

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

ECUABEVERAGE CORPORATION,

Petitioner,

-v-

BALORU S.A.,

Respondent

Cancellation No.
92055569

85-336,274

**RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY
JUDGMENT AND CROSS MOTION FOR DISMISSAL AND SANCTIONS**

Pursuant to Rules 56, 12(b)(6) and 11 of the Federal Rules of Civil Procedure, Respondent Baloru S.A. ("Baloru") submits this Memorandum of Law in Opposition to Petitioner Ecuabeverage Corporation's Motion for Summary Judgment and in support of Baloru's Cross-Motion for Dismissal and Sanctions. Petitioner, in support of its Motion, filed a Memorandum of Law with a number of exhibits. One of the exhibits is an improperly submitted affidavit from another proceeding, and two of the exhibits consist of inadmissible hearsay. In addition, not only does Petitioner's Memorandum of Law attempt to obfuscate the fact that it has been filed in violation of the TTAB's Rules and the Federal Rules of Civil Procedure, but it contains recycled arguments that Petitioner has unsuccessfully previously used in Cancellation Proceedings Nos. 92051197 and 92051242 and the TTAB rejected. Because (i) the filing of Petitioner's Motion violates the TTAB's Discovery Procedures and the Federal Rules of Civil Procedure, (ii) Petitioner's argument is based on a theory of acquiescence, and (iii) Petitioner has failed



to establish the absence of genuine issues any material facts, the TTAB should deny Petitioner's Motion in its entirety and dismiss the Petition for Cancellation. Furthermore because all of the foregoing constitute an abuse of process, the TTAB must also grant Respondent's Cross Motion for Sanctions.

PROCEDURAL STANDING OF THE CASE

Petitioner filed the instant petition for cancellation on April 23, 2012. On May 7, 2012, the Board issued the trial order. The Trial Order mandated that Baloru file its answer by June 16, 2012; the parties hold their Fed. Rule Civ. P. 26(f) Discovery Conference by July 16, 2012; all Discovery is to open July 16, 2012; and the parties' mandatory initial disclosures are to be served on each other by August 15, 2012.

Because the deadline for the parties' Discovery Conference as set forth in the Trial Order was in July, the parties had not yet conducted their Fed. R. Civ. P. 26(f) discovery conference when Petitioner served its initial disclosures on Baloru on June 5, 2012, prior to the opening of Discovery and contrary to the Rules. Following this rule-violating service of its initial disclosures, Petitioner, on June 20, 2012, served the instant motion for summary judgment. Baloru served and filed its Answer on June 14, 2012 denying the salient allegations of the Petition for Cancellation and asserting four affirmative defenses.

THE PARTIES

Respondent Baloru, S.A., a sociedad anonima organized and existing under the laws of Ecuador, is the owner of U.S. Trademark Registration No. 4,120,917.

Baloru is a manufacturer of concentrates used for making soft drinks that are sold in the United States. Brooklyn Bottling of Milton, New York, Inc. (Brooklyn Bottling),

in turn, is a U.S. distributor of soft drinks made from concentrate or syrup manufactured by Baloru.

Petitioner is a direct competitor of Brooklyn Bottling.

Brooklyn Bottling did not assign the mark that is the subject of Registration No. 4,120,917 to Baloru, nor has Baloru ever assigned its rights in said mark to any other party. Wilentz Decl., Exhibit F (Excerpts from File Wrapper of Registration No. 4,120,917 printed from uspto.gov).

Petitioner owns registration No. 2892511 for the mark TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR ECUATORIANO SODA DE FRESA and design, for “Soda, namely, carbonated soft drinks.” During the prosecution of the application that led to this registration Petitioner failed to disclaim the term TROPICAL. Wilentz Decl., Exhibit G (Excerpts from File Wrapper of Registration No. 2,892,511 printed from uspto.gov).

Petitioner and/or Petitioner’s president, Francisco Cervantes, formerly distributed Respondent’s TROPICAL brand soft drinks in the United States. Exhibit 1, (shipping documents); Wilentz Decl., Exhibit E, (Declaration of Carlos Tama).

The parties have not held a 26(f) discovery conference.

PRIOR PROCEEDINGS

On July 20, 2009 Petitioner filed Cancellation No. 92051242 to cancel Baloru’s registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL, alleging laches and acquiescence as grounds for cancellation. (Wilentz Decl. Exhibits A & C). Petitioner’s attorney, Mr. Schindler, represents Petitioner in said Cancellation.

In its January 20, 2011 order, the Board consolidated Cancellation Proceedings Nos. 92051197 and 92051242, and dismissed Petitioner's petition for cancellation in Proceeding 92051242 because the asserted grounds were affirmative defenses, namely laches and acquiescence. (Wilentz Decl., Exhibit C).

In its January 20, 2011 order, the Board clearly stated that affirmative defenses are not grounds for cancellation. (Wilentz Decl., Exhibit C, pages 3-5).

Consequently, as a result of the Board's January 20, 2011 order, Petitioner and Petitioner's attorney, Mr. Schindler, are fully aware that acquiescence is an affirmative defense and is not grounds for cancellation. (Wilentz Decl., Exhibit C).

Petitioner's summary judgment motion is based on Petitioner's assertion that Brooklyn Bottling acquiesced to Petitioner's use of the term "tropical" to market Petitioner's product. (Petitioner's memorandum in support of its motion, generally).

Respondent herein was substituted for Brooklyn Bottling as party defendant in proceeding 92051242 by order of the Board dated May 1, 2012. (Wilentz Decl., Exhibit D).

ARGUMENT

A. The Motion for Summary Judgment is Premature and Must be Dismissed as Petitioner's Initial Disclosures Were Improperly Served Prior to the Opening of Discovery and Prior to the 26(f) Conference

A party may not file a motion for summary judgment until the party has made its initial disclosures. 37 C.F.R. 2.127(e)(1). And a party may not make its initial disclosures until after discovery has opened and the parties have conducted their Federal Rule 26(f) meeting. The Trademark Rules of Practice stipulate that procedure in *inter partes* proceedings before the TTAB is governed by the Federal Rules of Civil Procedure.

37 C.F.R. §2.116(a). The Federal Rules of Civil Procedure in turn, require that initial disclosures must be made *at or after* the 26(f) discovery conference:

Time for Initial Disclosures--In General. A party must make the initial disclosures at or within 14 days after the parties' Rule 26(f) conference unless a different time is set by stipulation or court order, or unless a party objects during the conference that initial disclosures are not appropriate in this action and states the objection in the proposed discovery plan. In ruling on the objection, the court must determine what disclosures, if any, are to be made and must set the time for disclosure.

Fed. R. Civ. P. 26(a)(1)(c) (emphasis added). See also, *Wintice Group, Inc. v. Longleg*, 2011 WL 383039 (D. Nev., 2011) (“Unless a different time is set by stipulation or court order, initial disclosures must be made within fourteen days of the parties' Rule 26(f) conference”); *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc.* 218 F.Supp.2d 1243, 1252 (S.D.Cal.,2002) (“party must make initial disclosures at or within 14 days after the Rule 26(f) conference”); *Winfield Collection, Ltd. v. Sun Hill Industries, Inc.*, 2002 WL 1009571 (E.D.Mich.,2002) (“Rule 26(a)(1) requires that initial disclosures be made at or within 14 days after the Rule 26(f) conference unless a different time is set by stipulation or court order”) (internal quotations omitted).

The Trademark Rules of Practice adopted a modified version of Federal Rule of Civil Procedure 26 pertaining to initial disclosure. While FRCP 26(a)(1)(c) requires that initial disclosures be made at or within 14 days of the 26(f) conference, the Trademark Rules require that initial disclosures be made within 30 days of the opening of discovery. See Federal Register / Vol. 72, No. 147 / Wednesday, August 1, 2007 / Rules and Regulations, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, at 42245: “Deadline for making initial disclosures—30 days from the opening of the

discovery period.” The reason for this modification of the Federal Rule 26(a)(1)(c) is to provide a longer period for making disclosures than is provided under the Federal Rules:

The deadline for making initial disclosures is similar to that of Federal Rule 26(a)(1), except that disclosure under the federal rule is measured from the actual date of, not the deadline for, the discovery conference. Because the Board approach measures the due date for disclosures from the opening of discovery, which typically will occur after the discovery conference, the Board approach typically will provide a longer period for making disclosures than is provided under the federal rule.

42242 Federal Register / Vol. 72, No. 147 / Wednesday, August 1, 2007 / Rules and Regulations, Miscellaneous Changes to Trademark Trial and Appeal Board Rules at 42245. Thus, the Trademark Rules of Practice clearly did not alter the requirement in Federal Rule 26(a)(1)(c) that initial disclosures be made at or after the 26(f) conference. Rather, the Trademark Rules of Practice simply modified the federal rule to allow for a longer period after the discovery conference in which the parties could exchange initial disclosures. As the purpose of the modification was to provide for a longer period during which initial disclosures could be made, such modification of FRCP 26(a)(1)(c) adopted by the Trademark Rules of Practice would serve no purpose if the initial disclosures could be made prior to the opening of the discovery period and prior to the parties’ Rule 26(f) meeting.

Further, it is clear that the Trademark Rules of Practice require that initial disclosures must be served during the discovery period:

The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.

37 CFR 2.120(a)(1) (emphasis added); TBMP 403.01.

Consistent with all of the foregoing, the Board in its May 7 Trial Order in the this proceeding specified that the initial disclosures were to be made during the discovery period by August 15, 2012, after Discovery opened and after the parties' Rule 26(f) Discovery Conference, which had to be held by July 16, 2012. Thus, it is clear that the Trademark Rules of Practice do not allow for initial disclosures to be served prior to the opening of discovery and, more importantly, prior to the 26(f) discovery conference. Allowing initial disclosures to be served prior to the opening of discovery and prior to the discovery conference would defeat the purpose of the discovery conference and the entire disclosure regime adopted by the Board in 2007.

Yet that is exactly what Petitioner would be doing if it is permitted to get away with its June 5, 2012 service of initial disclosures on Baloru, before the parties held a Rule 26(f) discovery conference and before the July 16, 2012 opening of discovery. Accordingly, the Board must find that Petitioner's June 5, 2012 service of initial disclosures on Baloru is improper and therefore invalid. And if the Board finds that Petitioner's June 5, 2012 service of initial disclosures on Baloru is improper and therefore invalid then the Board must also find that the filing of Petitioner's motion for summary judgment violates 37 C.F.R. §2.127(e)(1) and is therefore improper. Accordingly, Petitioner's Motion for Summary Judgment should be dismissed in its totality.

B. The June 18 Email Exchange Between the Parties Does not Alter the Fact That Petitioner's June 5th Service of Initial Disclosures Was Improper

On June 18, 2012, counsel for the parties exchanged emails. This email exchange cannot be construed as indicating that Baloru considers the instant summary judgment motion to be procedurally proper. The invalid service of initial disclosures prior to the opening of discovery and prior to any 26(f) discovery conference had already happened

on June 5, 2012. It is this invalid service of initial disclosures that Baloru objects to, as Petitioner is attempting to use said invalid service of initial disclosures as a basis for the instant summary judgment motion, which, as set forth in further detail below, appears to have been filed in order to harass and waste the resources of Baloru. The invalid service of initial disclosures was not discussed in the June 18 email exchange, and therefore said email exchange cannot be viewed as any concession on Baloru's part regarding the validity of Petitioner's service of its initial disclosures. Accordingly, no matter how Petitioner may try to depict this email exchange, Baloru's counsel never acknowledged that Petitioner's summary judgment motion was procedurally proper.

C. Improper Introduction of Testimony From Another Proceeding

Petitioner has attached as Exhibit 5 to Petitioner's motion for summary judgment a purported affidavit of Eric Miller. This affidavit constitutes testimony from another proceeding, and may be considered as evidence only upon granting of a motion filed pursuant to Trademark Rule 2.122(f). 37 CFR §2.122(f); See, e.g., Focus 21 International, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha 1992 WL 76584, Cancellation No. 19,611 (TTAB February 27, 1992). Trademark Rule 2.122(f) provides any adverse party with the right "to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." Thus, Rule 2.122(f) will allow the affidavit of Eric Miller to be considered as evidence only upon granting of motion. Petitioner has not filed, and the Board has not granted such motion. Accordingly, Exhibit 5 should not be considered by the Board and any purported facts that rely on said Exhibit 5 should be disregarded.

D. Petitioner's Motion Is Based On a Legal Theory of Acquiescence, Which Is an Affirmative Defense and Is Not Grounds for Cancellation

The argument upon which Petitioner's summary judgment motion is based, distilled to its essence, is that (1) a relationship exists between Baloru and Brooklyn Bottling such that Baloru is legally bound by Brooklyn Bottling's statements; (2) Brooklyn Bottling made a statement whereby it "assured" Petitioner that Petitioner could use the term "tropical" to market its products; and (3) therefore, Baloru can claim no trademark rights to the term TROPICAL.

This argument sounds in acquiescence. "The distinguishing feature of the acquiescence defense is the element of active or explicit consent to the use of an allegedly infringing mark." 6 McCarthy on Trademarks and Unfair Competition § 31:41 (4th ed.) (quoting SunAmerica Corp. v. Sun Life Assurance Co. of Can., 77 F.3d 1325, 38 U.S.P.Q.2d 1065, 1079 (11th Cir. 1996)). Acquiescence is an affirmative defense and is not grounds for opposition. Leatherwood Scopes International Inc. v. Leatherwood, 63 USPQ2d 1699, 1702 (TTAB 2002.) Affirmative defenses are not grounds for cancellation. (Wilentz Decl. Exhibit C, at page 4 (January, 20, 2011 Order, Cancellation Proceeding No. 92051242)). Affirmative defenses include "unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense." H.D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715, 1720 n. 16 (TTAB 2008) (citing Black's Law Dictionary and 2.106(b)(1)). Because Petitioner's motion is based on the assertion of a legally insufficient affirmative defense rather than a legal theory that could if proven serve as a basis for cancellation, the motion should be dismissed.

And Petitioner knows this very well. On July 20, 2009, Petitioner, by and through its present attorney Mr. Schindler, filed a petition to cancel Baloru's registered mark by

assignment, TROPICAL PURO SABOR NACIONAL, U.S. Registration No. 1474395 on the basis of laches and acquiescence. The Board dismissed such cancellation No. 92051242 by order dated January 20, 2011 holding that the affirmative defenses of laches and acquiescence “are not grounds for cancellation,” “failed to state a claim” for cancellation, and therefore “dismissal is appropriate.” Wilentz Decl. Exhibit C.

As attorney of record in that cancellation, Mr. Schindler was and is fully knowledgeable of the Board’s dismissal of Cancellation No. 92051242 and the reasons therefore. Yet, his legal arguments in the instant summary judgment motion on behalf of Petitioner are virtually identical to the arguments that were dismissed as failing to state a claim in Cancellation No. 92051242 in that they assert acquiescence as the basis for the relief sought by Petitioner.

E. **There Are Many Material Facts as to Which a Genuine Dispute Exists**

Paragraph 5 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute because Baloru in its Answer has denied that Brooklyn Bottling acts as a distributor for Baloru. Distributing soft drinks made from concentrate manufactured by Baloru is not the same as *acting as a distributor for* Baloru. Nowhere in Petitioner’s Exhibit 2 does Panagiota Betty Tufariello, Esq. state that Brooklyn Bottling “acts as a distributor” for Baloru. Furthermore, Petitioner’s Exhibit 2, cited as evidence to support the allegation that Brooklyn Bottling “acts as a distributor” for Baloru, is hearsay in that it is a statement made by a declarant offered by Petitioner herein to prove the truth of the matter asserted. Accordingly, Petitioner’s Exhibit 2 should be disregarded by the Board.

Paragraph 6 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute because Baloru in its answer has denied Petitioner’s

allegation, which is no more than a legal conclusion, that Brooklyn Bottling is a “related company” of Baloru.

