

ESTTA Tracking number: **ESTTA547971**

Filing date: **07/11/2013**

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

Proceeding	92055269
Party	Plaintiff Mango's Tropical Cafe, Inc.
Correspondence Address	DAVID K FRIEDLAND FRIEDLAND VINING PA 1500 SAN REMO AVENUE, SUITE 200 CORAL GABLES, FL 33146 UNITED STATES trademarks@friedlandvining.com, dkf@friedlandvining.com, jrv@friedlandvining.com
Submission	Reply in Support of Motion
Filer's Name	Jaime Rich Vining
Filer's e-mail	trademarks@friedlandvining.com, dkf@friedlandvining.com, jrv@friedlandvining.com
Signature	/Jaime Rich Vining/
Date	07/11/2013
Attachments	REP - Motion to Amend - 7.11.13 - AS FILED.pdf(156363 bytes)

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

Mango's Tropical Cafe, Inc.,
Petitioner,

v.

Tango Mango, LLC,
Registrant.

Cancellation No.: 92055269
Registration No.: 3,328,822
Mark: **TANGO MANGO**
Registration Date: November 6, 2007

**PETITIONER'S REPLY MEMORANDUM IN SUPPORT OF ITS RENEWED MOTION
FOR LEAVE TO FILE AMENDED PETITION TO CANCEL**

Petitioner Mango's Tropical Cafe, Inc. (hereinafter "Petitioner") respectfully submits this reply memorandum in support of its Renewed Motion for Leave to File Amended Petition to Cancel ("Motion to Amend"). In support thereof, Petitioner states as follows:

I. INTRODUCTION

In its Opposition to Petitioner's Motion to Amend ("Opposition"), Registrant Tango Mango, LLC ("Registrant") objects to Petitioner's renewed request to amend its Petition to Cancel on the grounds that: (1) "the assertion of likelihood of confusion was already before the United States Patent and Trademark Office ["PTO"] and no likelihood of confusion was found" between Petitioner's two additional registrations, namely **MANGO'S (word mark)**, Reg. No. 4,190,731, and **MANGO'S TROPICAL CAFE (word mark)**, Reg. No. 4,224,643 (the "New Mango's Registrations")¹, and Registrant's **TANGO MANGO** mark; (2) Petitioner's newly-asserted abandonment

¹ Registrant does not dispute that the New Mango's Registrations were both issued following the initiation of this cancellation proceeding.

claim is “legally insufficient and serves no useful purpose;” and (3) Petitioner unduly delayed² in asserting its two registrations and proposed abandonment claim.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See Karsten Mfg. Corp. v. Editoy AG*, 79 U.S.P.Q.2d 1783 (TTAB May 4, 2006); *Coach, Inc. v. Denise Mourges*, 2004 WL 341248 (TTAB Feb. 18, 2004). Neither exception is applicable to the instant proceeding. As discussed below, the arguments raised in Registrant’s Opposition are ill-conceived and without legal merit.

Registrant’s assertion that the PTO has already determined that a likelihood of confusion does not exist is both puzzling and irrelevant. In addition, Registrant concedes that the entity identified as “TANGO MANGO, LLC” (i.e. Registrant) does not exist and has never existed so Petitioner has sufficiently stated a claim for abandonment. Finally, any alleged delay was caused by the actions and misrepresentations of Registrant and its counsel. Accordingly, Petitioner requests that that the Board GRANT it leave to amend the original Petition to Cancel.

² “Generally, delay in seeking leave to amend a pleading is not in and of itself a reason to deny a motion to amend.” *Cashflow Technologies v. Netdecide*, 2002 WL 192410 (TTAB Feb. 7, 2002)(seeking leave to amend thirty-five days after discovery closed did not constitute undue delay).

II. ARGUMENT

A. Registrant's Discussion of the PTO and Likelihood of Confusion is Wholly Irrelevant

In the Opposition, Registrant argues that “the [PTO] has already determined that the Tango Mango Mark is not likely to cause confusion with the Petitioner’s new registrations.” Opposition, p. 3. Without further elaborating, Registrant appears to suggest that because the Trademark Examining Attorney assigned to review Petitioner’s applications for the New Mango’s Registrations did not refuse Petitioner’s applications on the basis of confusion with Registrant’s **TANGO MANGO** mark, then the PTO has already concluded that a likelihood of confusion does not exist and such purported finding should somehow be binding on the Board. This argument is nonsensical.

