

ESTTA Tracking number: **ESTTA721302**

Filing date: **01/19/2016**

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	Carlos Martinez Somoza		
Entity	Individual	Citizenship	UNITED STATES
Address	750 North Mobile Ave Apt 35 Camarillo, CA 93010 UNITED STATES		

Attorney information	Steven J. Eyre Law Office of Steven J. Eyre 3550 Wilshire Blvd Ste 420 Los Angeles, CA 90010 UNITED STATES stevenjeyre@gmail.com Phone:213-814-4416		
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Registration Subject to Cancellation

Registration No	4607981	Registration date	09/23/2014
Registrant	Gutierrez, J. Sergio Rios 722 West 132 St Gardena, CA 90247 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2007/10/31 First Use In Commerce: 2007/11/22 All goods and services in the class are cancelled, namely: Entertainment, namely, live performances by a musical band

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85813544	Application Date	01/01/2013
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	LA MIGRA		
Design Mark			
Description of Mark	The mark consists of Black and white logo with black border.		
Goods/Services	<p>Class 009. First use: First Use: 1975/03/17 First Use In Commerce: 1976/04/15 Audio tapes featuring music; Compact discs featuring music</p> <p>Class 041. First use: First Use: 1976/04/15 First Use In Commerce: 1976/04/15 Entertainment services, namely, live, televised and movie appearances by a professional entertainer; Entertainment services, namely, production of special effects including model-making services, computer-generated imagery and computer-generated graphics for the production of motion pictures, videos, and movie trailers</p>		

Attachments	85813544#TMSN.png(bytes) 2016-01-19-1205-Petition for Cancellation.pdf(145028 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	/stevenjeyre/
Name	Steven J. Eyre
Date	01/19/2016

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

Carlos Martinez Somoza, Individual

Petitioner,

vs.

J. Sergio Rios Gutierrez, Individual

Respondent.

Cancellation No.

In the Matter of

Reg. No. 4,607,981

PETITION FOR CANCELLATION

This Petition for Cancellation is submitted in the matter of Registration No. 4,607,981, registered on September 23, 2014 and owned by respondent J. Sergio Rios Gutierrez, an individual (hereinafter, "Respondent"), with a mailing address of 722 West 132nd Street, Gardena, CA 90247, for the stylized mark GRUPO LA MIGRA plus design in international class 41 for "entertainment, namely, live performances by a musical band," with a claimed date of first use of October 31, 2007 and a claimed date of first use in commerce of November 22, 2007.

Petitioner Carlos Martinez Somoza, an Individual (hereinafter, "Petitioner"), whose address is 750 N. Mobile Ave, Apt 35, Camarillo, CA 93010, is owner of the musical group "La Migra" as well as the stylized mark L MIGRA plus design used in connection with goods, namely and audiovisual recordings, and services, namely live entertainment services of a musical group, which Petitioner's musical group has used in its literal and stylized forms since at least as early as 1975 and in commerce since at least as early as 1976. Petitioner has filed an application with the United States Patent and Trademark Office to register the LA MIGRA mark, Ser. No. 85813544, which is pending.

The LA MIGRA mark as well as the stylized mark LA MIGRA plus design used by Petitioner and his musical group in commerce in the United States since at least as early as

1983 in connection with goods, namely audio and audiovisual recordings, and services, namely live entertainment services of a musical group, is essentially identical to the stylized mark GRUPO LA MIGRA for which Respondent has wrongfully obtained the above-referenced registration.

As grounds for this Petition for Cancellation, it is alleged that:

I. FACTUAL BACKGROUND

1. Petitioner and his fellow group members started the musical group “La Migra” in Mexico at least as early as 1975. Petitioner has used the mark LA MIGRA continuously since at least that date in connection with the services, namely live musical performances, of the musical group “La Migra.” Petitioner first used the mark LA MIGRA in commerce in the United States since at least as early as 1983 in connection with services, namely live musical performances, of the musical group “La Migra.” Petitioner has continuously used the mark LA MIGRA in commerce since the date of first use in connection with services, namely live musical performances, of the musical group “La Migra.”

2. Petitioner has used the mark LA MIGRA in connection with goods, namely a series of sound recordings, tapes, CDs and the like, since at least as early as 1983. Petitioner has used the mark LA MIGRA in commerce in the United States in connection with goods, namely a series of sound recordings, tapes, CDs and the like, since at least as early as 1983. Petitioner has continuously used the mark LA MIGRA in commerce in the United States since the date of first use in connection with goods, namely a series of sound recordings, tapes, CDs and the like.