Paragraph 7 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute because Baloru in its Answer has denied all of these allegations. Moreover, to the extent that Petitioner’s Exhibit 3 is offered as proof of the statement contained therein that Baloru possesses a family of marks based upon the term TROPICAL, such evidence is inadmissible as hearsay. Federal Rules of Evidence Rule 801. Petitioner has submitted its Exhibit 3 solely in an attempt to establish that Baloru owns a family of marks based on the term TROPICAL, as is clear from Petitioner’s reliance in its argument on the purported existence of such family of marks in order to support Petitioner’s claim (see Petitioner’s argument, page 6). Besides being hearsay, the letter written by the attorney for Brooklyn Bottling in connection with another case is not admissible as evidence under Trademark Rule 2.122, as it does not constitute an official record. In addition, Exhibit 3 and any evidence related to whether Baloru owns a family of marks based on the term TROPICAL is inadmissible as irrelevant, in that ownership of a family of marks has no bearing on whether Baloru can claim exclusive rights to the term TROPICAL or whether the term TROPICAL is descriptive of the goods identified in registration No. 4,120,917, which are the claims set forth in the Petition for Cancellation.

Paragraph 8 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute for the same reasons set forth above regarding Paragraph 7. Petitioner’s Exhibit 3 does not constitute an official record, is irrelevant to the issues contested in this proceeding, and furthermore, is inadmissible hearsay in that it is a

statement by a declarant offered to prove the truth of the matter asserted – namely, that Baloru owns a family of marks that includes registration No. 4,120,917.

Paragraph 9 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute for the same reasons as exist with respect to Petitioner’s asserted facts Nos.7 and 8. The Board should disregard Petitioner’s Exhibit 3 to Petitioner’s motion as hearsay and irrelevant and not otherwise admissible.

Paragraph 10 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” raises an issue that was not alleged in Petitioner’s Petition for Cancellation. Respondent declines to amend the pleadings to address such issue.

Paragraph 11 of Petitioner’s “Statement of Material Facts to Which No Genuine Dispute Exists” is in dispute because Baloru, in its Answer at Paragraph 12, has denied all of these allegations. Moreover, Exhibit 5 attached to Petitioner’s motion is inadmissible and should be given no consideration by the Board, as it is testimony from another proceeding and Petitioner failed to file a motion pursuant to Rule 2.122(f) requesting that the Board allow such testimony. Respondent has not been given the opportunity to recall or demand the recall for examination or cross-examination of Eric Miller and to rebut the testimony. Thus, Petitioner’s Exhibit 5 should be disregarded by the Board and any purported facts that rely on Exhibit 5 cannot be held undisputed.

In sum, Petitioner has failed to establish the existence of undisputed material facts that would allow the Board to grant Petitioner’s motion.

F. Baloru’s Pledged Affirmative Defenses, if Proven, Would Bar Petitioner From Seeking Relief.

Baloru, in its Answer served and filed June 14, 2012, has asserted the affirmative defenses of Estoppel, Waiver, Laches and Unclean Hands. At this point in the

proceedings, prior to the opening of Discovery, Baloru has not yet been able to take discovery in the form of interrogatories, requests for admissions, and discovery depositions in order to prove these affirmative defenses. It is simply too early in this proceeding for the Board to hold there is no genuine issue of material fact regarding Baloru's Affirmative Defenses, which are briefly set forth below.

(i) ESTOPPEL

Petitioner's claims are barred by the equitable doctrine of estoppel. Petitioner owns registration No. 2892511 for the mark TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR ECUATORIANO SODA DE FRESA and design, for "Soda, namely, carbonated soft drinks." During the prosecution of the application that led to this registration Petitioner failed to disclaim the term TROPICAL (Wilentz Decl., Exhibit G). Baloru relied on Petitioner's said failure to disclaim the term TROPICAL in likewise not disclaiming said term in the application that matured into the subject registration No. 4,120,917. Petitioner is therefore equitably estopped from demanding that Baloru be required to now disclaim the term TROPICAL or asserting that because Baloru failed to disclaim the term TROPICAL, Baloru's registration should be canceled.

(ii) WAIVER

Petitioner is barred by the equitable doctrine of waiver. Petitioner voluntarily failed to disclaim the word TROPICAL in its application that matured into registration No. 2892511 for the mark TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR ECUATORIANO SODA DE FRESA and design, for "Soda, namely, carbonated soft drinks" (Wilentz Decl., Exhibit G). By failing to

disclaim the word TROPICAL in its own application for soft drinks, Petitioner voluntarily relinquished its known right to object to any other party's failure to disclaim the word TROPICAL in a trademark application for soft drinks.

(iii) LACHES

Petitioner is barred by the equitable doctrine of laches. Baloru is the owner of Registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL, which has been registered for soft drinks since Jan. 26, 1988, and in said registration the word TROPICAL is not disclaimed. On July 20, 2009, Petitioner filed a petition to cancel said registration (Cancellation Proceeding No. 92051242), but Petitioner in its Petition For Cancellation in that proceeding did not base any of its claims on Baloru's failure to disclaim the word TROPICAL. Petitioner has known of Registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL for many years, as Petitioner and/or Petitioner's president, Francisco Cervantes, was previously a distributor of Baloru's TROPICAL PURO SABOR NACIONAL brand soft drinks (Wilentz Decl., Exhibit E), yet despite such long term knowledge of Registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL Petitioner never objected to the lack of disclaimer of the term TROPICAL. Baloru relied on Petitioner's long term lack of objection to the non-disclaimer of the term TROPICAL in Baloru's registration No. 1474395, and Baloru would be prejudiced if the instant petition to cancel is allowed to proceed based on the non-disclaimer of said term in the subject registration No. 4,120,917.

(iv) UNCLEAR HANDS

Petitioner is barred by the equitable doctrine of unclean hands. Petitioner and/or Petitioner's president Francisco Cervantes ("Cervantes"), who has long been familiar with the strength of Baloru's TROPICAL brand for soft drinks, was a distributor of Baloru's TROPICAL brand soft drink products in United States (Exhibit 1; Wilentz Decl., Exhibit E) until such time as Cervantes created Petitioner's mark and trade dress with the specific intent of confusing consumers into purchasing Petitioner's competing "TROPICAL" soft drinks and free-riding on Baloru's well-established reputation. Baloru will establish through discovery that Petitioner's business plan is in fact to mislead consumers by using a mark and/or trade dress that is confusingly similar to Baloru's famous mark and/or trade dress, and that this has been Petitioner's business plan since Petitioner first started selling soft drinks under Petitioner's purported mark that is the subject of Registration No. 2892511. These actions of Petitioner constitute unclean hands and Petitioner is thereby estopped from asserting its claims against Baloru.

G. Even if All the Purported Facts from Petitioner's "Statement of Material Facts to Which No Genuine Dispute Exists" Were Accepted as Undisputed Facts by the Board, Petitioner's Motion Must Still Fail

Petitioner's motion must fail because Petitioner has not set forth facts that would show Petitioner is entitled as a matter of law to the relief it seeks, namely for the Board to cancel Registration No. 4,120,917 or to require that Registration No. 4,120,917 be amended to include a disclaimer of the term TROPICAL.

Even if the Board were to accept the tortured reasoning that Petitioner asserts to find Baloru bound by statements made by Brooklyn Bottling, those statements do not bar Baloru from claiming trademark rights to the term TROPICAL in Registration No. 4,120,917 because Brooklyn Bottling never made any statement acknowledging it had no exclusive right to TROPICAL as a trademark for soft drinks. Petitioner alleges that

Brooklyn Bottling's president Eric Miller testified in Paragraph 8 of the Affidavit submitted as Exhibit 5 to Petitioner's motion that "Brooklyn Bottling is not claiming that Defendant cannot use the term "tropical" to market its product." This statement could mean simply that Ecuabeverage may use of the term "tropical" in advertising copy, for example "Ecuabeverage's drinks remind me of sitting on a tropical beach." Use of the term tropical "to market its product" is not equivalent to trademark use of the term, and Petitioner does not allege that Miller testified that Brooklyn Bottling does not object to Petitioner's use of TROPICAL as a trademark, nor does Petitioner allege that Miller testified that Brooklyn Bottling does not claim TROPICAL as a trademark that inures to the benefit of Baloru. In fact, if Petitioner's Exhibit 5 is taken into consideration by the Board even though Petitioner failed to make the requisite motion pursuant to Rule 2.122(f), then the Board must also note that Miller testified in the same affidavit at Paragraph 9 as follows:

"However, Brooklyn Bottling does have a problem with Defendant's use of the term "tropical" in such a way as to confuse and deceive consumers about the source of Brooklyn Bottling's product and Defendant's product."

In other words, if Petitioner's Exhibit 5 is considered by the Board, it establishes that Brooklyn Bottling, rather than giving Petitioner any "assurance," clearly objected to infringing trademark use of the term TROPICAL by Petitioner. Accordingly, despite Petitioner's attempt to paint a different picture, Brooklyn Bottling did not concede non-exclusivity of the term TROPICAL as a trademark for soft drinks. Brooklyn Bottling never stated that Ecuabeverage may use TROPICAL as a trademark for its products, and certainly never "assured" Ecuabeverage that Ecuabeverage could use the term

TROPICAL as a trademark. Thus, even if the Board accepts the contorted chain asserted by Petitioner to make Baloru bound by the statements of Brooklyn Bottling, such statements of Brooklyn Bottling cannot be held to bar Baloru from claiming trademark rights to the term TROPICAL in Registration No. 4,120,917, because such statements would not bar Brooklyn Bottling itself from claiming trademark rights to the term TROPICAL.

Moreover, even if the Board considers the hearsay evidence that Petitioner submitted in its Exhibit 3, Petitioner has not established that Baloru owns a family of marks. The existence of a family of marks requires more than mere ownership of the marks and more than merely asserting ownership of a family of marks. Petitioner's reliance on Baloru's ownership of a family of marks, which reliance is clearly demonstrated on page 6 of Petitioner's motion, raises an issue of fact for which Petitioner has submitted no evidence.

Whether a family of marks exists is a question of fact based on the family formative's distinctiveness, and the nature of the use, advertising and promotion in which the alleged family marks appear. Relevant to this enquiry is the extent to which the proponent of the family has used joint advertising and promotion of the family in a manner designed to create an association of common origin for all marks containing the family formative or "surname."

4 McCarthy on Trademarks and Unfair Competition § 23:61 (4th ed.).

In order to establish a "family of marks," it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

American Standard, Inc. v. Scott & Fetzer Co., 200 U.S.P.Q. 457, 461 (T.T.A.B.

1978). Moreover, not only does Petitioner rely on the existence of a family of marks, but

on Brooklyn Bottling's "usages" of said "family of TROPICAL trademarks" (see Petitioner's motion, page 6). Petitioner has submitted no evidence establishing Brooklyn Bottling's "usages" of the purported "family." Therefore, Brooklyn Bottling's "usages" of the "family" is yet another fact issue as to which there is a genuine dispute.

None of Petitioner's so-called undisputed material facts, nor the sum total of them, would establish as a matter of law that the term TROPICAL is merely descriptive for the goods identified in Baloru's Registration No. 4,120,917 or that Baloru can claim no exclusive right to the term TROPICAL. Thus, even if the Board accepts as proven all the so-called "facts" set forth in Petitioner's "Statement of Material Facts to Which No Genuine Dispute Exists," there still is no ground for granting Petitioner's motion.

H. Baloru Cannot be Bound by the Statements of Brooklyn Bottling

Petitioner asserts that Baloru's rights to Registration No. 4,120,917 are subject to the liabilities of Brooklyn Bottling because Brooklyn Bottling assigned trademark Registration No. 1,474,395 for the mark TROPICAL PURO SABOR NACIONAL to Baloru. Petitioner asserts that as an assignee of the registered mark "TROPICAL PURO SABOR NACIONAL" Baloru "stands in the shoes" of Brooklyn Bottling. Petitioner ignores the inconvenient fact that Brooklyn Bottling did not assign the mark that is the subject of Registration No. 4,120,917 to Baloru, nor has Baloru ever assigned its rights in said mark to any other party. (Wilentz Decl., Exhibit F). The mark TROPICAL PURO SABOR NACIONAL that is the subject of Registration No. 1,474,395 is not the same trademark as the mark TROPICAL & design that is the subject of Registration No. 4,120,917, and thus the assignment of registration No. 1,474,395 from Brooklyn Bottling to Baloru can have no effect on Baloru's rights to the mark TROPICAL & Design that is

the subject of registration No. 4,120,917. An assignee cannot be charged with the liabilities of its assignor with regard to the assignee's property that was never owned by the assignor and was not part of the assignment. Accordingly, Baloru's position as assignee of Registration No. 1,474,395 for the mark TROPICAL PURO SABOR NACIONAL has no effect whatsoever on the rights Baloru can claim to the mark TROPICAL & design that is the subject of Registration No. 4,120,917.

I. Petitioner Has Not Established That Brooklyn Bottling and Baloru are Related Companies or Why it Would Matter if They Were

Petitioner has asserted as a fact the legal conclusion that Brooklyn Bottling is a "related company" of Baloru under §5 of the Trademark Act, 15 U.S.C. § 1055, yet Petitioner has failed to set forth the basis for this assertion. Moreover, even if the Board were to hold that Baloru and Brooklyn Bottling are related companies, Petitioner has failed to explain the legal theory by which Baloru would be bound by the statements of its "related" company. Petitioner has cited no authority establishing that "related" companies are bound by each other's statements. Accordingly, Petitioner has failed to show that Brooklyn Bottling is a related company of Baloru, or why the legal status of being a related company would be relevant to Petitioner's case.

J. The December 22, 2009 Affidavit of Eric Miller Does Not Waive Baloru's Right to Claim Exclusive Rights to the Term TROPICAL

Paragraph 8 of Eric Miller's purported December 22, 2009 affidavit submitted by Petitioner as Exhibit 5 to the summary judgment motion does not say that Brooklyn Bottling makes no claim to exclusive right to the term "Tropical." Rather, Petitioner's Exhibit 5 shows that Brooklyn Bottling objected to Ecuabeverage's infringing use of the term "TROPICAL" as a trademark, as in Paragraph 9 it clearly states that Brooklyn

Bottling objects to Ecuabeverage's use of the term TROPICAL in such a way as to confuse and deceive consumers about the source of the goods:

“However, Brooklyn Bottling does have a problem with Defendant’s use of the term “tropical” in such a way as to confuse and deceive consumers about the source of Brooklyn Bottling’s product and Defendant’s product.”

(Petitioner’s Exhibit 5, Paragraph 9).

Because Brooklyn Bottling, in Paragraph 9 of Petitioner’s Exhibit 5, clearly states its objection to infringing trademark use of the term TROPICAL by Petitioner, Petitioner’s Exhibit 5 cannot be viewed as evidence supporting Petitioner’s claim that Brooklyn Bottling gave Petitioner any “assurance” it could use TROPICAL as a trademark, and certainly cannot serve as the basis for a grant of summary judgment in Petitioner’s favor. Brooklyn Bottling simply did not concede non-exclusivity of the term TROPICAL as a trademark for soft drinks in Eric Miller’s Affidavit submitted as Petitioner’s Exhibit 5. Moreover, the civil proceeding in which said Affidavit was filed has been dismissed without prejudice.

Accordingly, rather than grant Petitioner’s motion for summary judgment, the Board should grant summary judgment against Petitioner, as Petitioner has offered no proof nor made any allegation in the Petition for Cancellation that TROPICAL is descriptive of the goods identified in the subject registration No. 4,120,917, nor has Petitioner made any allegations or offered any proof that would support a finding that Baloru can make no claim to exclusive right to the term TROPICAL for the goods identified in the subject registration No. 4,120,917. *Visa International Service Association v. Life-Code Systems, Inc.*, 220 U.S.P.Q. 740, 1983 WL 54211 (T.T.A.B.

1983); Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 U.S.P.Q. 909, 1984 WL 63595 (T.T.A.B. 1984).

