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

Proceeding	92054452
Party	Plaintiff Jose Guzman
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Attachments	Opposition of Petitioner J. Guzman to Registrants' Motion to Amend Registration No. 3979438.pdf (6 pages)(70733 bytes)

Petitioner filed its application for use of “La Senal de Tierra Caliente” on May 17, 2011 and filed the Petition for cancellation herein on August 30, 2011 (the “Petition”). In the Petition, Petitioner alleges that it has continuously used the mark since March 31, 2005. On October 11, 2011, Registrant answered the Petition and filed a Motion to Amend the Registration to claim that Registrants have used the mark at least as early as 2004 (the “Motion”). In the Motion, Registrants claim that they submitted the statement of use without assistance of counsel and inadvertently claimed the dates of first use and first use in commerce as May 22, 2010. Petitioner opposes the relief requested in the Motion because Registrants have not provided clear and convincing evidence of the purported earlier first use date. Further, a decision on the Motion is premature and should be deferred to the end of this cancellation proceeding.

II. ARGUMENT

A. The Moving Party Has Not Provided the Clear and Convincing Evidence Required to Amend the First Use Date of the Registration.

A change of position to earlier dates of use requires enhanced substantiation. *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1473 (Fed Cir. 1987) (holding that where applicant seeks to prove an earlier date than alleged in its application proof must be clear and convincing). To succeed on the Motion, Registrants have the burden to establish the earlier use date by clear and convincing evidence. *Id.* Registrants have not provided clear and convincing evidence that establishes that they have used the mark as early as 2004. *See, e.g. Helene Curtis Industries, Inc. v. Suave Shoe Corporation*, 13 U.S.P.Q.2d (BNA) 1618 at *10 (Trademark Tr. & App. Bd. 1989) (finding evidence of shipping label using trademark at earlier time not sufficient to change date of first use). To be clear and convincing, proof of earlier use “must not be characterized by contradiction, inconsistencies or indefiniteness.” *Threshold TV, Inc. v. Metronome Enterprises, Inc.*, 96 U.S.P.Q.2d (BNA) 1031 at *4 (Trademark Tr. & App. Bd. 2010).

Registrants have not provided clear and convincing evidence to establish bona fide use of the mark as early as 2004. In support of their answer to the Petition, Registrants filed the declarations of Hector Arambula and Juan Valdez Sanchez (collectively, the “Declarations”).¹ The Declarations contain objectionable evidence not supported by adequate personal knowledge that is indefinite at best. First, the declaration of Juan Valdez Sanchez does not provide any evidence, other than Mr. Sanchez’s self-serving statement, that Registrants used the mark at least as early as November 6, 2004. Mr. Sanchez’s statement is indefinite regarding how, when, where and how frequently Registrants used the mark. Similarly, the declaration of Hector Arambula does not provide clear and convincing evidence of earlier use of the mark. Mr. Arambula only states that he was the “booking agent” for Monterrey Artist Inc. and that in that capacity he booked a band with the name “La Senal de Tierra Caliente” to perform at an event on November 6, 2004. Mr. Arambula’s declaration does not identify Registrants as members of the band he booked to perform. Further, neither the contract nor the Declarations establish that the band actually performed at the event in November 2004. Based on the foregoing, not only do the Declarations not show that the mark was actually used in November 2004, they do not even establish precisely who purportedly used the mark. For the foregoing reasons, the Declarations are not definite and do not provide clear and convincing evidence of the Registrants’ bona fide use of the mark as early as November 2004. On this basis alone, the Trademark Trial and Appeal Board (the “Board”) should deny Registrants’ Motion in its entirety.

B. In the Alternative, the Board Should Defer a Decision on the Motion to Amend Registration Until the End of this Cancellation Proceeding.

A registration subject to a cancellation may only be amended with the consent of the other parties and approval of the Board or upon motion granted by the Board. 37 C.F.R. § 2.133 (2011). Generally, the Board will defer a decision on an unconsented motion to amend

¹ Under Trademark Rule 2.71(a), the Motion to Amend must be supported by an affidavit or declaration. 37 C.F.R. § 2.71 (2011). For purposes of this Opposition, Petitioner will consider the Declaration filed in support of Registrants’ “Answer to the Petition” to also be the declaration submitted in support of the Motion.

registration until a final decision is reached in the cancellation proceeding. TBMP 514.03 (3d ed. 2011); *see also Fort Howard Paper Co. v. G. V. Gambina Inc.*, 4 U.S.P.Q.2d (BNA) 1552, 1554 (Trademark Tr. & App. Bd. 1987) (holding that it is the practice of the Board to defer ruling on motions to amend the dates of first use in a registration application until after final hearing). As here, the registrants in *Threshold TV, Inc.* asserted that because they prosecuted their application for registration without the assistance of trademark counsel, they did not understand the term “use” and inadvertently submitted the wrong first use date with their registration. 96 U.S.P.Q.2d (BNA) 1031 at *4. In that case, the Board deferred ruling on the motion to amend until the end of the action. *Id.* Here, the Board can either deny the Motion at this stage or delay a decision on the Motion until the conclusion of this action to allow Petitioner to take discovery and test the credibility of Registrants’ purported evidence.

An amendment of the Registration at this early stage of the cancellation proceeding would provide an unfair advantage to Registrants and prejudice the rights of Petitioner. Registrants only filed their Motion because Petitioner now seeks to cancel the Registration. Registrants’ Motion is therefore suspect and should be suspended to allow Petitioner to conduct discovery to explore whether Registrants are attempting to procure an earlier first use date based on false information. In fact, Petitioner is informed and believes that Registrants did not use the purported Registration in 2004 and were using the name: “La Zanal Jalisciense” at that time. Further, the testimony and evidence required for a determination in this cancellation action is the same as the evidence required to rule on the Motion. Because the evidence presented in support of the Motion necessarily must be consistent with the evidence presented at trial of this action, it would be more efficient for the Board to resolve both issues at the same time. *See Fort Howard Paper Co.*, 4 U.S.P.Q.2d (BNA) 1552, 1554 (holding that a motion to amend registration “shall be granted only if the proposed amendment is established by, or is not inconsistent with, evidence adduced during the testimony period”). For the foregoing reasons, the Board should either deny the Motion or defer ruling on the Motion until the end of this cancellation action.

III. CONCLUSION

The Board should deny the Motion because Registrants have not provided clear and convincing evidence to support bona fide use of the Registration in commerce as early as November 2004. The Declarations submitted in support of the Motion are objectionable and wholly inadequate. At a minimum, the Board should allow Petitioner to conduct discovery regarding the Registrants' purported earlier use. For the foregoing reasons, the Board should either deny the Motion or defer ruling on the Motion until resolution of this action in its entirety.

DATED: October 26, 2011

FRIEDEMANN GOLDBERG LLP

By: 

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Attorneys for Petitioner
JOSE GUZMAN

CANCELLATION NO. 92054452

REGISTRATION NO. 3979438

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Petitioner's Opposition Of Petitioner Jose Guzman To Registrants' Motion To Amend Registration No. 3979438** has been served on Attorneys for Registrants, Anne-Leith W. Matlock and Suma N. Ramaswamy-Canzius by mailing said copy on October 26, 2011, via overnight courier, postage prepaid to:

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