

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.

Response to Cancellation No.

In the Matter of

Reg. No. 4,607,981 - 85 770 819



02-26-2016

U.S. Patent & TMO/TM Mail Rpt Dt. #22

RESPONSE TO PETITION FOR CANCELLATION

This Response to 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 041 for "entertainment, namely, live performances by a musical band," with a claimed date and approved by UNITED STATES PATENT AND TRADEMARK OFFICE - of first use of October 31, 2007 and a claimed date of first use in commerce of November 22, 2007.

Respondent J. Sergio Rios Gutierrez, an Individual (hereinafter, "Respondent"), whose address is 722 West 132nd Street, Gardena, CA 90247, is owner of the musical group "GRUPO LA MIGRA" as well as the stylized mark LA MIGRA plus design used in connection with goods, namely and audiovisual recordings, and services, namely live entertainment services of a musical group, which Respondent'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 (Proof and evidence to follow during discovery). Respondent has filed an application with the United States Patent and Trademark Office to register the GRUPO LA MIGRA mark, Ser. No. 4,607,981, which "Published for Opposition" on May 7, 2013 (according to UNITED STATES PATENT & TRADEMARK OFFICE - publication), & was not opposed by Petitioner and/or any other parties.

The LA MIGRA mark as well as the stylized mark GRUPO LA MIGRA plus design used by Respondent and his musical group in commerce in the United States since at least as early as 1976 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 Petitioner has in Bad Faith, wrongfully, Fraudulently, and outside of UNITED STATES PATENT & TRADEMARK OFFICE rules & regulations wants to oppose Registration No. 4,607,981, registered on September 23, 2014 & owned by respondent J. Sergio Rios Gutierrez on basis of false allegations.

As grounds for this Response to the Cancellation request, it is a fact that:

I FACTUAL BACKGROUND

1. Respondent & his fellow group members to include but not limited to: Sacramento Gonzalez, Daniel Rodriguez, & Miguel Ramirez started the musical group "Grupo La Migra" in Mexico at least as early as 1975. Respondent has used the mark GRUPO LA MIGRA continuously since at least that date in connection with the services, namely live musical performances, of the musical group "Grupo La Migra." Respondent first used the mark GRUPO LA MIGRA in commerce in the United States since at least as early as 1976 in connection with services, namely live musical performances, of the musical group "Grupo La Migra." Respondent has continuously used the mark GRUPO LA MIGRA in commerce since the date of first use in connection with services, namely live musical performances, of the musical group "Grupo La Migra."

2. Respondent has used the mark GRUPO LA MIGRA in connection with goods, namely a series of sound recordings, tapes, CDs and the like, since at least as early as 1976. Respondent has used the mark GRUPO 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 1976. Respondent has continuously used the mark GRUPO 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, CD's, and the like.

3. Respondent J. Sergio Rios Gutierrez is the true, rightful, and only owner of **GRUPO LA MIGRA**, Registration No. 4,607,981, registered on September 23, 2014, per UNITED STATES PATENT & TRADEMARK OFFICE rules and regulations. Furthermore, 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 who approved the name, and the name was unopposed to present day.

4. The LA MIGRA mark wrongfully adopted, used and registered by Respondent is essentially identical to the GRUPO LA MIGRA mark Respondent 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 which is approved by UNITED STATES PATENT AND TRADEMARK OFFICE and unopposed by Petitioner. Respondent's (alleged) mark, since Respondent'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. Respondent is the sole remaining member of "Grupo La Migra" and has owned the group and mark continuously since the date of the group's inception and has used the GRUPO 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. Respondent incorporates as though fully set forth herein all previous facts of this Response.

7. Respondent is the prior user in commerce in the United States of the GRUPO 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 GRUPO LA MIGRA name and mark continuously in commerce since at least as early as 1976.

8. Respondent was first to file his application to register the GRUPO LA MIGRA mark in November 2012 which was unopposed by Petitioner; all parties had the opportunity to file their application within the last thirty (30) years after Respondent's prior and exclusive use of the GRUPO 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; however, marks that Respondent

has used in commerce in connection with the musical group "Grupo La Migra" since at least as early as 1976.