II. Respondent's Cross Motion for Dismissal Pursuant to Rule 12(b)(6)

In order to establish standing, the petition to cancel must include a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration. 37 CFR § 2.112. The petitioner, at the pleading stage, must allege facts sufficient to show a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. TBMP §309.03(b); Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Mere conclusory allegations of damage do not satisfy this requirement. Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 545 (2007) ("a plaintiff's obligation to provide the 'grounds' of his entitle[ment] to relief" requires more than labels and conclusions, and a formulaic recitation of the elements.... Factual allegations must be enough to raise a right to relief above the speculative level on the assumption that all of the complaint's allegations are true.") (internal citations omitted). If Petitioner does not plead facts sufficient to show a personal interest in the outcome beyond that of the general public, the case may be dismissed for failure to state a claim. Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Here, Petitioner's petition does not include any short and plain statement showing why the Petitioner believes it would be damaged by the continued registration of Baloru's mark, and further, fails to allege any facts sufficient to show a "reasonable basis" for its belief that it would suffer some kind of damage as a result of the continued registration of Baloru's mark. Notably, Petitioner has failed to allege Baloru's mark gives rise to a likelihood of confusion with any of Petitioner's marks. Petitioner, in

cancellation proceeding No. 92051197 has denied that there is any likelihood of confusion between Baloru's TROPICAL PURO SABOR NACIONAL mark and Petitioner's mark TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR ECUATORIANO SODA DE FRESA that is the subject of registration No. 2892511, in which every word except TOME TROPICAL is disclaimed. Petitioner has also failed in the Petition for Cancellation to provide notice of any legal proceedings between the parties or between Petitioner and Brooklyn Bottling pertaining to Petitioner's use of the term TROPICAL to market Petitioner's goods. Thus, although Petitioner has made a formulaic recitation of the element of standing in the conclusory allegation in Paragraph 10 of the Petition for Cancellation that Petitioner would be "damaged" by continued registration of Baloru's mark, Petitioner has utterly failed to allege any facts showing why Petitioner would be damaged thereby. Furthermore, Petitioner has also failed in the present motion for Summary Judgment to assert a single fact or put forth any argument showing how continued registration of Baloru's mark would damage Petitioner.

Accordingly, the Board should dismiss the instant Petition for Cancellation for lack of standing as Petitioner has failed to allege any facts that would establish a reasonable basis for Petitioner's allegation that Petitioner would be damaged by the continued registration of Baloru's mark that is the subject of Registration No. 4,120,917.

III. Respondent's Cross Motion for Sanctions

The Board has the authority to enter sanctions up to and including entry of judgment under Rule 11 of the Federal Rules of Civil Procedure or under the Board's inherent authority to sanction. 37 CFR § 2.116(a); TBMP §527.02; TBMP §527.03;

Central Mfg. Inc. v. Third Millenium Technology, Inc., 61 USPQ2d 1210 (TTAB 2001).

A predominant purpose for entering sanctions is to prevent further wrongdoing. Id.

Here, Petitioner's attorney filed a petition to cancel Baloru's registered mark TROPICAL PURO SABOR NACIONAL, registration No. 1474395 on July 20, 2009, alleging laches and acquiescence. (Wilentz Decl. Exhibits A & C). The Board dismissed said cancellation No. 92051242 by order dated January 20, 2011 because the asserted grounds were the affirmative defenses of laches and acquiescence, clearly stating in its order that "affirmative defenses are not grounds for cancellation." (Wilentz Decl. Exhibit C).

Petitioner's argument in the instant summary judgment motion is that Brooklyn Bottling previously stated it does not have a problem with Petitioner's use of the term "tropical" to market Petitioner's products and Baloru is bound by Brooklyn Bottling's statement. Although cloaked as a claim based on a failure to disclaim the term TROPICAL, Petitioner's argument boils down to an assertion of acquiescence, which is an affirmative defense. Because Petitioner's attorney already was put on notice by the Board in its order of January 20, 2011 that affirmative defenses - and specifically acquiescence - are not grounds for cancellation, the instant summary judgment motion, in which Petitioner seeks cancellation of Baloru's registration on a legal theory of acquiescence, amounts to an abuse of process. Petitioner's summary judgment motion was clearly filed in bad faith and for improper purposes, namely, to harass Baloru and to waste the resources of Baloru and of the Board. It is within the Board's discretion to sanction counsel for the filing of an untenable or meritless motion, whether or not a

formal motion for sanctions has been filed. Schering-Plough Animal Health Corporation v. Aqua Gen AS, 90 USPQ2d 1184 (TTAB 2009).

In considering what sanction may be appropriate, Baloru wishes to alert the Board that Petitioner has followed the same course of conduct with regard to the currently pending cancellation proceeding No. 92055519 in which Petitioner filed its initial disclosures prior to the opening of discovery, prior to the holding of the discovery conference, and has moved for summary judgment, as plaintiff, on a legal theory of acquiescence cloaked as a claim based on a failure to disclaim the term TROPICAL.

Accordingly, Respondent requests that the Board sanction Petitioner's attorney appropriately to prevent further abuses of process, harassment of Baloru and waste of Baloru's and the Board's resources.

Conclusion

For the reasons set forth above, Baloru respectfully requests that Petitioner's motion for summary judgment be denied, Baloru's cross motions for dismissal and sanctions be granted, and such other relief as may be just and proper.

Respectfully submitted,

THOMAS M. WILENTZ,
ATTORNEY AT LAW, PLLC
Attorney for Respondent

Dated: Scarsdale, New York
July 23, 2012

By 
Thomas M. Wilentz
75 South Broadway, 4th Floor
White Plains, NY 10601
(914) 723-0394

EXHIBIT 1



COLAS Y COLAS S. A.



Km. 7 1/2 Via Daule - Telef. Conm. 253844 - 250891 - Fax 253551 - Casilla 09-01-3900
Guayaquil - Ecuador

FACTURA: 001/99

FECHA: 07/20/99

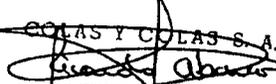
CONSIGNADO: OVIDIO CERVANTES
541 BARRETO STREET
BRONX NEW YORK 10474
TROPICAL INTERNATIONAL Co.

VIA: MARITIMO

CANTIDAD	DESCRIPCION (BEBIDAS GASEOSAS)	PRECIO UNITARIO (\$ C/CAJA)	TOTAL (\$)
PAQ. 2 LITROS PET			
1800 CAJAS	TROPICAL	2.30	4,140.00
1000 CAJAS	MANZANA	2.30	2,300.00
200 CAJAS	CRUSH	2.30	460.00
3000 CAJAS	TOTAL FOB ==>		6,900.00
CARTONES 24 BOTELLAS VIDRIO			
460 CAJAS	TROPICAL	2.30	1,058.00
240 CAJAS	MANZANA	2.30	552.00
100 CAJAS	CRUSH	2.30	230.00
800 CAJAS	TOTAL FOB ==>		1,840.00
TOTAL GENERAL FOB ==>			8,740.00

2 CONTENEDORES DE 40'	
PESO NETO:	46.780 KILOS
PESO BRUTO:	48.000 KILO

F.U.E. #708896

~~COLAS Y COLAS S.A.~~

 FIRMA AUTORIZADA
 COLAS & COLAS S.A.

BANCO CENTRAL DEL ECUADOR

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Guayaquil, 7 - ABR. 2000 Copia no negociable.

(E) Abel Villa S.

RESPONSABLE DEL ARCHIVO GENERAL Y MICROFILM

000041

**VENTANILLA UNICA DE EXPORTACIONES
BANCO CENTRAL DEL ECUADOR**

1) ORIGINAL: Cedula No. 1	4) RUC: 51251211341710011	7) PAIS DESTINO: USA	11) FORMAS DE PAGO: A Plazo (44 días)	25) FECHA DE CADUCIDAD:
2) NOMBRE Y DIRECCION DEL EXPORTADOR: SOLICITUD DE EXPORTACION S.A. CALLE: 745 Vía Lealle TELEF.: 25775 Fax: 25793	5) FACTURA COMERCIAL N°: FE-002-2001	8) VIA TRANSPORTE: MARITIMA	12) N° DAFE	N° DAFE
3) NOMBRE Y DIRECCION DEL COMPRADOR: BANK OF AMERICA CORP. 341 Braroto St. Box 10474 ALEX: 715-30-3225 Fax: 715-30-3242	6) TIPO DE EXPORTACION: GEN. EXP.	9) PUERTO EMBARQUE: GUAYAQUIL	FECHA: 17-04-01	DECLARACION N°: 110643
14) SUBPARTIDA N°: 2224.00.00	15) PESO NETO KILOS: 11.900	16) TOTAL UNIDADES: 1.340 Cajas	17) VALOR FOB: US\$ 5.125,34	IMPUESTO
13) DESCRIPCION COMERCIAL DE LA MERCADERIA: Cafes - lechidos descafeinados	18) DEDUCCIONES:	19) TOTAL: 11.900 K	20) MONEDA: DOLAR AMERICANO	TARIFA
20) OBSERVACIONES:	21) AUTORIZACIONES ESPECIALES: 117	22) TOTAL EXPORTADO: 11.900 K	23) VALOR FOB: 5.125,34	IMPUESTO

21) DECLARAMOS QUE LOS PRECIOS INDICADOS SON LOS ACTUALMENTE VIGENTES EN EL MERCADO INTERNACIONAL DE EXPORTACIONES DEL ECUADOR. VENDER EN LAS DIVISAS CORRESPONDIENTES AL VALOR REAL DE LA EXPORTACION EFECTUADA AL AMPARO DE ESTE FORMULARIO UNICO DE EXPORTACION DENTRO DEL PLAZO ESTABLECIDO POR LA JUNTA MONETARIA Y DE CONFORMIDAD CON EL AFORO REALIZADO POR LA ADUANA Y LAS COMPROBACIONES QUE EFECTUE EL BANCO CENTRAL DEL ECUADOR.	22) BANCO CENTRAL DEL ECUADOR VENTANILLA UNICA DE EXPORTACIONES	23) AFORO PRESERCIADO POR: EFCANBANCO S. A.	24) FECHA DE CONCESION: 17 APR 2001
Nombre: OSCAR E. UGALDE VERA Cédula N°: 13224353-2	Nombre: JAMES AVILES VILLIN Cédula N°: 2821528473	25) FECHA DE CADUCIDAD:	26) MONEDA:
27) PRODUCTOR DE CAFEEXPORT S. A. Cecar Euzgen Vera FINANZA IMPORTADORA	28) FIRMA AUTORIZADA DEL EXPORTADOR	29) VALOR	30) RECIBO
29) BANCO CENTRAL DEL ECUADOR	31) VALOR	32) RECIBO	33) RECIBO

000042

15/10

RESPONSABLE DEL ARCHIVO GENERAL Y MICROFILM

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Certificamos que es fiel copia del documento

Doc. No. BANCO CENTRAL DEL ECUADOR

Valor

Fecha

RECIBO

PRODUCTORA DE GASEOSAS S.A.

PROGASEOSAS

RUC: 0992134178001

Km. 7 1/2 Via Daule

Telefono: 593-4-257794 - 593-4-257797

Fax : 593-4257793

Guayaquil, Ecuador

ORIGINAL

FACTURA DE EXPORTACION
FE-002-2001

Para: : ECUABEVERAGE CORP. Puerto de Embarque : Guayaquil - Ecuador
 541 Barreto St. Bronx N.Y. 10474
 New York - New York
 Telefono: 718 - 8603256 Puerto de Descarga : New York
 Fax : 718 - 8603248

Pais de Origen : Ecuador Lugar de Destino : New York

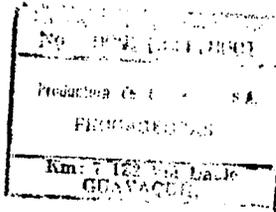
MARCAS MARCK	CANTIDAD QUANTITY	CLASE CLASS	DESCRIPCION DESCRIPTION	VALOR UNITARIO	VALOR TOTAL
Topical	300	Cajas	Cola Tropical 2000cc. PET x 6	\$4.857	\$1,457.14
Manzana	300	Cajas	Cola Manzana 2000cc. PET x 6	\$4.857	\$1,457.13
Crush	100	Cajas	Cola Crush 2000cc. PET x 6	\$4.857	\$485.71
Topical	20	Cajas	Cola Tropical 250cc. PET x 15	\$3.277	\$65.54
Manzana	20	Cajas	Cola Manzana 250cc. PET x 15	\$3.277	\$65.54
Topical	200	Cajas	Cola Tropical Twist Off. x 12	\$2.657	\$531.42
Manzana	200	Cajas	Cola Manzana Twist Off. x 12	\$2.657	\$531.42
Crush	200	Cajas	Cola Crush Twist Off. x 12	\$2.657	\$531.42

TOTAL FOB GUAYAQUIL

\$5,125.34

SON: Cinco Mil ciento veinticinco, 34/100 Dolares Americanos

TOTAL CAJAS : 1,340 CAJAS
 PESO NETO : 11.900 Kls.
 PESO BRUTO : 12.500 KIS.
 P. A. : 2202.10.00.00
 F.U.E. : 0964038



Guayaquil, 16 de Abril del 2001

BANCO CENTRAL DEL ECUADOR

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(e) Abel Vilotta S.

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000043



Compañía Chilena de Navegación
Interoceánica S. A.

BILL OF LADING: COPY

SHIPPER'S NAME PRODUCTORA DE GASEOSAS S.A. KM 7 1/2 VIA DAULE GUAYAQUIL-ECUADOR	MRGBL-0001	ECGYE07522
CONSIGNEE ECUABEVERAGE CORP. 541 BARRETO ST. BRONX, NY 10474 NEW YORK	EXPIRE REFERENCE	
NOTIFY PARTY THE SAME	FORWARDING AGENT REFERENCE	
ALSO NOTIFY ROUTING AND INSTRUCTIONS		

PRE-CARRIAGE BY	PLACE OF RECEIPT GUAYAQUIL	PORT OF DISCHARGE NEW YORK, NY	FINAL DESTINATION (for the Shipper's use only)
OCEAN VESSEL NO. CROWLEY LION 0012NB	PORT OF LOADING GUAYAQUIL	PLACE OF DELIVERY NEW YORK, NY	TYPE OF MOVE FCL/FCL

MARKS & Nos. CONTAINER & SEAL Nos.	No. OF PKGS	DESCRIPTION OF PACKAGES AND GOODS	GROSS WEIGHT	MEASUREMENT
CIU 111536-4 20FT SN# 410945 CY/CY	1	CONTAINER DV 20' SAID TO CONTAIN 1.340 CAJAS DE COLA TROPICAL, MANZANA, CRUSH 11.900 KN TUE: 0954038 FREIGHT COLLECT SHIPPER'S LOAD STOW AND COUNT	GROSS (KG) VOLUME (M3) 12,500.00 20.000	

COPY NON NEGOTIABLE

FREIGHT RATING AND CHARGES	RATES	PER	PREPAID	COLLECT
OCEAN FREIGHT	1,700.00	PER PA		1,700.00USD
BUNKER SURCHARGE	155.00	PER PA		155.00USD
DOCUMENTATION FEE	50.00	PER BL		50.00USD
EXTRA CHARGE H/C	120.00	PER PA		120.00USD
CHASSIS USAGE CHARGE	60.00	PER PA		60.00USD
TOTALS				2,085.00USD



[Signature]

RECEIVED ON BOARD

SHIPPER'S DECLARED VALUE	EX-RATE	FREIGHT PAYABLE AT	IN LOCAL CURRENCY
		NEW YORK, NY	

Per Compañía Chilena de Navegación Interoceánica S. A.

LADEN ON BOARD DATE: GUAYAQUIL PLACE: ABR-29-2001 MONTH DAY YEAR

Received in apparent good order and condition from the Shipper or Shipper's agent, the number of containers or other packages or units said by the Shipper to contain the goods described in the Particulars Furnished by Shipper, to be transported from the port of loading to the port of discharge, or to new stevedores as the carrying vessel, or other craft used can get, be and have always in safety and about under all conditions of tide, water and weather, and there to be delivered to consignee or on carrier on payment of all charges due thereon. Carrier makes no representation as to the correctness of the particulars furnished by the Shipper. In accepting this Bill of Lading, the Shipper, consignee, holder hereof and the owners of the goods agree, the same as if signed by each of them, that the receipt, custody, carriage, relay, delivery and any transhipping of the goods are subject to the terms appearing on the face and back hereof which shall govern the relations, whatsoever they may be, between Shipper, consignee, the owner of the goods and any holder hereof and Carrier, its agents, contractors, employees, Master and vessel in every contingency occurring and whether it arise in such or bulk. Carrier shall have the right to stow, secure, lash or trailer on deck and without notice as per Clause 11. The terms hereof shall not be deemed waived by Carrier except by written waiver signed by Carrier or its duly authorized agent.

