

ESTTA Tracking number: **ESTTA749234**

Filing date: **05/31/2016**

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

Proceeding	92063542
Party	Defendant Ramon Verduzco Martinez and Maximiliano Peraza Castro
Correspondence Address	RAMON VERDUZCO MARTINEZ 2075 OCEAN VIEW BLVD SAN DIEGO, CA 92113 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Steven J. Eyre
Filer's e-mail	stevenjeyre@gmail.com
Signature	/stevenjeyre/
Date	05/31/2016
Attachments	2016-05-31-Answer.pdf(217009 bytes)

Registration Subject to the filing

Registration No	4585035	Registration date	08/12/2014
Registrants	TIRADO, FERNANDO CAMACHO Av. Santa Rosa No. 3404, Col. Burócrata Mazatlán, Sinaloa, C.P.82163 MEXICO ARAMBURO, JULIO CESAR ARAMBURO Privada Simón Bolívar No. 59 Culiacán, Sinaloa, C.P.80040 MEXICO		

Goods/Services Subject to the filing

Class 009. First Use: 2013/01/14 First Use In Commerce: 2013/01/14 All goods and services in the class are requested, namely: Apparatus for recording, transmission or reproduction of sound or images; prerecorded magnetic data carriers featuring music; digital media, namely, compact discs, DVDs and downloadable audio files featuring music
Class 041. First Use: 2013/09/01 First Use In Commerce: 2013/09/01 All goods and services in the class are requested, namely: Entertainment in the nature of visual and audio performances by musical bands; entertainment, namely, live music concerts, live performances by a musical band; music production services

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

JULIO CESAR ARAMBURO ARAMBURO
and FERNANDO CAMACHO TIRADO,

Petitioners,

vs.

MAXIMILIANO PERAZA CASTRO and
RAMON VERDUZCO MARTINEZ,

Respondents.

Cancellation No. 92063542
In the Matter of
Registration No. 4,916,677

**ANSWER AND COUNTERCLAIM
FOR CANCELLATION OR
MODIFICATION**
Registration No. 4,585,035

REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION

Respondents and Registrants Maximiliano Peraza Castro and Ramon Verduzco Martinez ("Registrants"), by and through their counsel of record, hereby respond to the Petition for Cancellation of Petitioners Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado as follows:

1. Answering paragraph 1 of the Petition, Registrants deny that they claim an alleged date of first use in commerce of March 4, 2013; instead, Registrants claim an alleged date of first use in commerce at least as early as March 4, 2013. Registrants admit all other allegations of paragraph 1 of the Petition.
2. Answering paragraph 2 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.
3. Answering paragraph 3 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.

4. Answering paragraph 4 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.

5. Answering paragraph 4 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.

6. Answering paragraph 6 of the Petition, Registrants deny the allegations thereof.

a. Answering subparagraph 6.a. of the Petition, Registrants deny the allegations thereof;

b. Answering subparagraph 6.b. of the Petition, Registrants deny the allegations thereof;

c. Answering subparagraph 6.c. of the Petition, Registrants deny the allegations thereof;

d. Answering subparagraph 6.d. of the Petition, Registrants deny that the goods and services of Petitioners and Registrants are identical; Registrants deny the remainder of the allegations of paragraph 6.d. on information and belief;

e. Answering subparagraph 6.e. of the Petition, Registrants deny the allegations thereof on information and belief;

f. Answering subparagraph 6.f. of the Petition, Registrants deny the allegations thereof;

7. Answering paragraph 7 of the Petition, Registrants deny the allegations thereof on information and belief.

8. Answering paragraph 8 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.

9. Answering paragraph 9 of the Petition, Registrants do not have sufficient knowledge or information as to form a belief as to the truth or accuracy of the allegations contained therein and accordingly deny the allegations.

10. Answering paragraph 10 of the Petition, Registrants deny the allegations thereof.

11. Answering paragraph 11 of the Petition, Registrants deny the allegations thereof.

12. Answering paragraph 12 of the Petition, Registrants deny the allegations thereof on information and belief.

AFFIRMATIVE DEFENSES

Registrants assert the following affirmative defenses to the Petition for Cancellation or modification of Registration No. 4,585,035, registered on August 12, 2014 for the mark BANDA RANCHO VIEJO LA BANDONONONA Petitioners Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado:

1. Petitioners are barred from seeking cancellation of the Registrants' mark under the doctrines of laches, estoppel, waiver and unclean hands.