It is well established that prior decisions and actions of other examining attorneys and the PTO have little evidentiary value and are not binding on the Board. *See In re Bennett*, 2013 TTAB LEXIS 256, *9-10 (TTAB May 13, 2013)(“Prior decisions in other applications are not binding on the Board, and each case must stand on its own merits.”)(citing *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)); *see also In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009)(“Even if all of the third-party registrations should have been refused registration ..., such errors do not bind the USPTO to improperly register Applicant's marks.”); *Tatuaje Cigars, Inc. v. Nicar. Tobacco Imps., Inc.*, 2011 TTAB LEXIS 377, *11-12 (TTAB Nov. 22, 2011)(“Finally, the fact that two separate examining attorneys

passed applicant's and opposer's subsequent marks on for publication is of little to no probative value. At a minimum, the records in the *ex parte* examinations would be quite different from the record in this *inter partes* proceeding. Moreover, previous decisions by examining attorneys are without evidentiary value and are not binding on the agency or the Board.”)(citing *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009)).

Registrant has not proffered any legal authority to support its flawed theory that the PTO’s purported determination “that the Tango Mango Mark is not likely to cause confusion with the Petitioner’s new registrations” (which Petitioner disputes) has any relevance to or bearing on this proceeding or the Board. Given the precedence above, Registrant’s assertions are baseless.

B. Petitioner’s Amended Petition Sufficiently States a Claim for Abandonment.

With respect to the substance of Petitioner’s proposed new claim for abandonment, Registrant argues that the claim “is defeated on its face by its very own logic and is insufficient and serves no useful purpose.” Opposition, p. 5. As an initial matter, Registrant unambiguously concedes that the entity identified as “TANGO MANGO, LLC” does not exist and has never existed. Instead, Petitioner argues that “the Tango Mango Mark remains owned by the original registrant,” notwithstanding two invalid assignments from and to “TANGO MANGO, LLC,” an entity that does not legally exist, and the resultant loss of goodwill and priority date.

Registrant asserts “Tango Mango LLC would not have been able to assign the Tango Mango Mark to Knightspin, LLC, in the first place.” Registrant’s evasive, red

herring efforts are intended to distract the Board’s attention from the irrefutable fact that “TANGO MANGO LLC,” the entity currently identified as “Registrant,” is not a natural or juristic person, as required pursuant to 15 U.S.C. § 1127 and TMEP §§ 803 and 501.05. While it may be true that the assignment to Knightspin LLC (and Knightspin LLC’s subsequent assignment back to “TANGO MANGO, LLC”) may be invalid,³ “TANGO MANGO, LLC” does not exist as a legal entity and therefore cannot possibly be using the mark for which registration has been obtained.

Alternatively, if Registrant is truly the owner of the mark, as Registrant has maintained throughout the pendency of this cancellation proceeding (in both pleadings and discovery responses), despite the fact that it does not legally exist, then the registration for the **TANGO MANGO** mark is void and subject to cancellation.

If an applicant is not the owner of (or entitled to use) the mark at the time the application is filed, the application is void and cannot be amended to specify the correct party as the applicant, because the applicant did not have a right that could be assigned.

Trademark Manual of Examining Procedure ("TMEP") § 803.01, *citing* 37 C.F.R. § 2.71(d); *see also Third Educ. Group, Inc. v. Phelps*, 2009 U.S. Dist. LEXIS 67434, *10-11 (E.D. Wis. May 15, 2009)(voiding the application and subsequent registration because the registrant had “no interest that could be assigned.”). Under either theory, Registrant’s corporate shell game and invalid assignments cast a cloud on the title of the **TANGO**

³ *A & L Laboratories, Inc. v. Bou-Matic LLC*, 429 F.3d 775, 780, 77 U.S.P.Q.2d 1248 (8th Cir. 2005) (“Trademark ownership may be assigned, but the assignor may transfer only what it owns.”); *Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666, 675, 216 U.S.P.Q. 11 (7th Cir. 1982) (“An abandoned trademark is not capable of assignment, ...”).