If this box is checked, goods have been loaded, stowed and counted by Shipper. Carrier has NOT done so and is not responsible for accuracy of count, condition or nature of goods described in PARTICULARS FURNISHED BY SHIPPER. THE RECEIPT, CUSTODY, CARRIAGE AND DELIVERY OF THE GOODS ARE SUBJECT TO THE TERMS APPEARING ON THE FACE AND BACK HEREOF AND TO THE CARRIER'S APPLICABLE TARIFF.

In witness whereof original Bills of Lading all the same and due one of which being accomplished the others to stand void, have been issued by Compañía Chilena de Navegación Interoceánica S.A. or its designated agent on behalf of itself, other participating carriers, the vessel, her Master, owners or charterers.

Form CCNI 105

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(e) Abel V. de H. S.
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000044

SHIPPER'S NAME AND ADDRESS: KM.7 1/2 VIA DAULE TELF:253844 FAX:253551 GUAYAQUIL-ECUADOR		BOOKING NBR	SERVICE	BL NUMBER CHI27A005507
CONSIGNEE'S NAME AND ADDRESS: 541 BARRETO STREET BRONX NEW YORK 10474 TROPICAL INTERNATIONAL CO.		EXPORT REFERENCES		
NOTIFY NAME AND FULL ADDRESS: SAME		FORWARDING AGENT'S NAME AND ADDRESS: "The shipper, consignee, owner of the cargo, bill of lading or other party in possession of the bill of lading or improperly described cargo will be held liable and that they are in compliance with the terms of the United States custom carrier liability agreement", and that the shipper, consignee, owner of the cargo, bill of lading or other party in possession of the bill of lading or improperly described cargo, including but not limited to drugs.		
PRECARRIAGE BY (Mode) (*)	PLACE OF RECEIPT BY PRECARRIER (*)	POINT AND COUNTRY OF ORIGIN OF GOODS		
GUAYAQUIL, ECUADOR	CONT. CHITOE TOY:0007NB	DOMESTIC ROUTING / EXPORT INSTRUCTIONS / ONWARD INLAND ROUTING		
PLACE OF DELIVERY BY ONCARRIER (*)				
NEW YORK USA/NEW YORK-USA				

PARTICULARS FURNISHED BY SHIPPER - CARRIER NOT RESPONSIBLE

MARKS AND NUMBERS	NO OF PKGS./CNTRS.	DESCRIPTION OF PACKAGES AND GOODS	GROSS WEIGHT	MEASUREMENT
CSVU4500305 /SEAL 00035596 1.833 CAJAS /24.000 KB	2	CONTAINERS DV40 SAID TO CONTAIN 1800 CAJAS TROPICAL ZLT.PET. 33 CAJAS MANZANA ZLT.PET.	46.780.00 KN 48.000.00 KB	
ICSU1842407 /SEAL 00035537 1.967 CAJAS /24.000 KB		460 CAJAS TROPICAL CC TOFF 240 CAJAS MANZANA CC TOFF 967 CAJAS MANZANA ZLT (88) 100 CAJAS CRUSH CC TOFF 290 CAJAS CRUSH 2 LT.PET. FUE: 708896		

Copy Not Negotiable

'CARGO CONTAINER WEIGHT CERTIFIED BY SHIPPER'

STUFFED IN CONTAINER CY/CY 'SLAC' (SHIPPER'S LOAD AND COUNT) FREIGHT COLLECT

ANY PROVISION HEREIN TO THE CONTRARY BE IT BY WHATEVER NAME, CONTRACT MAY BE RECEIVED, SHALL BE VOID BY CARRIER AT SHIP'S TACKLE AND RECEIPT AND DELIVERY BY WHATEVER SHIP'S TACKLE SHALL BE VOID BY AT THE OPTION OF THE CARRIER AND DELIVERY AT THE EXPENSE OF THE SHIPPER OR CONSIGNEE.

SHIPPER'S DECLARED VALUE \$ (IF NOT DECLARED, LIABILITY LIMIT APPLIES AS PER CLAUSE 16.):

TOTAL No. OF CONTAINERS OR PACKAGES RECEIVED BY THE CARRIER:

The number of containers or packages shown in the "TOTAL No. OF CONTAINERS OR PACKAGES RECEIVED BY THE CARRIER" box which are said by the Shipper to hold or consolidate the Goods described in the "PARTICULARS FURNISHED BY SHIPPER - CARRIER NOT RESPONSIBLE" box, have been received by COMPANIA SUD AMERICANA DE VAPORES S.A. from the Shipper in apparent good order and condition except as otherwise indicated hereon - weight, measure, marks, numbers, quality, quantity, description, contents and value unknown - for Carriage from the Place of Receipt or the Port of Loading (whichever is applicable) to the Port of Discharge or the Place of Delivery (whichever is applicable) on the terms and conditions hereof INCLUDING THE TERMS AND CONDITIONS ON THE REVERSE SIDE HEREOF, THE CARRIER'S APPLICABLE TARIFF AND THE TERMS AND CONDITIONS OF THE PRECARRIER AND ONCARRIER AS APPLICABLE IN ACCORDANCE WITH THE TERMS AND CONDITIONS ON THE REVERSE SIDE HEREOF.

FREIGHT CHARGES	RATE	PREPAID	COLLECT	PAYABLE AT
FREIGHT AS AGREED *****				

IN WITNESS WHEREOF THREE (3) ORIGINAL BILLS OF LADING (unless otherwise stated above) HAVE BEEN SIGNED ALL OF THE SAME TENOR AND DATE, ONE OF WHICH BEING ACCOMPLISHED THE OTHERS TO STAND VOID.

COMPANIA SUD AMERICANA DE VAPORES S.A.
RECEIVED ON BOARD



TOTAL

Place issued: **GUAYAQUIL, ECUADOR, Jul 22, 1999**

Date issued: **GUAYAQUIL, ECUADOR, Jul 22, 1999**

VERSION 12/1997

(*) Applicable only when used as intermodal Bill of Lading (see clause 10 on the reverse hereof)

000040

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Guayaquil 2 - ABR 2009 Copia no Negociable.
(c) Abel Cillo Ka S.
RESPONSABLE DEL ARCHIVO GENERAL Y MICROFILM

CERTIFICATE OF SERVICE

I hereby certify that I have this date served counsel for all parties to this action with a copy of the foregoing **Respondent's Opposition to Petitioner's Motion for Summary Judgment and Cross Motion for Dismissal and Sanctions** (including Exhibit 1) by depositing the same by first-class mail in an envelope addressed to:

EDWIN D. SCHINDLER
EDWIN D. SCHINDLER, PATENT ATTORNEY
4 HIGH OAKS COURT P. O. BOX 4259
HUNTINGTON, NY 11743-0777

Scarsdale, New York
July 23, 2012

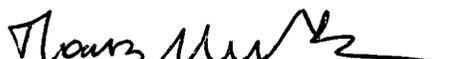

Thomas M. Wilentz

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on July 23, 2012


Signature

Thomas M. Wilentz

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

ECUABEVERAGE CORPORATION,

Petitioner,

-v-

BALORU S.A.,

Respondent

Cancellation No.
92055569

DECLARATION OF THOMAS M. WILENTZ

Thomas M. Wilentz hereby declares:

1. I am the attorney representing Respondent Baloru S.A. (Respondent) in this Cancellation Proceeding, No. 92055569.
2. I submit this declaration in support of Respondent's OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT AND CROSS MOTION FOR DISMISSAL AND SANCTIONS solely for the purpose of authenticating certain documents attached as exhibits to this declaration.
3. Attached as Exhibit A is a copy of Petitioner Ecuabeverage Corporation's PETITION FOR CANCELLATION of Respondent's registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL, filed July 20, 2009 (Cancellation No. 92051242), retrieved June 12, 2012 from the TTAB's web site at <http://ttabvue.uspto.gov/ttabvue/>.

4. Attached as Exhibit B are copies of pages retrieved June 12, 2012 from the USPTO web site at uspto.gov, showing the current status and title of Respondent's registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL.

5. Attached as Exhibit C is a copy of the Board's January 20, 2011 order dismissing Petitioner Ecuabeverage Corporation's PETITION FOR CANCELLATION of Respondent's registration No. 1474395 for the mark TROPICAL PURO SABOR NACIONAL (Cancellation No. 92051242), retrieved June 12, 2012 from the TTAB's web site at <http://ttabvue.uspto.gov/ttabvue/>.

6. Attached as Exhibit D is a copy of the Board's May 1, 2012 order substituting Baloru S.A. for Royal Signature as party plaintiff in Cancellation No. 92051197 and substituting Baloru S.A for Brooklyn Bottling of Milton, N.Y., Inc. as party defendant in Cancellation No. 92051242, retrieved June 12, 2012 from the TTAB's web site at <http://ttabvue.uspto.gov/ttabvue/>.

7. Attached hereto as Exhibit E is the Declaration of Carlos Tama in support of Respondent's Response to Petitioner's Motion for Summary Judgment.

8. Attached hereto as Exhibit F are excerpts from the file wrapper of Respondent's Registration No. 4120917 printed from the uspto.gov web site.

9. Attached hereto as Exhibit G are excerpts from the file wrapper of Petitioner's Registration No. 2892511 printed from the uspto.gov web site.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or

any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Dated: Scarsdale, New York

July 23, 2012

A handwritten signature in black ink, appearing to read 'Thomas M. Wilentz', written over a horizontal line.

THOMAS M. WILENTZ

EXHIBIT-A

ESTTA Tracking number: **ESTTA296329**

Filing date: **07/20/2009**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Ecuabeverage Corporation		
Entity	Corporation	Citizenship	New York
Address	1240 Randall Avenue Bronx, NY 10474 UNITED STATES		

Attorney information	Edwin D. Schindler Edwin D. Schindler, Patent Attorney Five Hirsch Avenue, P. O. Box 966 Coram, NY 11727-0966 UNITED STATES EDSchindler@att.net, EdwinSchindler@gmail.com, EdwinSchindler@yahoo.com, jeffrey@thefirm.com, bruce@thefirm.com, tmlaw@dineff.com Phone:(631)474-5373
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Registration Subject to Cancellation

Registration No	1474395	Registration date	01/26/1988
Registrant	BROOKLYN BOTTLING OF MILTON, NY, INC. 1900 LINDEN BLVD. BROOKLYN, NY 11207 UNITED STATES		

Goods/Services Subject to Cancellation

Class 032. First Use: 1966/04/19 First Use In Commerce: 1966/04/19 All goods and services in the class are cancelled, namely: SOFT DRINKS AND FLAVORED SYRUPS USED IN THE PREPARATION OF MAKING SOFT DRINKS
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Grounds for Cancellation

Abandonment	Trademark Act section 14
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Related Proceedings	PTO Cancellation Proceeding 92051197, filed July 3, 2009; and Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation, Civil Action No. 07-CV-08483-AKH (S.D.N.Y 2007)
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Attachments	Ecuabeverage's Petition for Cancellation re Tmk. Reg. 1,474,395 (7-20-2009).PDF (26 pages)(1568706 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Edwin D. Schindler/
Name	Edwin D. Schindler
Date	07/20/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of: Trademark Registration No. 1,474,395

For the Trademark: "TROPICAL PURO SABOR NACIONAL" (Int. Class 32)

Registered: January 26, 1988

ECUABEVERAGE CORPORATION,	:	
	:	Cancellation No. _____
Petitioner,	:	
	:	
v.	:	
	:	
ROYAL SIGNATURE INC. and	:	
BROOKLYN BOTTLING OF MILTON,	:	
NEW YORK, INC.	:	
	:	
Joint Respondents.	:	

PETITION FOR CANCELLATION

The Parties

1. Petitioner Ecuabeverage Corporation ("Ecuabeverage") is a corporation organized and existing under the laws of the State of New York, having its principal place of business at 1240 Randall Avenue, Bronx, New York 10474.

2. Upon information and belief, Joint Respondent Royal Signature Inc. ("RSI") is a corporation organized and existing under the laws of the country of Panama, having its principal place of business at Avenida Balboa, Centro Comercial Plaza Paitilla, Oficina 61 A, Primer Alto, Panama, Panama.

3. Upon information and belief, Joint Respondent Brooklyn Bottling of Milton, New York, Inc. (“Brooklyn Bottling”) is a corporation organized and existing under the laws of the State of New York, having its principal place of business at 143 S Road, Milton, New York 12547.

Parties’ Trademark Registrations and Ongoing Concurrent Proceedings

4. Ecuabeverage is being damaged, and will continue to be damaged, by the continued registration of U.S. Trademark Registration No. 1,474,395, issued January 26, 1988, for the mark “TROPICAL PURO SABOR NACIONAL,” which recites goods in International Class 32 as “SOFT DRINKS AND FLAVORED SYRUPS USED IN THE PREPARATION OF MAKING SOFT DRINKS.” (“Exhibit 1”)

5. On October 1, 2007, Brooklyn Bottling filed a trademark infringement action in the United States District Court for the Southern District of New York entitled Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation, Civil Action No. 07-CV-08483-AKH, alleging violations of rights attendant U.S. Trademark Reg. No. 1,474,395.

6. At the time that Brooklyn Bottling commenced the federal civil action in the Southern District of New York, RSI – not Brooklyn Botting – owned the entire right, title and interest in, and to, U.S. Trademark Reg. No. 1,474,395.

7. Upon information and belief, on, or about, February 11, 2008, RSI assigned its entire ownership in, and to, U.S. Trademark Reg. No. 1,474,395 to Brooklyn Botting, so

that Brooklyn Bottling could establish its standing to assert claims dependent upon ownership of U.S. Trademark Reg. No. 1,474,395.

8. RSI is not, nor has RSI ever been, a party to the civil action pending in the United States District Court for the Southern District of New York.

9. The civil action of Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation, Civil Action No. 07-CV-08483-AKH, remains pending as of the date of filing of this *Petition for Cancellation*.

10. On June 30, 2009, Brooklyn Bottling assigned a “security interest” in U.S. Trademark Reg. No. 1,474,395 to RSI, but otherwise retained ownership. (“Exhibit 2”)

11. On July 3, 2009, RSI filed a *Petition to Cancel* in the U.S. Patent and Trademark Office (“PTO”), Cancellation Proceeding No. 92051197, seeking the cancellation of U.S. Trademark Reg. No. 2,892,511, issued October 12, 2004, for the trademark “TOME TROPICAL (AND DESIGN)”, which is owned by Ecuabeverage. (“Exhibit 3”)

12. RSI has claimed that its “security interest” in, and its status as an “exclusive licensee” (though not the sole user in the United States) under, U.S. Trademark Reg. No. 1,474,395, accords it standing in Cancellation Proceeding No. 92051197.

13. Brooklyn Bottling is not a party to Cancellation Proceeding No. 92051197, nor has Brooklyn Botting sought to further amend its *Complaint* in the civil action pending in the U.S. District Court for the Southern District of New York to add a claim for

cancellation of U.S. Trademark Reg. No. 2,892,511 owned by Ecuabeverage.

14. Ecuabeverage is compelled to initiate a new proceeding by filing a *Petition for Cancellation* that seeks to effectively assert its compulsory counterclaims that would otherwise be brought in Cancellation Proceeding No. 92051197, precisely because Brooklyn Bottling is not a party to cancellation proceeding recently commenced by RSI.

Count I

First Claim for Cancellation on the Ground of Laches under 15 U.S.C. §1115(b)(9)

15. Petitioner Ecuabeverage repeats and realleges each and every allegation set forth in ¶¶ 1 – 14 of this *Petition for Cancellation*.

16. On, or about, June 7, 2007, RSI and Brooklyn Bottling entered into an “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT.” Various pages of this Agreement, made of record in the civil action in the U.S. District Court for the Southern District of New York, are included with this *Petition for Cancellation* as “Exhibit 4.”

17. In the “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT” of RSI and Brooklyn Bottling, the “Company” is “Royal Signature Inc.” and the “Bottler” is “Brooklyn Bottling of Milton, New York, Inc.”

18. “Article II” of the “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT” between RSI and Brooklyn Bottling states, in relevant part, that:

“The Bottler [Brooklyn Bottling] acknowledges that several other bottlers and/or sellers have been using the Trademarks without the consent of the Company [RSI], and as a result the Company [RSI] may have waived some or all of the rights in the Trademarks or be stopped from asserting them against such other users.”