2. Petitioners have acquiesced in Registrants' adoption, registration and use of the mark that is the subject of the Petition for Cancellation.

3. Petitioners lack standing to assert trademark claims raised in their Petition for Cancellation, and are not and will not be damaged by the registration of Registrants' mark.

4. The term "BANDONONONA" is not the dominant term in Petitioners' mark, as demonstrated by the inconsistent use of the term in the specimens submitted by Petitioners in support of registration as well as the inconsistent use of the term both prior and subsequent to registration of Petitioners' mark.

5. The term "BANDONONONA," contrary to the assertion by Petitioners in their application for registration to the effect that the term has no meaning, is the hyper augmented form of the word "Banda" (the word "Band" in Spanish), is the equivalent of the phrase "super

duper band” in English, is descriptive, and is therefore entitled to limited or no protection vis-à-vis Registrants’ mark LA BANDONONONA CLAVE NUEVA DE MAX PERAZA.

6. Registrants’ registered mark and the alleged trademark registration cited in Petitioners’ Petition for Cancellation are different in sound, appearance and meaning and commercial impression.

7. Registration of Petitioners’ registered mark was obtained through mistake and negligent misrepresentation and is invalid.

Wherefore, Registrant prays that the Petition for Cancellation be dismissed in its entirety.

**COUNTERCLAIM FOR CANCELLATION, PARTIAL CANCELLATION OR
MODIFICATION OF REGISTRATION**

Registrants and Counterclaimants Maximiliano Peraza Castro and Ramon Verduzco Martinez (“Counterclaimants”), assert the following counterclaim for cancellation, partial cancellation or modification of U.S. Registration No. 4,585,035 issued to Counter-defendants Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado (hereinafter, “Counter-defendants”) on August 12, 2014, as follows:

1. Counter-defendants Maximiliano Peraza Castro and Ramon Verduzco Martinez were issued registration of the mark BANDA RANCHO VIEJO LA BANDONONONA on August 12, 2014, U.S. Registration No. 4,585,035 in spite of the following inconsistencies between the allegations in their application for registration and the specimens submitted in support of registration:

a. The specimen of use submitted in support of registration of Counter-defendants’ alleged mark in international class 009 for “apparatus for recording, transmission or reproduction of sound or images; prerecorded magnetic data carriers featuring music; digital media, namely, compact discs, DVDs and downloadable audio files featuring music” actually displays the marks BANDA RANCHO VIEJO DE JULIO ARAMBURO (“OLD RANCH BAND OF JULIO ARAMBURO”) or BANDA RANCHO VIEJO DE JULIO ARAMBURO LA

BANDONONONA (“OLD RANCH BAND OF JULIO ARAMBURO THE SUPER DUPER BAND”) and BANDA RANCHO VIEJO (“OLD RANCH BAND”). Nowhere in the specimen of use in international class 009 is the registered mark BANDA RANCHO VIEJO LA BANDONONONA shown.

b. The specimen of use submitted in support of registration of Counter-defendants’ alleged mark in international class 041 for “entertainment in the nature of visual and audio performances by musical bands; entertainment, namely, live music concerts, live performances by a musical band; music production services” actually displays the mark BANDA RANCHO VIEJO DE JULIO ARAMBURO (“OLD RANCH BAND OF JULIO ARAMBURO”) or BANDA RANCHO VIEJO DE JULIO ARAMBURO LA BANDONONONA (“OLD RANCH BAND OF JULIO ARAMBURO THE SUPER DUPER BAND”). Nowhere in the specimen of use in international class 041 is the registered mark BANDA RANCHO VIEJO LA BANDONONONA shown.

2. In each of the specimens cited above, the term “La Bandononona” (“the super duper band”) appears only as an honorific or appendage to the principal mark, which is shown as either BANDA RANCHO VIEJO or BANDA RANCHO VIEJO DE JULIO ARAMBURO.

3. The USPTO improperly issued U.S. Registration No. 4,585,035 to Counter-defendants, given the fact that the specimens of use did not show the mark that Counter-defendants applied to register.

