business operations. The Petition states that consumers are likely to think that the Mark is affiliated with Univision and/or its services and thus, cause damage and harm to Univision. Petition, ¶¶ 1-3, 11. Nothing more is required to assert standing. *See* TBMP 309.03(b).

IV. UNIVISION HAS PROPERLY PLED ITS CLAIM FOR LIKELIHOOD OF CONFUSION, DILUTION AND FRAUD ON THE TRADEMARK OFFICE

Unimundo contends that Univision has failed to properly assert its claims. Unimundo, however, fails to identify what elements of what claims Univision has not properly alleged. Unimundo also fails to cite to a single case that supports its position. As Unimundo has failed to identify what elements of what claims have purportedly not been properly alleged, Univision addresses the elements of each of its claims. As set forth below, Univision has properly asserted all necessary elements to assert its claim for likelihood of confusion, dilution and fraud on the Trademark Office. Accordingly, Unimundo's motion should be dismissed.

A. Likelihood of Confusion

A claim for likelihood of confusion is properly pled if the opposing party claims that a registered mark so resembles the opposing party's mark as to be likely to cause confusion or mistake when used on or in connection with the goods or services identified in the registration. Trademark Manual of Examining Procedure ("TMEP") §1207.01. Univision's Petition sets forth these elements.

The Petition identifies Univision and its business operations. Petition ¶¶ 1-2. The Petition also describes the procedural history of the Mark and the services identified in the

registration. Petition ¶¶ 4-7. The Petition identifies Univision's Registered Marks (as defined in the Petition) and states that the Mark resembles Univision's Registered Marks such that consumers are likely to think that the Mark is either affiliated with Univision or that the Mark and its related services are a joint venture between Univision and Unimundo. Petition ¶10. The Petition also states that use of the Mark by Unimundo has and will continue to cause damage and harm to Univision. Petition ¶11. Univision has pled all the necessary elements for a claim of likelihood of confusion. Accordingly, Unimundo's motion should be dismissed.

B. Dilution

The federal dilution statute, 15 U.S.C. § 1125(c), permits the owner of a famous mark to state a claim for dilution by "blurring" or "tarnishment." To state a claim for dilution, the complaint must include (i) a claim that the mark is famous and (ii) state whether dilution is by "blurring" that impairs the famous mark's distinctiveness and/or "tarnishment" that harms the famous mark's reputation. Univision's Petition sets forth these elements and therefore properly asserts a claim for trademark dilution.

The Petition identifies Univision as the leading Spanish-language media company in the United States that has been delivering news and entertainment to Spanish-speaking audiences since at least as early as the late 1970s. Petition, ¶1. The Petition further states that Univision's Registered Marks are famous and widely recognized by Spanish and English-speaking audiences throughout the globe. Petition, ¶3. Univision then spends several paragraphs explaining how the Mark has and will likely continue to cause damage and harm to Univision as a result of dilution by blurring and tarnishment. Petition, ¶¶12-15. The Petition states that use of the Mark by Unimundo has caused and is likely to continue to cause dilution by blurring by impairing the distinctiveness of Univision's Registered Marks and dilution by tarnishment by harming the

reputation and goodwill associated with Univision's Registered Marks. *Id.* Accordingly, Univision has properly pled its claim for dilution and Unimundo's motion must be denied.

C. Fraud on the Trademark Office

A claim for fraud on the Trademark Office requires assertions of material misrepresentations that were knowingly made to procure a registration. *Daimler Chrysler Corp. and Chrysler, LLC v. American Motors Corp.*, Canc. No. 92045099 (Jan. 14, 2010). Intent, as a condition of mind, of a person to deceive the Trademark Office may be averred generally. See Fed. R. Civ. P. 9(b) and *Id.* at p.5.

Here, Univision has sufficiently pled a fraud claim, including Unimundo's requisite intent to deceive the USPTO in the procurement of its registration. Specifically, the Petition states that Marcus Fontain, the CEO of Unimundo, knowingly made material misrepresentations to the Trademark Office in order to procure registration of the Mark. Petition, ¶¶4-6. The allegations preceding and following this assertion state the specific representations of fact that Univision alleges were false, were known to be false, were material, and were relied upon by the Trademark Office (e.g., statements by Unimundo that the Mark was being used in connection with "television broadcasting" and "internet broadcasting television network" when the Mark had not been used in connection with such services). Petition, ¶¶ 4-9. Paragraph 8 of the Petition specifically refers to Unimundo's intent to deceive. It states that Mr. Fontain submitted verified statements to the Trademark Office that contained false material misrepresentations of fact in order to procure registration of the Mark. Accordingly, the Petition properly identifies known misrepresentations on a material matter that were made by Unimundo to procure a registration of the Mark. Thus, Univision's fraud claim is properly pled and Unimundo's motion must be denied.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSITION TO UNIMUNDO'S PETITION TO CANCEL upon Registrant by depositing one copy in First Class mail, in the United States mail, postage prepaid, on **July 18, 2011** addressed as follows:

**Marcus Fontain
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