19. Among the “Trademarks” encompassed by the “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT” between RSI and Brooklyn Bottling is the mark “TROPICAL PURO SABOR NACIONAL” of U.S. Trademark Reg. No. 1,474,395, upon which Brooklyn Bottling has filed a civil action in the United States District Court for the Southern District of New York and upon which RSI has commenced Cancellation Proceeding No. 92051197.

20. RSI has conceded in Article II of the “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT” that it has knowingly not policed and enforced its purported trademark rights, including, of the mark “TROPICAL PURO SABOR NACIONAL” of U.S. Trademark Reg. No. 1,474,395, and that “several” other bottlers and/or sellers have been using the mark of Trademark Reg. No. 1,474,395, and RSI has knowingly not taken action seeking to prevent others from using its registered trademark.

21. Brooklyn Bottling has acknowledged in Article II of the “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT” that RSI has knowingly not policed and enforced its purported trademark rights of the mark “TROPICAL PURO SABOR NACIONAL” of U.S. Trademark Reg. No. 1,474,395, and that “several” other bottlers and/or sellers have been using the mark of U.S. Trademark Reg. No. 1,474,395, and RSI has knowingly not taken action seeking to prevent others from using its registered

trademark.

22. RSI's deliberate failure to police and enforce its purported trademark rights for the trademark "TROPICAL PURO SABOR NACIONAL" of U.S. Trademark Reg. No. 1,474,395, and Brooklyn Bottling's acknowledgment of RSI's deliberate failure to police and enforce its trademark rights for various "Trademarks," including that of U.S. Trademark Reg. No. 1,474,395, constitutes laches against RSI and Brooklyn Bottling.

23. U.S. Trademark Reg. No. 1,474,395 for the trademark "TROPICAL PURO SABOR NACIONAL" should be cancelled on the equitable ground of laches under 15 U.S.C. §1115(b)(9).

Count II

Second Claim for Cancellation on the Ground of Laches under 15 U.S.C. §1115(b)(9)

24. Petitioner Ecuabeverage repeats and realleges each and every allegation set forth in ¶¶ 1 – 14 and 16 – 23 of this *Petition for Cancellation*.

25. On February 27, 2005, Michael I. Kroll, the attorney who prosecuted the Ecuabeverage trademark application that ultimately issued as Ecuabeverage's "TOME TROPICAL (AND DESIGN)," Trademark Reg. No. 2,812,511, wrote a "cease-and-desist" letter to Brooklyn Bottling's attorney, Jeffrey E. Jacobson, alleging that Brooklyn Bottling's use of the trademark "TROPICAL PURO SABOR NACIONAL" infringed the rights of Ecuabeverage as represented by Trademark Reg. No. 2,812,511. ("Exhibit 5")

26. On March 24, 2005, Jeffery E. Jacobson, on behalf of Brooklyn Bottling, contended that there “is no likelihood of confusion” between the respective marks of Brooklyn Bottling and Ecuabeverage. (“Exhibit 6”)

27. On July 24, 2007, Brooklyn Bottling’s trademark counsel, Jeffrey E. Jacobson, sent a “cease-and-desist” letter directly to Ecuabeverage placing on notice Ecuabeverage of Brooklyn Bottling’s alleged rights to the registered trademark “TROPICAL PURO SABOR NACIONAL” and that a likelihood of confusion existed between Ecuabeverage’s use of Ecuabeverage’s “TOME TROPICAL (AND DESIGN)” registered trademark and the “TROPICAL PURO SABOR NACIONAL” registered trademark of Brooklyn Bottling (which was, in fact, owned by RSI at such time.) (“Exhibit 7”)

28. Ecuabeverage’s trademark registration, Reg. No. 2,892,511, erroneously recites a date of first use, and first use “in commerce,” of July 1990. (“Exhibit 3”)

29. The erroneous date of first use, and first use “in commerce,” recited on U.S. Trademark Reg. No. 2,892,511, is legally immaterial and has no effect on its validity or enforceability. *See, Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (T.T.A.B. 2009) (“That is, if the mark was in use in commerce as of the filing date, then the claimed date of first use, even if false, does not constitute fraud because the first use date is not material to the Office’s decision to approve a mark for publication.”); *Georgia Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1726-1727 (T.T.A.B. 1990) (“One final matter requires our consideration, namely the date of first use of the mark set forth in the involved application, which user asserts is incorrect. While user contends that applicant’s incorrect

date of first use constitutes fraud, no evidence persuasive thereof was introduced. User does not dispute that applicant made use of its mark prior to the filing date of the involved application. *An erroneous date of first use could not possibly result in the allowance of a registration which would otherwise not be allowed, as long as there was technical trademark use prior to filing of the application. Thus, the date of first use alleged by applicant in its application, even if false, cannot be said to constitute fraud on the Office.*” (emphasis added)).

30. Ecuabeverage was incorporated in 1999, and has been continuously using, “in commerce,” its registered “TOME TROPICAL (AND DESIGN)” trademark since at least 2000 to the present day.

31. Since at least March 24, 2005, Brooklyn Bottling, through its attorney, has had actual knowledge of Ecuabeverage’s trademark rights and Ecuabeverage’s use of Ecuabeverage’s “TOME TROPICAL (AND DESIGN)” registered trademark.
 (“Exhibit 6”)

32. As of June 7, 2007, the date on which RSI and Brooklyn Bottling executed their “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT,” Ecuabeverage has, in fact, made actual use, “in commerce,” of its “TOME TROPICAL (AND DESIGN)” registered trademark for more than six (6) years. (“Exhibit 4”)

33. As of June 7, 2009, the date on which RSI and Brooklyn Bottling executed their “EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT,” Brooklyn

Bottling, through its attorney, has had actual knowledge that Ecuabeverage had been using, "in commerce," Ecuabeverage's "TOME TROPICAL (AND DESIGN)" registered trademark for more than six (6) years, notwithstanding the unintentional error in the dates of first use recited on U.S. Trademark Reg. No. 2,892,511.

34. Brooklyn Bottling had actual knowledge, via counsel, on June 7, 2007, that Ecuabeverage was using the trademark of U.S. Trademark Reg. No. 2,892,511, "TOME TROPICAL (AND DESIGN)" for more than six years, after affirmatively communicating to Ecuabeverage's counsel, Michael I. Kroll, that there was no likelihood of confusion between Ecuabeverage's registered trademark and the registered trademark, "TROPICAL PURO SABOR NACIONAL," thereby amounting to laches against Brooklyn Bottling and RSI, the latter of which actually owned the federal registration for "TROPICAL PURO SABOR NACIONAL" on June 7, 2007, thereby justifying cancellation of Trademark Reg. No. 1,474,395 for the trademark "TROPICAL PURO SABOR NACIONAL" on the equitable ground of laches under 15 U.S.C. §1115(b)(9).

Count III

Claim for Cancellation on the Ground of Acquiescence under 15 U.S.C. §1115(b)(9)

35. Petitioner Ecuabeverage repeats and realleges each and every allegation set forth in ¶¶ 1 – 14, 16 – 23 and 25 – 34 of this *Petition for Cancellation*.

36. On March 24, 2005, Jeffery E. Jacobson, on behalf of Brooklyn Bottling, contended that there "is no likelihood of confusion" between the respective marks of

Brooklyn Bottling and Ecuabeverage. (“Exhibit 6”)

37. On March 24, 2005, Brooklyn Bottling, through counsel, actively represented to Ecuabeverage that it would not assert a trademark infringement claim against Ecuabeverage for Ecuabeverage’s use of the “TOME TROPICAL (AND DESIGN)” registered trademark. (“Exhibit 6”)

38. Twenty-eight (28) months later, on July 24, 2007, Brooklyn Bottling’s trademark counsel, Jeffrey E. Jacobson, sent a “cease-and-desist” letter directly to Ecuabeverage placing on notice Ecuabeverage of Brooklyn Bottling’s alleged rights to the registered trademark “TROPICAL PURO SABOR NACIONAL” and that a likelihood of confusion existed between Ecuabeverage’s use of its “TOME TROPICAL (AND DESIGN)” registered trademark and the “TROPICAL PURO SABOR NACIONAL” registered trademark of Brooklyn Bottling (which was, in fact, owned by RSI at such time.) (“Exhibit 7”)

39. On October 1, 2007, Brooklyn Bottling filed suit against Ecuabeverage in the United States District Court for the Southern District of New York alleging federal trademark infringement and other claims based upon the alleged infringement of the mark “TROPICAL PURO SABOR NACIONAL” of Trademark Reg. No. 1,474,395, in which civil action Brooklyn Bottling seeks monetary damages from Ecuabeverage, including for the period of time following Brooklyn Bottling’s active representation to Ecuabeverage that there was “no likelihood of confusion” between the parties’ respective trademarks, all to the detriment and prejudice of Ecuabeverage.

40. Active consent to use a trademark, or active representation not to file an infringement action, of as little as nineteen (19) months has been held sufficient for finding acquiescence. *See, e.g., Pro Fitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C.*, 314 F.3d 62, 65 USPQ2d 1195 (2d Cir. 2002).

41. Brooklyn Bottling, through its trademark counsel, acquiesced in Ecuabeverage's use of the registered trademark "TOME TROPICAL (AND DESIGN)," which use Brooklyn Bottling in the civil action in the United States District Court for the Southern District of New York, and RSI in Cancellation Proceeding No. 92051197, now allege infringes, or otherwise conflicts with, rights represented by U.S. Trademark Reg. No. 1,474,395 for the "TROPICAL PURO SABOR NACIONAL" mark, such acquiescence by Brooklyn Bottling thereby justifying cancellation of Trademark Reg. No. 1,474,395 for the trademark "TROPICAL PURO SABOR NACIONAL" on the equitable ground of acquiescence under 15 U.S.C. §1115(b)(9) vis-à-vis the purported right represented by U.S. Trademark Reg. No. 1,474,395.

WHEREFORE, Petitioner Ecuabeverage Corporation respectfully demands that its *Petition for Cancellation* be granted and that the U.S. Trademark Registration No. 1,474,395, for the mark "TROPICAL PURO SABOR NACIONAL," be cancelled on the equitable grounds of laches and/or acquiescence by Joint Respondents Royal Signature Inc. and/or Brooklyn Bottling of Milton, New York, Inc.

The filing fee of \$300.00 in support of Ecuabeverage Corporation's *Petition for Cancellation*, pursuant to 37 C.F.R. 2.6(a)(16), for petitioning for the cancellation of U.S. Trademark Registration No. 1,474,395 in International Class 32, is being concurrently remitted via EFT.

Respectfully submitted

ECUABEVERAGE CORPORATION

By 
Edwin D. Schindler
Attorney for Petitioner
Reg. No. 31,459

Five Hirsch Avenue
P. O. Box 966
Coram, New York 11727-0966

(631)474-5373

E-Mail: EDSchindler@att.net
EDSchindler@optonline.net

July 20, 2009

Int. Cl.: 32

Prior U.S. Cl.: 45

United States Patent and Trademark Office **Reg. No. 1,474,395**
Registered Jan. 26, 1988

**TRADEMARK
PRINCIPAL REGISTER**

TROPICAL PURO SABOR NACIONAL

BANCO DEL PACIFICO S.A. (ECUADOR COR-
PORATION)
P. YCAZA 200
GUAYAQUIL, ECUADOR

FOR: SOFT DRINKS AND FLAVORED
SYRUPS USED IN THE PREPARATION OF
MAKING SOFT DRINKS, IN CLASS 32 (U.S. CL.
45).

FIRST USE 4-19-1966; IN COMMERCE
4-19-1966.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PURO SABOR", APART
FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF THE
WORDS "PURO SABOR NACIONAL" MEANS
"TRUE NATIONAL FLAVOR" OR "REAL NA-
TIONAL FLAVOR".

SER. NO. 489,879, FILED 7-16-1984.

MARTIN MARKS, EXAMINING ATTORNEY

EXHIBIT 1



United States Patent and Trademark Office

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 4

Serial #: 73489879 **Filing Dt:** 07/16/1984 **Reg #:** 1474395 **Reg. Dt:** 01/26/1988

Registrant: BANCO DEL PACIFICO S.A.

Mark: TROPICAL PURO SABOR NACIONAL

Assignment: 1

Reel/Frame: 0615/0358 **Received:** **Recorded:** 08/09/1988 **Pages:** 1

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Assignor:

BANCO DEL PACIFICO, S.A.

Exec Dt: 07/15/1988

Entity Type: UNKNOWN

Citizenship: NONE

Assignee: BALORU INTERNATIONAL, INC.

Entity Type: UNKNOWN

Citizenship: NONE

Correspondent: VALDES-FAULI, COBB & PETREY
SUITE 3400 - ONE BISCAYNE TOWER
2 SOUTH BISCAYNE BOULEVARD
MIAMI, FL 33131-1897

Assignment: 2

Reel/Frame: 3442/0298 **Received:** 12/12/2006 **Recorded:** 12/12/2006 **Pages:** 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor:

BALORU INTERNATIONAL INC.

Exec Dt: 11/24/2006

Entity Type: CORPORATION

Citizenship: FLORIDA

Assignee: ROYAL SIGNATURE INC.

AVENIDA BALBOA, CENTRO COMERCIAL PLAZA PAITILLA
OFICINA 61 A, PRIMER ALTO
PANAMA, PANAMA

Entity Type: CORPORATION

Citizenship: PANAMA

Correspondent: LAUREL V. DINEFF
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Domestic rep: LAUREL V. DINEFF
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Assignment: 3

EXHIBIT 2

Reel/Frame: 3721/0531 **Received:** 02/15/2008 **Recorded:** 02/15/2008 **Pages:** 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor:

ROYAZ SIGNATURE INC.

Exec Dt: 02/11/2008

Entity Type: CORPORATION

Citizenship: FLORIDA

Assignee: BROOKLYN BOTTLING OF MILTON, NY, INC.

1900 LINDEN BLVD.
BROOKLYN, NEW YORK 11207

Entity Type: CORPORATION

Citizenship: NEW YORK

Correspondent: JAZOBSON + LOLFIN, PC
JEFFREY & JAZOBSON
60 MADISON AVE, SUITE 1026
NEW YORK, NY 10010

Assignment: 4

Reel/Frame: 4014/0784 **Received:** 06/30/2009 **Recorded:** 06/30/2009 **Pages:** 7

Conveyance: SECURITY INTEREST

Assignor:

BROOKLYN BOTTLING OF MILTON, NY, INC.

Exec Dt: 02/11/2008

Entity Type: CORPORATION

Citizenship: NEW YORK

Assignee: ROYAL SIGNATURE INC.

AVENIDA BALBOA, CENTRO COMERCIAL PLAZA PAITILLA
OFICINA 61 A, PRIMER ALTO
PANAMA, PANAMA

Entity Type: CORPORATION

Citizenship: PANAMA

Correspondent: JUSTIN R. YOUNG, DINEFF TRADEMARK LAW
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Domestic rep: JUSTIN R. YOUNG, DINEFF TRADEMARK LAW
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Search Results as of: 07/19/2009 02:07 AM

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Web interface last modified: October 18, 2008 v.2.0.2

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Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 2,892,511

Registered Oct. 12, 2004

TRADEMARK
PRINCIPAL REGISTER



ECUABEVERAGE CORP. (NEW YORK COR-
PORATION)
541 BARRETO STREET
BRONX, NY 10474

FOR: SODA, NAMELY, CARBONATED SOFT
DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 7-0-1990; IN COMMERCE 7-0-1990.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PRODUCTO ORIGINAL ECUA-
TORIANO, PURO SABOR ECUATORIANO" AND

"SODA DE FRESA", APART FROM THE MARK AS
SHOWN.

THE ENGLISH TRANSLATION OF "PRODUCTO
ORIGINAL ECUATORIANO, TOME, PURO SABOR
ECUATORIANO, SODA DE FRESA" IS "ORIGINAL
ECUADORIAN PRODUCT, TAKE, PURE ECUADOR-
IAN FLAVOR, STRAWBERRY SODA"

SER. NO. 76-450,190, FILED 9-17-2002.