4. In their application to register their mark and in subsequent response to office actions issued by the USPTO, counter-defendants claim that the term BANDONONONA has no significance nor is it a term of art in the relevant trade or industry. Counter-defendants also claim that the term BANDONONONA has no meaning in a foreign language. Those representations by counter-defendants are incorrect, if not misleading.

5. In point of fact, the term “Bandononona” is the hyper-augmented form of the word “Banda,” which means “band” in Spanish. The suffix “-ona” is used as an augmentative for a

word in the feminine gender in Spanish. Thus the augmented form of “Banda” becomes “Bandona,” the augmented form of the already-augmented term “Bandona” becomes “Bandonona,” and the augmented form of the twice-augmented term “Bandonona” becomes “Bandononona,” a hyper-augmented, descriptive and laudatory form of the word “Banda” that Counterclaimants and Counter-defendants both use in connection with their respective musical groups, although the use of the term by Counterclaimants is consistent and persistent, whilst the use of the term by Counter-defendants is inconsistent and irregular.

6. The best approximation of the term “Bandononona” in English is “super duper band,” an honorific or laudatory, but nevertheless descriptive, term.

7. The inconsistent use of the honorific or laudatory term “La Bandononona” by Counter-defendants further demonstrates that the mark serves as a descriptive term, and not as a dominant or even essential term of the mark that Counter-defendants actually use in commerce, as Counter-defendants demonstrate in the specimens of use submitted in support of registration.

8. Counter-defendants’ mischaracterization of the meaning, significance and usage of the term “Bandononona” in their application and response to office action, as well as Counter-defendants’ misrepresentations regarding the mark actually used and shown in their specimens of use, led to the wrongful issuance of U.S. Registration No. 4,585,035 to Counter-defendants for the mark BANDA RANCHO VIEJO LA BANDONONONA.

9. Counterclaimants are damaged, and will continue to be damaged, if Counter-defendants are permitted to continue with the registration of Registration No. 4,585,035 of the mark BANDA RANCHO VIEJO LA BANDONONONA in its current content and form, given the inaccuracies in the application and response to office action, the inconsistencies between the specimens of use and the applied-for mark, and the mischaracterization of the term “BANDONONONA” as a term without meaning in any language.

10. Under Section 18 of the Trademark Act, 15 U.S.C. § 1068, the Board has the authority to cancel registrations in whole or in part, to restrict the goods or services identified in an application or registration, or to otherwise restrict or rectify the registration of a registered mark.

WHEREFORE, Counterclaimants respectfully request as relief:

A. That the Board cancel Registration No. 4,585,035 of the mark BANDA RANCHO VIEJO LA BANDONONONA based upon the fact that specimens submitted in support of registration do not show the mark that Counter-defendants applied to register or that appears in the registration certificate;

B. As alternative and/or additional relief, that the Board modify Registration No. 4,585,035 to comport with the specimens of use submitted by Counter-defendants, showing that Counter-defendants' mark is in fact BANDA RANCHO VIEJO DE JULIO ARAMBURO or BANDA RANCHO VIEJO or BANDA RANCHO VIEJO DE JULIO ARAMBURO LA BANDONONONA;

C. As alternative and/or additional relief, that the Board rectify the material inaccuracies in the registration certificate of Registration No. 4,585,035 to show that the term "BANDONONONA" is the hyper-augmented form of the word "BANDA" and means "super duper band" in English;

D. As alternative and/or additional relief, that the Board modify the registration certificate of Registration No. 4,585,035 to show that Counter-defendants make no claim to the exclusive right to use the term "BANDONONONA."

Dated: May 31, 2016

Respectfully submitted

/stevenjeyre/

Steven J. Eyre
Attorney for Respondents and
Counterclaimants Maximiliano Peraza
Castro and Ramon Verduzco Martinez

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 a true copy of the foregoing **ANSWER AND COUNTERCLAIM FOR CANCELLATION OR MODIFICATION** was served on counsel for Petitioners and Counter-defendants this 31st day of May, 2016 by placing the same in an envelope and depositing in the U.S. mail addressed as follows:

John S. Egbert, Esq.
Egbert Law Offices, PLLC
1001 Texas, Ste 1250
Houston, TX 77002

/stevenjeyre/

Steven J. Eyre
Attorney for Respondents and
Counterclaimants