3. Respondent J. Sergio Rios Gutierrez is an interloper who has no connection to Petitioner or Petitioner’s musical group “La Migra.” Respondent filed an application to register the mark GRUPO LA MIGRA (in English, “La Migra’ Group”), claiming a date of first use of October 2007. In November 2010, Respondent filed articles of incorporation for a corporation

with the name “El Sensacional Grupo La Migra, Inc.” (“the Sensational ‘La Migra’ Group”) with the California Secretary of State.

4. The GRUPO LA MIGRA mark wrongfully adopted, used and registered by Respondent is essentially identical to the LA MIGRA mark Petitioner has used for over thirty (30) years in connection with his musical group. The term “grupo” in Respondent’s mark means “group” in English. The name “La Migra” is the colloquial term in Spanish for “Immigration,” i.e. the U.S. Immigration & Naturalization Service, now known as USCIS or United States Citizenship and Immigration Service, and more particularly federal immigration enforcement officers of that agency. There is no meaningful difference between Respondent’s registered mark and Petitioner’s mark, since Petitioner’s musical group is referred to as a group or “grupo” in Spanish and is sometimes referred to as “Grupo La Migra” as well as “La Migra.”

5. Petitioner is the sole remaining member of “La Migra” and has owned the group and mark continuously since the date of the group’s inception and has used the LA MIGRA mark continuously to the present day since the date of first use in commerce in the United States in connection with the goods and services described above.

II. PRIORITY OF USE AND LIKELIHOOD OF CONFUSION (Lanham Act § 2(d))

6. Petitioner incorporates as though fully set forth herein all previous allegations of this Petition.

7. Petitioner is the prior user in commerce in the United States of the LA MIGRA name and mark in connection with goods, namely audio and audiovisual recordings, and services, namely live entertainment services of a musical group, having used the LA MIGRA name and mark continuously in commerce since at least as early as 1983.

8. Respondent filed his application to register the GRUPO LA MIGRA mark in November 2012, some thirty (30) years after Petitioner’s prior and exclusive use of the LA MIGRA mark in commerce.

9. The GRUPO LA MIGRA service mark that Respondent registered in September 2014 is essentially identical to the LA MIGRA marks that Petitioner has used in commerce in connection with the musical group “La Migra” since at least as early as 1983.

10. There is a likelihood of confusion between the GRUPO LA MIGRA mark that Respondent has registered and the LA MIGRA marks used by Petitioner in in commerce in connection with the goods and services of Petitioner’s musical group “La Migra,” given the fact that (a) the marks are essentially identical and (b) members of the public are likely to believe that Respondent’s goods and services are associated with the services of Petitioner’s musical group since Petitioner’s goods and services and the purported goods and services of Respondent flow in the same channels of trade, i.e. the marketplace for audio and audiovisual recordings and live performances of a musical group in the Regional Mexican and Spanish-language genres in the United States.

11. Petitioner’s LA MIGRA mark is symbolic of extensive good will and consumer recognition built up by Petitioner and his musical group “La Migra” in commerce over the course of decades.

12. Respondent’s intent in registering the GRUPO LA MIGRA mark was and is to profit from the public recognition, work and decades of effort of Petitioner’s musical group. Respondent’s registration of the GRUPO LA MIGRA mark was made in bad faith and for an improper purpose.

III. FALSE SUGGESTION OF SOURCE (Lanham Act § 2(a))

13. Petitioner incorporates as though fully set forth herein all previous allegations of this Petition.

14. Petitioner’s musical group La Migra is an institution in its own right. Since at least as early as 1989 up to the present time, the group’s sound recordings have been listed hundreds of times on the sales charts of Billboard magazine, the music industry bible in the

United States. There are numerous listings of the sound recordings, tracks, albums and compilations of Petitioner's musical group "La Migra" on internet sites such as amazon.com, many of which antedate the stated date of first use of the GRUPO LA MIGRA mark claimed by Respondent in his application herein. Petitioner's musical group has been advertised extensively throughout the United States since at least as early as 1983 to the present time.

15. The mark GRUPO LA MIGRA registered by Respondent is essentially identical to the name and identity of Petitioner's musical group "La Migra."