MANGO mark. Petitioner therefore submits that its proposed claim for abandonment is legally sufficient and serves a useful purpose. *Dollar Tree Stores, Inc. v. Everything for a Dollar Store (Canada) Inc.*, 2001 TTAB LEXIS 285, *3-5 (TTAB Mar. 30, 2001)(rejecting argument that proposed abandonment claim “would be futile and would waste the resources of the Board and the parties”). Registrant's admissions regarding the chain of title to the registration at issue in this proceeding help establish that Petitioner's claim of abandonment is appropriate for the Board to determine in this proceeding.

C. Registrant and Its Counsel Are the Exclusive Source of Any Perceived Delay.

Finally, Registrant’s assertions regarding Petitioner’s “undue delay” and the “prejudice” Registrant will potentially suffer are so disingenuous that they are laughable. Preliminarily, Petitioner initially sought to amend its Petition to Cancel on January 18, 2013. Prior to seeking leave, Petitioner had been engaged in settlement discussions with Registrant. *See* Declaration of Jaime Vining attached hereto as Exhibit A, ¶ 3.⁴ On January 18, 2013 and January 22, 2013, counsel for Registrant unambiguously confirmed its acceptance of the proposed settlement terms. *Id.*, ¶ 4.

On the basis of Registrant’s acceptance of the settlement terms, Petitioner agreed to suspend this proceeding for 90 days while the parties documented their settlement. *Id.*, ¶ 5. Subsequently, counsel for Petitioner forwarded settlement documents to counsel for Registrant. *Id.*, ¶ 6. On April 24, 2013, Petitioner agreed to further suspend the proceeding for an additional 60 days, after Registrant and its counsel failed to provide

⁴ Due to the sensitive nature of the settlement terms, Petitioner is filing Exhibit A confidentially.

any comments on the draft settlement agreement provided to them by undersigned counsel and counsel for Registrant represented that he was awaiting "minor comments" from his client. *Id.*, ¶ 7. Months after Registrant's counsel finally advised that Registrant had "minor comments" on the draft agreement, Registrant's counsel sent an email on June 21, 2013, renegeing on the previously-reached settlement. *Id.*, ¶ 8.

As is clearly evident by a review of the parties' communications between January and June of this year, Registrant has taken no action with the Board to move this proceeding forward for one singular reason: Registrant's written representations that the matter was resolved. Registrant's counsel accepted, in writing, settlement terms and then confirmed her client's acceptance of those terms in writing. Over five months later, after having not uttered a word of substance regarding the settlement agreement but representing that the agreement might be subject to "minor comments," Registrant suddenly, on the eve of the expiration of the latest suspension period, renegeed on terms that had been accepted in writing. But for Registrant's acceptance of the settlement terms in January, this matter would not have been suspended for 150 days by agreement of the parties. Any delay of which Registrant speaks in its opposition was solely caused by the actions of Registrant and its counsel. As a result of Registrant's counsel's various material misrepresentations, Registrant has been hoist on its own petard. The delay is Registrant's own doing, so Registrant cannot use the delay as a basis for opposing Petitioner's efforts to amend the Petition to Cancel.

/

III. CONCLUSION

For all of the foregoing reasons, as well as the reasons set forth in Petitioner's Renewed Motion to Amend, Petitioner Mango's Tropical Cafe, Inc. respectfully requests that the Board enter an Order granting Petitioner leave to file an amended Petition to Cancel.

Date: July 11, 2013

Respectfully submitted,

FRIEDLAND VINING, P.A.

/s/Jaime Rich Vining

By: **David K. Friedland**
Florida Bar No. 833479
Jaime Vining
Florida Bar No. 30932
1500 San Remo Avenue, Suite 200
Coral Gables, Florida 33146
(305) 777-1720 telephone
e-mail: dkf@friedlandvining.com
e-mail: JRV@friedlandvining.com

*Counsel for Petitioner Mango's Tropical
Cafe, Inc.*

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing **PETITIONER'S REPLY MEMORANDUM IN SUPPORT OF ITS RENEWED MOTION FOR LEAVE TO FILE AMENDED PETITION TO CANCEL** was served upon the Registrant by delivering true and correct electronic copies of same to Registrant through its counsel on July 11, 2013 as follows:

Mr. Rebecca J. Stempien Coyle
Levy & Grandinetti
P.O. Box 18385
Washington, D.C. 20036
mail@levygrandinetti.com

/s/Jaime Rich Vining
Jaime Rich Vining