10. There is a proof positive facts that Respondent is the true, and only owner of GRUPO LA MIGRA; UNITED STATES PATENT AND TRADEMARK OFFICE, and the CALIFORNIA SECRETARY OF STATE approved, confirmed, and gave their blessings at the time registration and until present day. Respondent has registered and the GRUPO LA MIGRA marks used by Respondent in commerce in connection with the goods and services of Respondent's musical group "Grupo La Migra," given the fact that (a) the marks are essentially unique and do not provide any confusion of any active or pending "marks" at the time of application, and approval by UNITED STATES PATENT AND TRADEMARK OFFICE, and the CALIFORNIA SECRETARY OF STATE. Members of the public may at their sole discretion obtain ownership information on the public websites of UNITED STATES PATENT AND TRADEMARK OFFICE, and the CALIFORNIA SECRETARY OF STATE in order to confirm ownership of "marks" and registration. Respondent's goods and services are associated with the services of audio and audiovisual recordings and live performances of a musical group in the Regional Mexican and Spanish-language genres in the United States.

11. Respondent's GRUPO LA MIGRA mark is symbolic of extensive good will and consumer recognition built up by Respondent and his musical group "Grupo La Migra" in commerce over the course of decades.

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

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

13. Respondent incorporates as though fully set forth herein all previous facts of this Response.

14. Respondent's musical group "Grupo La Migra" is an institution in its own right. Since at least as early as 1976 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 in bible in the United States. There are numerous listings of the sound recordings, tracks, albums and compilations of Respondent's musical group "Grupo La Migra" on internet sites such, as amazon.com, many of which antedate the stated date of first use of the LA MIGRA mark claimed by Petitioner in his application herein. Respondent's musical group has been advertised extensively throughout the United States since at least as early as 1976 to the present time.

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

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

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

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

IV. FRAUD

19. Respondent incorporates as though fully set forth herein all previous facts of this Response.

20. Petitioner's application was obtained fraudulently in that in the formal application filed by Petitioner under notice under 18 USC § 1001, Petitioner 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, 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 Petitioner was and is false. At the time Petitioner made the above declaration, he knew that (a) Respondent was the registered owner of the mark GRUPO 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) Respondent was and is the only user of the GRUPO LA MIGRA mark, and (c) Petitioner's applied for LA MIGRA mark was and is confusingly similar to Respondent's GRUPO LA MIGRA mark.

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

23. The false statements made by Petitioner 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 accept Petitioner's application on January 1, 2013.

24. Respondent has been damaged by said false statements and the registration issued it reliance thereon in that Respondent's musical group "Grupo La Migra" has used the GRUPO LA MIGRA mark, -including without limitation the stylized GRUPO LA MIGRA mark and design, since at least as early as 1976 in connection with goods, namely audio and audiovisual recordings, and services, namely live entertainment services of a musical group, AND Respondent's rights and continued and legal use of the GRUPO LA MIGRA mark will be impaired by the continued registration of Petitioner's mark, and have been impaired by Petitioner's registration of the LA MIGRA mark.

V MISREPRESENTATION OF SOURCE (Lanham Act § 14)

25. Respondent incorporates as though fully set forth herein all previous facts of this Petition.

26. Petitioner has blatantly misused the LA MIGRA mark wrongfully registered by Petitioner to trade on the goodwill and reputation of Respondent and his musical group. This Petitioner has done so by using the 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 Petitioner are those of Respondent and his musical group GRUPO LA MIGRA.

27. Petitioner's activities include, without limitation, Facebook postings holding Petitioner's musical group made out as the authentic La Migra, seeking employment of Petitioner's group as "La Migra," advertising and causing others to advertise the services of

Petitioner's group as those of "La Migra," without any substantive disclaimer or other advisory that the group advertised or marketed is not that of Respondent.

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

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

Dated: February 25, 2016

Respectfully submitted,

J. Sergio Rios Gutierrez, an Individual
Respondent



J. Sergio Rios Gutierrez
722 West 132nd Street
Gardena, CA 90247

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document is being served on Petitioner, and Petitioner's Attorney by mail at his address, as follows:

Steven J. Eyre, Attorney at Law
3550 Wilshire Blvd., Ste 420
Los Angeles, CA 90010
Tel. 213.814.4416 Fax. 213.985.2159

Dated: February 25, 2016

ENRIQUE MORA E.M.