16. Petitioner is not connected with the goods and services that Respondent provides under Respondent's registered LA MIGRA mark. To the extent that Respondent asserts ownership of the mark that includes the words "La Migra," such activities constitute a usurpation of Petitioner's property, identity and name.

17. The name of Petitioner's group is of sufficient fame and reputation that when Respondent uses the GRUPO LA MIGRA mark in connection with Respondent's goods and services, a connection with Petitioner would be, and is, presumed.

18. Respondent's activities, including use of the wrongfully registered mark GRUPO LA MIGRA, falsely suggest a connection with Petitioner and Petitioner's musical group "La Migra."

IV. FRAUD

19. Petitioner incorporates as though fully set forth herein all previous allegations of this Petition.

20. Respondent's registration was obtained fraudulently in that in the formal application filed by Respondent under notice under 18 USC § 1001, Respondent declared as follows:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that

such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 15 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

21. The above statement by Respondent was and is false. At the time Respondent made the above declaration, he knew that (a) Petitioner was the owner of the mark LA MIGRA used in commerce in connection with goods, namely audio and audiovisual recordings, and services, namely the live performances of a musical group, (b) Petitioner was and is the senior user of the LA MIGRA mark, and (c) Respondent's applied for GRUPO LA MIGRA mark was and is confusingly similar to Petitioner's LA MIGRA mark.

22. Petitioner avers that Respondent's intent in applying for the registration of the GRUPO LA MIGRA mark was to obtain an advantage against Petitioner and Petitioner's musical group "La Migra," by reaping the benefit of the goodwill, reputation and public recognition of Petitioner's musical group and the LA MIGRA mark and by causing third parties to cancel engagements with Petitioner's musical group to Petitioner's damage and Respondent's economic benefit.

23. The false statements made by Respondent were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant the above-referenced

registration and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did in fact grant said registration to respondent.

24. Petitioner has been damaged by said false statements and the registration issued in reliance thereon in that Petitioner's musical group "La Migra" has used the LA MIGRA mark, including without limitation the stylized LA MIGRA mark and design, since at least as early as 1983 in connection with goods, namely audio and audiovisual recordings, and services, namely live entertainment services of a musical group, AND Petitioner's rights and continued and legal use of the LA MIGRA mark will be impaired by the continued registration of Respondent's mark, and have been impaired by Respondent's registration of the GRUPO LA MIGRA mark.

V. MISREPRESENTATION OF SOURCE (Lanham Act § 14)

25. Petitioner incorporates as though fully set forth herein all previous allegations of this Petition.

26. Respondent has blatantly misused the GRUPO LA MIGRA mark wrongfully registered by Respondent to trade on the goodwill and reputation of Petitioner and his musical group. This Respondent has done by using the GRUPO LA MIGRA mark to advertise the goods and services of Respondent's group, causing concert promoters, venue owners and members of the purchasing public to believe that services and goods rendered by Respondent are those of Petitioner and his musical group La Migra.

27. Respondent's activities include, without limitation, Facebook postings holding Respondent's musical group out as the authentic Grupo La Migra, seeking employment of Respondent's group as "Grupo La Migra," advertising and causing others to advertise the services of Respondent's group as those of "Grupo La Migra," without any substantive disclaimer or other advisory that the group advertised or marketed is not that of Petitioner.

28. The activities of Respondent are calculated to trade on Petitioner's goodwill and reputation at Petitioner's expense.

WHEREFORE, Petitioner hereby requests that Registration No. 4,607,981 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner under sections 2(d), 2(a) and 14 the Lanham Act, and for fraud in the procurement of Respondent's registration.

Dated: January 19, 2016

Respectfully submitted,

Carlos Martinez Somoza, an Individual
Petitioner

/stevenjeyre/

Steven J. Eyre
Attorney for Petitioner

Steven J. Eyre, Attorney at Law
3550 Wilshire Blvd., Ste 420
Los Angeles, CA 90010
Tel. 213.814.4416
Fax. 213.985.2159
Email: stevenjeyre@gmail.com

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document is being served on Respondent by mail at his address, as follows:

J. Sergio Rios Gutierrez
722 West 132nd St
Gardena, CA 90247
United States

Dated: January 19, 2016

/stevenjeyre/

Steven J. Eyre
Attorney for Petitioner

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