BRENDAN MCCAULEY, EXAMINING ATTORNEY

EXHIBIT 3

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①

THIS EXCLUSIVE BOTTLING AND DISTRIBUTION AGREEMENT (this "Agreement") effective as of June 1, 2007 (the "Effective Date"), is made and entered into by and between ROYAL SIGNATURE INC., AVENIDA BALBOA, CENTRO COMERCIAL PLAZA PAITILLA, OFICINA 61 A, PRIMER ALTO PANAMA, PANAMA a corporation organized and existing under the laws of Panama (the "Company"), and BROOKLYN BOTTLING OF MILTON, NEW YORK, INC., a corporation organized and existing under the laws of the State of New York, having its principal place of business in Brooklyn, New York (the "Bottler").

WITNESSETH:

WHEREAS

- A. The Company manufactures and sells the concentrates (the "Concentrates") for the manufacture of finished beverage products identified or described as "Beverages" on Schedule A (the "Beverages").
- B. The Company is the owner or authorized licensee of the trademarks identified on Schedule B (together with such other trademarks as may be authorized by the Company from time to time for current use by the Bottler under this Agreement, the "Trademarks"), which, among other things, identify and distinguish the Beverages;
- C. The reputation of the Beverages as being of consistently superior quality has been a major factor in stimulating and sustaining demand for the Beverages, and special technical skill and constant diligence on the part of the Bottler and the Company are required in order for the Beverages to maintain the excellence that consumers expect; and
- D. The Bottler wishes to manufacture, distribute and sell the Beverages in the Territories set forth in Schedule C on an exclusive basis, subject to the provisions herein.

NOW, THEREFORE, for and in consideration of the mutual covenants contained herein, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Company and the Bottler agree as follows:

ARTICLE I
The Authorization

- 1.
 - a) The Company authorizes the Bottler, and the Bottler undertakes to manufacture, package, distribute and sell the Beverages under the Trademarks in and throughout the Territories (as hereinafter defined).
 - b) The Company appoints the Bottler as its sole and exclusive purchaser of the Concentrates for the purpose of manufacturing, packaging, distributing and selling the Beverages in the

②

②

46 packages approved by the Company under the Trademarks in the Territories. The
47 Company further appoints Bottler as the sole and exclusive manufacturer, packager,
48 distributor and seller of the Beverages in the Territories, including any brand extensions
49 or other beverage products introduced for sale into the Territories by the Company; and
50 on a non-exclusive basis in Territories indicated as such on Schedule C.

51
52 c) "Territories" means each of the sub-territories identified on Schedule C.

53
54 **ARTICLE II**
55 **Obligations of Bottler**
56 **Relating to Trademarks and Other Matters**
57

58 2. The Bottler acknowledges and agrees not to question or dispute the validity of the
59 Trademarks or their exclusive ownership by the Company. By this Agreement, the Company
60 grants to the Bottler an exclusive license to use the Trademarks solely in connection with the
61 manufacture, packaging, marketing, distribution and sale of the Beverages in the Territories.
62 The Company represents and warrants that it possesses all rights in the licensed Trademarks
63 to grant Bottler the license(s) granted herein. Nothing herein, nor any act or failure to act by
64 the Bottler or the Company, shall give the Bottler any proprietary or ownership interest of
65 any kind in the Trademarks or in the goodwill associated therewith. The Bottler
66 acknowledges that several other bottlers and/or sellers have been using the Trademarks
67 without the consent of the Company, and as a result the Company may have waived some or
68 all of the rights in the Trademarks or be stopped from asserting them against such other
69 users.
70

71 **ARTICLE III**
72 **Obligations of Bottler Relating to**
73 **Manufacture and Packaging of the Beverages**
74

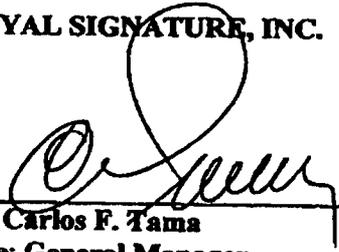
75 3. The Bottler represents and warrants that Bottler currently possesses, and will maintain
76 during the term of this Agreement, such plant or plants, machinery and equipment, trained
77 staff, and distribution facilities as are capable of manufacturing, packaging and distributing
78 the Beverages in accordance with this Agreement, in compliance with all applicable
79 material governmental and administrative requirements, and in sufficient quantities to fully
80 meet the anticipated demand for the Beverages in the Territories,
81
82 4. The Bottler recognizes that increases in the demand for the Beverages, as well as changes in
83 the packaging used for the Beverages, may, from time to time, require adaptation of its
84 existing manufacturing, packaging or delivery equipment or the purchase of additional
85 manufacturing, packaging and delivery equipment. The Bottler agrees to make such
86 reasonable modifications and adaptations as Bottler and the Company agree are necessary to
87 maintain quality standards and to fully meet the demand for the Beverages in the Territories.
88 Notwithstanding anything herein to the contrary, the Bottler shall not be required to use any
89 new packaging for Beverages or undertake capital improvements unless the Bottler in its
90 discretion approves such new packaging or capital improvements. X

②

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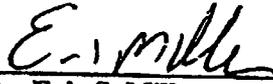
C
IN WITNESS WHEREOF, the parties have duly executed this Agreement in duplicate effective as of the day and year first above written.

ROYAL SIGNATURE, INC.



By: **Carlos F. Tama**
Title: **General Manager**
Date:

**BROOKLYN BOTTLING OF MILTON,
NEW YORK, INC.**



By: **Eric S. Miller**
Title: **President**
Date: *6/7/07*



Sabor
Hecho en
Ecuador!!!

Sabor
Hecho en
Ecuador!!!

Tropical

Puro sabor Nacional

Tropical

FRANCO
S.A.

Sabor
Hecho en
Ecuador!!!
Puro sabor Nacional

MICHAEL I. KROLL
ATTORNEY AT LAW

171 STILLWELL LANE - SYOSSET, NEW YORK 11791
816-367-7777 800-367-7776
FAX 800-367-7999 CAR PHONE 800-367-7776

TOLL FREE US & CANADA
International Phone/Fax 816-692-2787

Internet: www.invention.com E-mail: poteri@invention.com

PATENTS, TRADEMARKS & COPYRIGHTS

Brooklyn Bottling Corp.
1900 Linden Blvd.
Brooklyn, New York 11207

Attn: President

Re: US Trademark Infringement
Mark: **SOBEY**

Owner: Eouabeverage Corp.
US Trademark Registration s/ni 2,892,511

Gentlemen: 27 February 2005 (priority mail)

Please be advised that the undersigned has been retained by the owner of above referenced trademark in order to notify and apprise your company as to the existence and ownership of the above referenced trademark, copy of said registration enclosed.

It has come to our attention that you are distributing product using said mark in violation of the owner's rights and accordingly since there is no doubt as to the likelihood of confusion, request is hereby made that you immediately review the situation and contact the undersigned to discuss this matter in detail.

We consider this a very serious matter and suggest you treat this matter accordingly.

Please contact the undersigned within ten days to further discuss this matter.

MIL/ms
encl.

cc: Eouabeverage Corp.

Very truly yours,

Michael I. Kroll

DELIVERY CONFIRMATION
United States Postal Service

0310 2910 0003 4773 6365

0310 2910 0003 4773 6365

U.S. Postal Service Delivery Confirmation Receipt

Brooklyn Bottling Corp.
1900 Linden Blvd.
Brooklyn, New York 11207

Postmark: New York

Check one (Priority Mail only)
 Priority Mail
 Standard Mail (SM)

0310 2910 0003 4773 6365

0310 2910 0003 4773 6365

0310 2910 0003 4773 6365

MICHAEL I. KROLL
ATTORNEY AT LAW
171 STILLWELL LANE
SYOSSET, NEW YORK 11791

(516) 367 7777
(800) 367 7774

TO

Brooklyn Bottling Corp.
1900 Linden Blvd.
Brooklyn, New York 11207

FIRST CLASS MAIL

Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 2,892,511
Registered Oct. 12, 2004

TRADEMARK
PRINCIPAL REGISTER



ECUABEVERAGE CORP. (NEW YORK COR-
PORATION)
541 BARRETO STREET
BRONX, NY 10474

FOR: SODA, NAMELY, CARBONATED SOFT
DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 7-0-1990; IN COMMERCE 7-0-1990.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PRODUCTO ORIGINAL ECUA-
TORIANO, PURO SABOR ECUATORIANO" AND

"SODA DE FRESA", APART FROM THE MARK AS
SHOWN.

THE ENGLISH TRANSLATION OF "PRODUCTO
ORIGINAL ECUATORIANO, TOME, PURO SABOR
ECUATORIANO, SODA DE FRESA" IS "ORIGINAL
ECUADORIAN PRODUCT, TAKE, PURE ECUADOR-
IAN FLAVOR, STRAWBERRY SODA"

SER. NO. 76-450,190, FILED 9-17-2002.

BRENDAN MCCAULEY, EXAMINING ATTORNEY

Jacobson & Colfin, P.C.

Attorneys at Law

Jeffrey E. Jacobson*
Bruce E. Colfin

19 West 21st Street
New York, N.Y. 10010

(212) 691-5630
Fax: (212) 645-5038
www.thefirm.com
email: thefirm@thefirm.com

Bonnie L. Mohr**
of Counsel

*Also Member of D.C. Bar
**Also Member of N.J. Bar

March 24, 2005

Michael I. Kroll, Esq.
171 Stillwell Lane
Syosset, NY 11791

Via Fax: 800/367-7999

Re: Alleged Trademark Infringement
Mark: "Tomo Tropical"
Owner: Ecusbeverage Corp.
Registration s/n: 2,892,511

Dear Michael:

Your letter of February 27, 2005 to Brooklyn Bottling Corp. has been referred to me for reply.

We content that there is no likelihood of confusion; however, we are awaiting actual labels for complete analysis.

Will advise.

With best wishes.

Sincerely Yours.

EXHIBIT 6

Jacobson & Colfin, P.C.

Attorneys at Law

Jeffrey E. Jacobson*
Bruce E. Colfin

60 Madison Avenue
Suite #1026
New York, N.Y. 10010

(212) 691-5630
Fax: (212) 645-5038
www.thefirm.com
email: thefirm@thefirm.com

Bonnie L. Mohr**
Of Counsel:

July 24, 2007

* Also Member of D.C. Bar
** Also Member of N.J. Bar

Mr. Francisco Cervantes
President
Ecuabeverage Corp.
1240 Randall Ave.
Bronx, NY 10474

RE: Trademark Infringement

Dear Mr. Cervantes:

We are counsel for Brooklyn Bottling Of Milton Co., of New York, Inc., owner of the exclusive right, in this territory, to bottle beverages under the Federally registered trademark **TROPICAL PURO SABOR NACIONAL**.

Our client has recently learned that your company is utilizing a version of this name and mark for beverages in violation of our client's exclusive trademark rights.

Your company's use of a version of this name, mark and packaging in the manner and context in which it is used on the label, is so similar that it is likely to cause confusion as to the source of the product in the minds of the public. This product is apparently designed to appear as if it originates in Ecuador and is thus associated with our Licensor's brand name.

Your use constitutes an infringement and an act of unfair competition. Under federal and state law, these actions can subject you to liability for monetary damages as well as injunctive relief.

Accordingly, in order to resolve this matter short of litigation, our client demands that you comply immediately with the following conditions: cease all use of this name and mark, and agree not to resume any use of infringing or similar names or

1208 West Broadway, Hewlett, LI, 11557 • 516-295-7689

EXHIBIT 7

Jacobson & Colfin, P.C.

Attorneys at Law

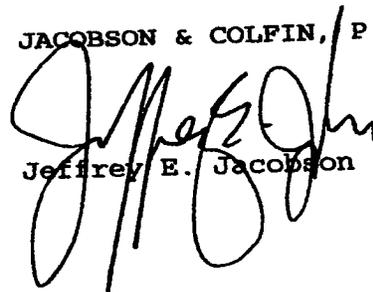
Ecuabeverage Corp.
July 24, 2007
Page (2) Two

marks in the future.

We presume we shall hear from you within ten (10) days of the date of this letter. If you fail to comply with these demands, our client will have no choice but to contemplate serious action in this matter.

Sincerely yours,

JACOBSON & COLFIN, P.C.



Jeffrey E. Jacobson

cc: Brooklyn Bottling of
Milton, New York, Inc.

CERTIFICATE OF SERVICE

I, EDWIN D. SCHINDLER, hereby certify that I served a true, and complete, copy of Ecuabeverage Corporation's *Petition for Cancellation* (including Exhibits 1 – 7) upon the following counsel for Respondent Brooklyn Bottling of Milton, New York, Inc. and Respondent Royal Signature Inc., via First-Class Mail, postage pre-paid:

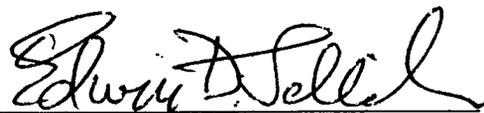
For Joint Respondent Brooklyn Bottling of Milton, New York, Inc.:

Jeffrey E. Jacobson
Bruce E. Colfin
JACOBSON & COLFIN, P.C.
60 Madison Avenue, Suite 1026
New York, New York 10010

For Joint Respondent Royal Signature Inc.:

Justin R. Young
DINEFF TRADEMARK LAW LIMITED
160 No. Wacker Drive
Chicago, Illinois 60606

on July 20, 2009.



Edwin D. Schindler
Attorney for Petitioner
Reg. No. 31,459

EXHIBIT-B

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-06-12 09:54:50 ET

Serial Number: 73489879 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1474395

Mark (words only): TROPICAL PURO SABOR NACIONAL

Standard Character claim: No

Current Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page

Date of Status: 2009-07-21

Filing Date: 1984-07-16

Transformed into a National Application: No

Registration Date: 1988-01-26

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 - Post Registration

Date In Location: 2007-08-29

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BALORU S.A.

Address:

BALORU S.A.
KAS 16 12 VIA DAULE
GUAYAQUIL

Ecuador

Legal Entry Type: SOCIEDAD ANONIMA(SA)

State or Country Where Organized: Ecuador

GOODS AND/OR SERVICES

International Class: 032

Class Status: Active

SOFT DRINKS AND FLAVORED SYRUPS USED IN THE PREPARATION OF MAKING SOFT DRINKS

Recht: 1(a)

First Use Date: 1966-04-19

First Use in Commerce Date: 1966-04-19

ADDITIONAL INFORMATION

Disclaimer: "PURO SABOR"

Translation: THE ENGLISH TRANSLATION OF THE WORDS "PURO SABOR NACIONAL" MEANS "TRUE NATIONAL FLAVOR" OR "REAL NATIONAL FLAVOR"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-06-01 - Automatic Update Of Assignment Of Ownership

2009-07-21 - Cancellation Instituted No 999999

2008-02-20 - Automatic Update Of Assignment Of Ownership

2007-08-29 - First renewal 10 year

2007-08-29 - Section 8 (10-year) accepted Section 9 granted

2007-08-16 - Assigned To Paralegal

2007-07-30 - Combined Section 8 (10-year) Section 9 filed

2007-07-30 - TEAS Section 8 & 9 Received

2007-05-03 - Case File In TIGRS

2006-12-15 - Attorney Revoked And Or Appointed

2006-12-15 - TEAS Revoked Appoint Attorney Received

2006-12-13 - Automatic Update Of Assignment Of Ownership

1994-05-23 - Section 8 (6-year) accepted & Section 15 acknowledged

1994-04-22 - Response received for Post Registration action

1994-03-09 - Post Registration action mailed Section 8 & 15

1994-01-07 - Response received for Post Registration action

1993-11-23 - Post Registration action mailed Section 8 & 15

1993-07-15 - Section 8 (6-year) and Section 15 Filed

1988-01-26 - Registered - Principal Register

1987-11-03 - Published for opposition

1987-10-02 - Notice of publication

1987-08-21 - Appeared for Pub - Principal Register (initial exam)

1987-05-08 - Communication received from applicant

1987-07-24 - Non-final action mailed

1987-07-22 - Allowance count withdrawn

1986-12-16 - Examiner's amendment mailed

1986-06-05 - Non-final action mailed

1986-03-05 - Communication received from applicant

1985-09-10 - Non-final action mailed

1985-01-25 - Non-final action mailed

1985-01-15 - Assigned To Examiner

1984-12-04 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Laurel V. Dineff

Correspondent

PANAGIOTA BETTY TUFARIELLO

INTELLECTUAL LAW OFFICES OF P.B. TUFAR

25 LITTLE HARBOR ROAD

MOUNT SINAI, NY 11766

Phone Number: 708-458-7200

Fax Number: 708-458-7300

Domestic Representative

Laurel V. Dineff

Phone Number: 708-458-7200

Fax Number: 708-458-7300

Int. Cl.: 32

Prior U.S. Cl.: 45

Reg. No. 1,474,395

United States Patent and Trademark Office Registered Jan. 26, 1988

**TRADEMARK
PRINCIPAL REGISTER**

TROPICAL PURO SABOR NACIONAL

BANCO DEL PACIFICO S.A. (ECUADOR COR-
PORATION)
P. YCAZA 200
GUAYAQUIL, ECUADOR

FOR: SOFT DRINKS AND FLAVORED
SYRUPS USED IN THE PREPARATION OF
MAKING SOFT DRINKS, IN CLASS 32 (U.S. CL.
45).

FIRST USE 4-19-1966; IN COMMERCE
4-19-1966.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PURO SABOR" , APART
FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF THE
WORDS "PURO SABOR NACIONAL" MEANS
"TRUE NATIONAL FLAVOR" OR "REAL NA-
TIONAL FLAVOR".

SER. NO. 489,879, FILED 7-16-1984.

MARTIN MARKS, EXAMINING ATTORNEY



Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 6

Serial #: 73489879

Filing Dt: 07/16/1984

Reg #: 1474395

Reg. Dt: 01/26/1988

Registrant: BANCO DEL PACIFICO S.A.

Mark: TROPICAL PURO SABOR NACIONAL

Assignment: 1

Reel/Frame: 0515/0358

Received:

Recorded: 08/09/1988

Pages: 1

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Assignor: BANCO DEL PACIFICO, S.A.

Exec Dt: 07/15/1988

Entity Type: UNKNOWN

Citizenship: NONE

Entity Type: UNKNOWN

Citizenship: NONE

Assignee: BALORU INTERNATIONAL, INC.Correspondent: VALDES-FAULI, COBB & PETREY
SUITE 3400 - ONE BISCAYNE TOWER
2 SOUTH BISCAYNE BOULEVARD
MIAMI, FL 33131-1897

Assignment: 2

Reel/Frame: 3442/0298

Received: 12/12/2006

Recorded: 12/12/2006

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BALORU INTERNATIONAL, INC.

Exec Dt: 11/24/2006

Entity Type: CORPORATION

Citizenship: FLORIDA

Entity Type: CORPORATION

Citizenship: PANAMA

Assignee: ROYAL SIGNATURE INC.
AVENIDA BALBOA, CENTRO COMERCIAL PLAZA PAITILLA
OFICINA 61 A, PRIMER ALTO
PANAMA, PANAMACorrespondent: LAUREL V. DINEFF
160 NORTH WACKER DRIVE
CHICAGO, IL 60606Domestic rep: LAUREL V. DINEFF
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Assignment: 3

Reel/Frame: 3721/0531

Received: 02/15/2008

Recorded: 02/15/2008

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: ROYAZ SIGNATURE INC.

Exec Dt: 02/11/2008

Entity Type: CORPORATION

Citizenship: FLORIDA

Entity Type: CORPORATION

Citizenship: NEW YORK

Assignee: BROOKLYN BOTTLING OF MILTON, NY, INC.
1900 LINDEN BLVD.
BROOKLYN, NEW YORK 11207Correspondent: JAZOBSON + LOFFIN, PC
JEFFREY & JAZOBSON
60 MADISON AVE, SUITE 1026
NEW YORK, NY 10010

Assignment: 4

Reel/Frame: 4014/0784

Received: 06/30/2009

Recorded: 06/30/2009

Pages: 7

Conveyance: SECURITY INTEREST

Assignor: BROOKLYN BOTTLING OF MILTON, NY, INC.

Exec Dt: 02/11/2008

Entity Type: CORPORATION

Citizenship: NEW YORK

Entity Type: CORPORATION

Citizenship: PANAMA

Assignee: ROYAL SIGNATURE INC.
AVENIDA BALBOA, CENTRO COMERCIAL PLAZA PAITILLA
OFICINA 61 A, PRIMER ALTO
PANAMA, PANAMACorrespondent: JUSTIN R. YOUNG, DINEFF TRADEMARK LAW
160 NORTH WACKER DRIVE
CHICAGO, IL 60606Domestic rep: JUSTIN R. YOUNG, DINEFF TRADEMARK LAW
160 NORTH WACKER DRIVE
CHICAGO, IL 60606

Assignment: 5

Reel/Frame: 4550/0310

Received: 05/27/2011

Recorded: 05/27/2011

Pages: 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BROOKLYN BOTTLING OF MILTON, NY, INC.

Exec Dt: 04/25/2011

Entity Type: CORPORATION

Citizenship: NEW YORK

Entity Type: SOCIEDAD ANONIMA(SA)

Citizenship: ECUADOR

Assignee: BALORU S.A.
KM. 16 1/2, VIA DAULE
GUAYAQUIL, ECUADORCorrespondent: PANAGIOTA BETTY TUFARIELLO, ESQ.
25 LITTLE HARBOR RD.
MT. SINAI, NY 11766Domestic rep: PANAGIOTA BETTY TUFARIELLO, ESQ.
25 LITTLE HARBOR ROAD
MOUNT SINAI, NY 11766

Assignment: 6

Reel/Frame: 4549/0363

Received: 05/26/2011

Recorded: 05/26/2011

Pages: 2

Conveyance: RELEASE BY SECURED PARTY

Assignor: ROYAL SIGNATURE INC.

Exec Dt: 05/02/2011

Entity Type: CORPORATION

Citizenship: PANAMA

Entity Type: CORPORATION

Citizenship: NEW YORK

Assignee: BROOKLYN BOTTLING OF MILTON, NY, INC.
1900 LINDEN BLVD.
BROOKLYN, NEW YORK 11207Correspondent: PANAGIOTA BETTY TUFARIELLO, ESQ.
25 LITTLE HARBOR RD.
MT. SINAI, NY 11766

EXHIBIT-C

Goodman

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 20, 2011

Cancellation No. 92051197

Royal Signature Inc.

v.

Ecuabeverage Corp.

Cancellation No. 92051242

Ecuabeverage Corp.

v.

Brooklyn Bottling of Milton
NY, Inc.

Before Bucher, Zervas and Bergsman, Administrative Trademark
Judges.

By the Board:

This case now comes up on the following motions:

- 1) Ecuabeverage's motion to suspend (filed October 18, 2010) in Cancellation No. 92051197;
- 2) Ecuabeverage's motion to dismiss (filed October 27, 2010) in Cancellation No. 92051197; and
- 3) Ecuabeverage's motion for extension of time (filed November 15, 2010) in Cancellation No. 92051197.

Consolidation

Before turning to the motions, the Board has learned through the parties' filings that there is a related Board proceeding (Cancellation No. 92051242) involving

Cancellation Nos. 92051197 and 92051242

Ecuabeverage Corp. (hereinafter Ecuabeverage) and Brooklyn Bottling of Milton, N.Y., Inc. (hereinafter Brooklyn Bottling). Brooklyn Bottling, the current owner of the TROPICAL PURO SABOR NACIONAL mark identified in the petitions for cancellation, licensed the mark to Royal Signature Inc. (hereinafter Royal Signature). Based on our review of the pleadings, we find that the parties to the proceedings are in privity and there are common questions of fact and law. Therefore, for purposes of judicial efficiency, to save the parties and the Board time and expense, to avoid duplicative filings of evidence, as well as to eliminate the risk of inconsistent results between the two proceedings, consolidation is appropriate. Consolidation will provide the most expeditious method of resolving the controversies among the parties without prejudicing the rights of any party on any of the issues in the separate proceedings. TBMP Section 511 (2d ed. rev. 2004) (Consolidation may be ordered on the Board's own initiative).

Accordingly, Cancellation Nos. 92051197 and 92051242 are hereby consolidated and may be presented on the same record and briefs, though each retains its separate character. The record will be maintained at the Board in Cancellation No. 92051197 as the "parent" case, but all

Cancellation Nos. 92051197 and 92051242

papers filed in these cases should include all proceeding numbers in ascending order.

The Board notes that counsel for Royal Signature and Brooklyn Bottling are different. Therefore, counsel for Royal Signature and Brooklyn Bottling should decide among themselves which counsel will be "lead counsel" for purposes of sending correspondence. (Except for this order, the Board mails only two copies of correspondence, and one copy of Board correspondence in this case will be mailed to Ecuabeverage.) Lead counsel, in turn will be "responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative."¹ TBMP Section 117.02. If the Board does not hear back from the parties regarding the designated correspondent, Thomas M. Wilentz, counsel in the parent case, will be designated to receive Board correspondence.

Petition to Cancel, Cancellation No. 92051242

In considering consolidation, the Board reviewed the pleadings in both proceedings. Upon review of the petition to cancel in Cancellation No. 92051242, the Board finds that the asserted grounds of laches and acquiescence are

¹ The Board will add the e-mail address of counsel for Brooklyn Bottling to the record in Cancellation No. 92051197 so that counsel may receive any automated e-mail communications from the Board.

Cancellation Nos. 92051197 and 92051242

affirmative defenses; affirmative defenses are not grounds for cancellation. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 n. 16 (TTAB 2008) (citing Black's Law Dictionary and 2.106(b)(1)) (affirmative defenses include "unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense"); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (laches and acquiescence are affirmative defenses, not grounds for opposition).

Accordingly, the Board finds that Royal Signature has failed to state a claim and dismissal is appropriate, see e.g., *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 530 F.2d 953, 189 USPQ 15 (C.C.P.A. 1976) (considering whether appeal of Board action of sua sponte striking fraud claim from pleading under Fed. R. Civ. P. 12(f) allowable); *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold LLC*, 95 USPQ2d 1185 (TTAB 2010) (noting that Board denied a motion to dismiss based on standing but sua sponte dismissed the original petition as lacking an adequate fraud claim); *Consolidated Foods Corporation v. Big Red, Inc.*, 231 USPQ 744 (TTAB 1986) (noting that Board sua sponte struck paragraphs from notice of opposition pursuant to Fed. R. Civ. P. 12(f)). Therefore, the petition to cancel is dismissed without prejudice.

Cancellation Nos. 92051197 and 92051242

As indicated below, consolidated proceedings are presently suspended for the parties' civil action. Should proceedings resume, Ecuabeverage will be afforded time to file an amended petition to cancel which states a proper ground for cancellation.

Motion to Dismiss Cancellation No. 92051197

We now turn to the motion to dismiss filed in Cancellation No. 92051197.

Ecuabeverage seeks dismissal pursuant to Fed. R. Civ. P. 12(b)(6),² 12(b)(7), 12(h)(2)(B), 12(c) and 19 for failure of Royal Signature to join an indispensable party, Brooklyn Bottling, the owner of Registration No. 1474395, TROPICAL PURO SABOR NACIONAL, for which mark Royal Signature alleges a real interest based on holding a security interest in the registration and its status as exclusive licensee of the mark (as well as "predecessor in title" of the federal registration). Ecuabeverage argues that this proceeding "must be dismissed under Fed.R.Civ.P. 19 for failure to join an indispensable [sic] party," Brooklyn Bottling.

In response, Royal Signature points out that joint filing in a Board proceeding is elective, and not mandatory.

² Although Ecuabeverage has identified Fed. R. Civ. P. 12(b)(6) in its caption, Ecuabeverage has not made any arguments that dismissal is warranted on the basis of failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6). Ecuabeverage, however, argues in its reply brief that its motion to dismiss for failure to join an indispensable party can be

Cancellation Nos. 92051197 and 92051242

Royal Signature also argues that the issue in a cancellation proceeding is "what rights Royal Signature has in its pleaded marks vis-à-vis the defendant, not what rights anyone else may have in it" and thus, Brooklyn Bottling is not a necessary or indispensable party.

In reply, Ecuabeverage argues that "all claimants need appear" in the Board proceeding since this proceeding will "necessarily determine rights in, and to, the absent owner's mark" and that otherwise there is the "potential for multiple litigations [sic] concerning 'the same basic facts.'"

To the extent that Ecuabeverage is seeking dismissal due to the failure to join Brooklyn Bottling as a necessary party or indispensable party, and to the extent that Royal Signature is relying on common law rights,³ the motion to dismiss is not well taken. As the Board stated in *Sun Valley Company Inc. v. Sun Valley Manufacturing Co.*, 167 USPQ 304, 310 (TTAB 1970):

It is illogical to require that all parties that could possibly be injured by a registration be joined as parties to a cancellation or opposition proceeding before any one party can seek relief from the registration of a mark. This position is contrary to

considered under both Fed. R. Civ. P. 12(b)(6) and Fed. R. Civ. P. 12(b)(7).

³ We note that Royal Signature has included allegations relating to Registration No. 1474395 in the petition to cancel. However, because Royal Signature is not the current owner of the registration, it cannot base its priority on this registration. Rather, Royal Signature's priority is based on its common law use.

Cancellation Nos. 92051197 and 92051242

the specific provisions of Sections 13 and 14 of the Statute which provide that "any person" who believes that he is or would be damaged by the registration of a mark is a proper party to file an opposition or a petition to cancel.

Accordingly, there is no requirement of joinder of Brooklyn Bottling to this proceeding. In view thereof, the motion to dismiss is denied.

Motion to Suspend, Cancellation No. 92051197

We now turn to the motion to suspend filed in Cancellation No. 92051197.

Ecuabeverage seeks a suspension of Board proceedings for a civil action involving Ecuabeverage and Brooklyn Bottling, *Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation*, Index No. 07 CIV 8483 (AKH).

In support of the motion, Ecuabeverage argues that the "relative rights of the various parties can be, and are being, sorted out by the federal district court and need not be addressed at this time in this cancellation proceeding." Ecuabeverage further states that Royal Signature agreed in writing to be bound by the outcome of the civil action; Ecuabeverage has provided an exhibit, namely a "certificate of estoppel" where Royal Signature has agreed "to be bound by the decision in the pending case before the U.S. District Court for the Southern District of New York"

In response, Royal Signature argues that suspension is not appropriate because Royal Signature is not a party to

Cancellation Nos. 92051197 and 92051242

the civil action and that the issues in the civil action, particularly the claims and defenses Ecuabeverage has asserted in the civil action, are not being asserted in the cancellation proceeding and/or involve different factual circumstances since different party plaintiffs are involved in the two proceedings.

In reply, Ecuabeverage points out that Brooklyn Bottling's claims against Ecuabeverage in the civil action include a claim of trademark infringement and that if the court finds that TROPICAL PURO SABOR NACIONAL "is descriptive and/or not entitled to protection as a trademark" or finds no likelihood of confusion between the parties' marks, then Royal Signature's claims of damage and basis for standing that flow from the TROPICAL PURO SABOR NACIONAL mark "would be undermined, if not completely destroyed." Therefore, Ecuabeverage asserts that "the related civil action . . . will determine the rights and interests" of Royal Signature in this proceeding and suspension is appropriate.

A proceeding may be suspended pending the outcome of civil litigation in which only one of the parties is involved, if a final decision in the civil action may have a bearing on the case. TBMP Section 510.02(a). A party's status as privy to litigants in a civil action may also be a basis for suspending the Board proceeding. See e.g., *Argo &*

Cancellation Nos. 92051197 and 92051242

Company, Inc. v. Carpetsheen Manufacturing, Inc., 187 USPQ 366 (TTAB 1975) (suspending Board proceeding based on civil action involving one of the parties' privies).

In this case, Royal Signature, as an exclusive licensee, is in privity with Brooklyn Bottling, the owner of Registration No. 1474395 and plaintiff in the civil litigation. See *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352 (TTAB 1981) (noting that an exclusive licensee is in privity with the owner of the mark). Additionally, the claims in the civil litigation include a claim of trademark infringement by which certain findings and conclusions made by the court may have a bearing on the claims in this proceeding (priority and likelihood of confusion, false suggestion of a connection, misrepresentation of source, and fraud). Cf.

DaimlerChrysler Corp. v. Maydak, 86 USPQ2d 1945, 1949 (TTAB 2008) (finding certain findings and conclusions of the district court in an Anticybersquatting Consumer Protection Act case involving the parties had a bearing on likelihood of confusion claim in opposition proceeding); *Los Angeles Bonaventure Company v. Bonaventure Associates*, 4 USPQ2d 1882, 1883 (TTAB 1987) ("final judgment rendered by a court of competent jurisdiction on the merits is conclusive as to the rights of the parties and their privies").

Cancellation Nos. 92051197 and 92051242

In view thereof, the Board finds suspension appropriate. Accordingly, Ecuabeverage's motion to suspend is granted.

Motion to Extend, Cancellation No. 92051197

We now turn to the motion to extend filed in Cancellation No. 92051197.

Ecuabeverage seeks an extension of time to respond to discovery requests which were served on Ecuabeverage on October 15, 2010. Ecuabeverage points out that under Trademark Rule 2.127, proceedings will be suspended for the motion to dismiss and requests that the proceeding be considered to be "already suspended" as of the filing of that motion to dismiss.

In response, Royal Signature advises that in light of Trademark Rule 2.127(a) it believes the motion to extend is unnecessary but that it was "not ready to grant Ecuabeverage extra time to respond to the outstanding discovery requests," leaving it to the Board to reset the dates. Royal Signature requests that "any order extending time . . . should do no more than place the parties in the same position that they were as of the date that Ecuabeverage filed its motion to dismiss."

In reply, Ecuabeverage argues that to the extent the motion to extend is not rendered moot by the Board's

Cancellation Nos. 92051197 and 92051242

November 17, 2010 suspension order, the motion to extend should be granted.

Inasmuch as the Board deems the proceedings suspended retroactive to the filing of the motion to dismiss on October 27, 2010, the motion to extend is granted to the extent that if proceedings resume, Ecuabeverage's time for serving responses to discovery will be reset.

Proceedings in this consolidated case are suspended pending the final disposition of the civil action.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action.

During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

cc:

Jeffrey E. Jacobson
The Jacobson Firm, P.C.
60 Madison Avenue, Suite 1026
New York, NY 10010

EXHIBIT-D

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: May 1, 2012

Cancellation No. 92051197

BALORU S.A., by assignment
from BROOKLYN BOTTLING OF
MILTON, NY, INC. by
assignment from
ROYAL SIGNATURE, INC.¹

v.

ECUABEVERAGE CORPORATION

Cancellation No. 92051242

ECUABEVERAGE CORPORATION

v.

BALORU S.A. by
by assignment from
BROOKLYN BOTTLING OF
MILTON N.Y., INC.²

Cancellation No. 92051263

ECUABEVERAGE CORPORATION

v.

BROOKLYN BOTTLING OF
MILTON N.Y., INC.

Cheryl S. Goodman, Interlocutory Attorney:

¹ Recorded at Reel/Frame 4550/0310 of the Office's Assignment Branch on May 27, 2011. When instituting this proceeding, the Office did not note the assignment from Royal Signature to Brooklyn Bottling of Milton, NY, Inc.

² Reel/Frame 4550/0310.

Cancellation Nos. 92051197, 92051242 and 92051263

On March 21, 2012, petitioner Royal Signature (Royal Signature) notified the Board that a final determination had been rendered in the civil action which occasioned suspension of the proceeding.

Royal Signature also sought to substitute Baloru S.A. as petitioner in Cancellation No. 92051197 for petitioner Royal Signature and to substitute Baloru S.A. as respondent in Cancellation No. 92051242 for respondent Brooklyn Bottling of Milton N.Y., Inc. Lastly, Royal Signature has sought to sever Cancellation No. 92051263 from the consolidated proceedings involving Ecuabeverage Corporation and Brooklyn Bottling of Milton N.Y. because the real parties in interest and the trademark at issue are different from the real parties in interest and trademarks at issue in the consolidated proceedings Cancellation Nos. 92051197 and 92051242.

Respondent in Cancellation No. 92051197, Ecuabeverage Corporation (Ecuabeverage) has responded to this filing and indicated its consent to such substitution of Baloru S.A. as party plaintiff in Cancellation No. 92051197 and as party defendant in Cancellation No. 92051242 as well as the severing of Cancellation No. 92051263.

After a proceeding has commenced, the Board can substitute a party as party defendant for an involved registration if the party plaintiff raises no objection to

Cancellation Nos. 92051197, 92051242 and 92051263

substitution. Similarly, after a proceeding has commenced if a mark pleaded by a plaintiff is assigned, the party plaintiff will be substituted if the party defendant raises no objection to substitution. TBMP Section 512 (3d ed. 2011).

Accordingly, Baloru S.A. has been substituted for Royal Signature as party plaintiff in Cancellation No. 92051197 and substituted for Brooklyn Bottling of Milton, N.Y., Inc. as party defendant in Cancellation No. 92051242.

With regard to the parties' notification regarding the parties' civil action, a brief review of other papers filed in this proceeding (e.g., Ecuabeverage's motion to dismiss for lack of prosecution) indicates that the decision by the district court in the parties' civil action was appealed on March 22, 2012, by Ecuabeverage. Therefore, the civil action is not final and the lifting of suspension is not appropriate.

Cancellation No. 92051263 was also suspended for the same civil action and consolidated with the other proceedings herein. While the parties are in agreement as to the motion to sever, and the motion appears well taken, the Board will defer consideration thereof until the civil action is concluded.

The Board notes that because of Ecuabeverage's belief that proceedings had resumed in the consolidated

Cancellation Nos. 92051197, 92051242 and 92051263

proceedings, it filed, on April 9, 2012, a motion to dismiss Cancellation No. 92051197 for lack of prosecution and a motion to dismiss counts II, III and IV of petition to cancel 92051197 for failure to state a claim. Petitioner in Cancellation No. 92051197 (now Baloru S.A. by way of assignment) has filed responses thereto. Consideration of these motions is deferred until the civil action, now on appeal, is final.

EXHIBIT E

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

ECUABEVERAGE CORPORATION,

Petitioner,

-v-

BALORU S.A.,

Respondent

DECLARATION OF CARLOS TAMA

Carlos Tama hereby declares:

1. I am currently the president of Respondent Baloru S.A. and I have been the general manager of Baloru S.A., which position I had held since November 1997, until recently when I became the president of Baloru S.A.
2. I currently reside at Circunvalacion Norte 512, Guayaquil, Ecuador.
3. As the president and former general manager of Respondent I am familiar with the facts set forth herein.
4. I submit this declaration in in support of Petitioner's Motion for Summary Judgment.
5. Petitioner Ecuabeverage Corporation and or its president Francisco ... distributed Respondent's TROPICAL branded soft drinks in the State ... prior to the year 2002.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

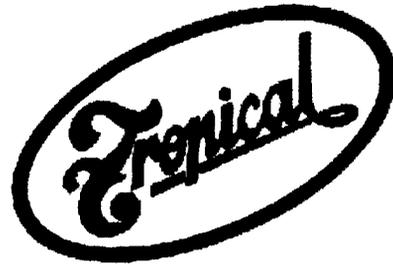
Dated: July 3/2020 Guayaquil - Ecuador


Carlos Tama

EXHIBIT F

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Mark: TROPICAL



US Serial Number:	85336274	Application Filing Date:	Jun. 02, 2011
US Registration Number:	4120917	Registration Date:	Apr. 03, 2012
Filed as TEAS Plus:	Yes	Currently TEAS Plus:	Yes
Register:	Principal		
Mark Type:	Trademark		
Status:	A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.		
Status Date:	May 07, 2012		
Publication Date:	Oct. 04, 2011		

Mark Information

Mark Literal Elements:	TROPICAL
Standard Character Claim:	No
Mark Drawing Type:	3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)
Description of Mark:	The mark consists of the word "TROPICAL" in blue script appearing over a yellow oval background with a red outline. The color blue appears in the word "TROPICAL", the color yellow appears in the oval design and color red appears in the outline of the perimeter of the oval design.
Color Drawing:	Yes
Color(s) Claimed:	The color(s) red, yellow and blue is/are claimed as a feature of the mark.

**Design Search
Code(s):**

26.03.17 - Concentric ovals;Concentric ovals and ovals within ovals;Ovals
within ovals;Ovals, concentric
26.03.21 - Ovals that are completely or partially shaded
26.17.13 - Letters or words underlined and/or overlined by one or more strokes
or lines;Overlined words or letters;Underlined words or letters

Related Properties Information

**Claimed Ownership
of US Registrations:** 3927391,3946678,3949746

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Soft drinks

International Class: 032 - Primary Class **U.S Class:** 045, 046, 048

Class Status: ACTIVE

Basis: 1(a)

First Use: 1952 **Use in Commerce:** 1989

Basis Information (Case Level)

Filed Use:	Yes	Currently Use:	Yes	Amended Use:	No
Filed ITU:	Yes	Currently ITU:	No	Amended ITU:	No
Filed 44D:	No	Currently 44D:	No	Amended 44D:	No
Filed 44E:	No	Currently 44E:	No	Amended 44E:	No
Filed 66A:	No	Currently 66A:	No		
Filed No Basis:	No	Currently No Basis:	No		

Current Owner(s) Information

Owner Name: Baloru S.A.

Owner Address: Km. 16 1/2 Via Daule
Guayaquil
ECUADOR

Legal Entity Type: sociedad anonima (sa)

State or Country Where Organized: ECUADOR

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Thomas M. Wilentz

Correspondent

Correspondent Name/Address: BALORU SA
KM 16 1/2 VIA DAULE
GUAYAQUIL
ECUADOR

Phone 914-723-0394 **Fax** 914-206-3787

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 07, 2012	CANCELLATION INSTITUTED NO. 999999	55569
Apr. 03, 2012	REGISTERED-PRINCIPAL REGISTER	
Feb. 23, 2012	1(B) BASIS DELETED; PROCEED TO REGISTRATION	71034
Feb. 16, 2012	NOTICE OF ALLOWANCE CANCELLED	71034
Feb. 23, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71034
Feb. 16, 2012	TEAS POST PUBLICATION AMENDMENT RECEIVED	
Nov. 29, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 04, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 04, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 04, 2011	PUBLISHED FOR OPPOSITION	
Aug. 16, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 09, 2011	ASSIGNED TO EXAMINER	81093

Jun. 07, 2011 NOTICE OF DESIGN SEARCH CODE MAILED
Jun. 06, 2011 NEW APPLICATION OFFICE SUPPLIED DATA
ENTERED IN TRAM
Jun. 06, 2011 NEW APPLICATION ENTERED IN TRAM

TM Staff and Location Information

Current Location: PUBLICATION AND ISSUE SECTION **Date in Location:** Apr. 03, 2012



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Assignments on the Web > [Trademark Query](#)



No assignment has been recorded at the USPTO

For Serial Number: 85336274

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350, v.2.3.1
Web interface last modified: Jan 26, 2012 v.2.3.1

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EXHIBIT G

Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

Reg. No. 2,892,511

United States Patent and Trademark Office

Registered Oct. 12, 2004

TRADEMARK
PRINCIPAL REGISTER



ECUABEVERAGE CORP. (NEW YORK COR-
PORATION)
541 BARRETO STREET
BRONX, NY 10474

FOR: SODA, NAMELY, CARBONATED SOFT
DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 7-0-1990; IN COMMERCE 7-0-1990.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PRODUCTO ORIGINAL ECUA-
TORIANO, PURO SABOR ECUATORIANO" AND

"SODA DE FRESA", APART FROM THE MARK AS
SHOWN.

THE ENGLISH TRANSLATION OF "PRODUCTO
ORIGINAL ECUATORIANO, TOME, PURO SABOR
ECUATORIANO, SODA DE FRESA" IS "ORIGINAL
ECUADORIAN PRODUCT, TAKE, PURE ECUADOR-
IAN FLAVOR, STRAWBERRY SODA"

SER. NO. 76-450,190, FILED 9-17-2002.

BRENDAN MCCAULEY, EXAMINING ATTORNEY

STATUS DOCUMENTS

[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2012-06-09 12:57:02 EST

Mark: TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR
ECUATORIANO SODA DE FRESA



US Serial Number: 76450190

Application Filing Date: Sep. 17, 2002

US Registration Number: 2892511

Registration Date: Oct. 12, 2004

Register: Principal

Mark Type: Trademark

Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Jul. 08, 2009

Publication Date: Jul. 20, 2004

Mark Information

Mark Literal Elements: TOME TROPICAL PRODUCTO ORIGINAL ECUATORIANO PURO SABOR ECUATORIANO SODA DE FRESA

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Disclaimer: "PRODUCTO ORIGINAL ECUATORIANO, PURO SABOR ECUATORIANO" and "SODA DE FRESA"

Translation: The English translation of "PRODUCTO ORIGINAL ECUATORIANO, TOME, PURO SABOR ECUATORIANO, SODA DE FRESA" is "ORIGINAL ECUATORIAN PRODUCT, TOME, PURE ECUATORIAN FLAVOR, STRAWBERRY SODA"

Design Search Code(s): 01.15.11 - Suds, soap; Soap suds; Foamy mass; Foam (bubbles); Bubbles
05.01.03 - Palm trees
26.01.06 - Circles, semi; Semi-circles
26.01.21 - Circles that are totally or partially shaded.
26.03.04 - Ovals with two breaks or divided in the middle
26.03.21 - Ovals that are completely or partially shaded
27.03.04 - Plants forming letters or numerals

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Soda, namely, carbonated soft drinks

International Class: 032 - Primary Class

U.S Class: 045, 046, 048

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 1990

Use in Commerce: Jul. 1990

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: ECUABEVERAGE CORP.
Owner Address: 1240 Randall Avenue
 Bronx, NEW YORK 10474
 UNITED STATES
Legal Entity Type: CORPORATION
State or Country Where Organized: NEW YORK

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Michael I. Kroll

Docket Number: LQ-1

Correspondent

Correspondent Name/Address: EDWIN D SCHINDLER
 4 HIGH OAKS COURT
 PO BOX 4259
 HUNTINGTON, NY 11743-0777
 UNITED STATES

Phone: 516-367-7777

Fax: 800-367-7999

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 27, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED	70131
Apr. 27, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70131
Apr. 24, 2010	TEAS SECTION 8 RECEIVED	
Jul. 08, 2009	CANCELLATION INSTITUTED NO. 999999	51197
Oct. 12, 2004	REGISTERED-PRINCIPAL REGISTER	
Jul. 20, 2004	PUBLISHED FOR OPPOSITION	
Jun. 30, 2004	NOTICE OF PUBLICATION	
May 06, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 29, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 01, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 01, 2004	PAPER RECEIVED	
Sep. 29, 2003	NON-FINAL ACTION MAILED	
Aug. 20, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Sep. 12, 2003	CASE FILE IN TICRS	
Aug. 20, 2003	PAPER RECEIVED	
Feb. 14, 2003	NON-FINAL ACTION MAILED	
Feb. 13, 2003	ASSIGNED TO EXAMINER	76733
Feb. 11, 2003	ASSIGNED TO EXAMINER	76745

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

TM Staff and Location Information

Current Location: TMO LAW OFFICE 114

Date In Location: Apr. 27, 2010

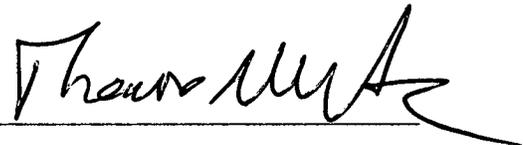
CERTIFICATE OF SERVICE

I hereby certify that I have this date served counsel for all parties to this action with a copy of the foregoing Declaration of Thomas Wilentz (including Exhibits A-G hereto) by depositing the same by first-class mail in an envelope addressed to:

EDWIN D. SCHINDLER
EDWIN D. SCHINDLER, PATENT ATTORNEY
4 HIGH OAKS COURT P. O. BOX 4259
HUNTINGTON, NY 11743-0777

Scarsdale, New York
July 23, 2012

Signed: _____

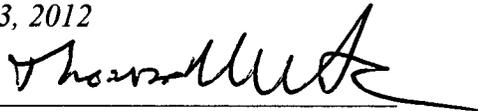


Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on July 23, 2012



Signature

Thomas M. Wilentz