

ESTTA Tracking number: **ESTTA756927**

Filing date: **07/07/2016**

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

Proceeding	92063542
Party	Plaintiff Julio C. Aramburo and Fernando C. Tirado
Correspondence Address	JOHN S EGBERT EGBERT LAW OFFICES PLLC 1001 TEXAS, SUITE 1250 HOUSTON, TX 77002 UNITED STATES mail@egbertlawoffices.com
Submission	Other Motions/Papers
Filer's Name	John S. Egbert
Filer's e-mail	mail@egbertlawoffices.com
Signature	/2144-29/
Date	07/07/2016
Attachments	2144-29 Mtn to Dismiss Counterclaim and Amend Pleading.pdf(1034751 bytes )

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

In the Matter of Registration No. 4,916,677  
Registered on March 15, 2016

JULIO CESAR ARAMBURO ARAMBURO §  
and FERNANDO CAMACHO TIRADO §

Petitioners, §

v. §

Cancellation No. 92063542

Maximiliano Peraza Castro and §  
Ramon Verduzco Martinez §

Registrants. §

**PETITIONER'S MOTION TO DISMISS REGISTRANT'S COUNTERCLAIM FOR  
FAILURE TO STATE A CLAIM AND PETITIONER'S MOTION FOR LEAVE TO  
AMEND ITS PETITION FOR CANCELLATION**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, JULIO CESAR ARAMBURO ARAMBURO and FERNANDO CAMACHO TIRADO ("Petitioners"), through its undersigned attorneys, submits this Motion to Dismiss the Counterclaim filed by Maximiliano Peraza Castro and Ramon Verduzco Martinez ("Registrants") for failure to state a claim upon which relief can be granted.

Pursuant to 37 CFR 2.106(b)(2)(i) and TBMP § 507.02(b), Petitioners also hereby move for an Order granting leave to amend its Petition for Cancellation to add an additional common law trademark owned by Petitioners. Petitioners respectfully requests that the Board suspend this proceeding pending the resolution of this motion.

In support of this Motion, Petitioners state as follows:

## INTRODUCTION

On April 15, 2016, Petitioners filed their Petition for Cancellation, asserting a claim of priority and likelihood of confusion. To support their claims, Petitioners cited Federal Trademark Registration No. 4,585,035, as Petitioner's "BANDA RANCHO VIEJO LA BANDONONONA" mark.

On May 31, 2016, Registrants filed their Answer to the Petition for Cancellation with a Counterclaim against Trademark Registration No. 4,585,035.

On June 8, 2016, the Board issued an Order indicating that an Answer to Registrants' Counterclaim would be due July 8, 2016. Prior to the deadline to file an Answer to the Registrants' Counterclaim, Petitioners are filing the present Motion to Dismiss the Registrants' Counterclaim for failure to state a cause of action. As discussed further below, a valid ground for cancelling Petitioners' "BANDA RANCHO VIEJO LA BANDONONONA" mark has not been established. As a result, the Board should grant this Motion to Dismiss for Failure to State a Claim and dismiss the Registrants' Counterclaim.

Petitioners are also filing a Motion for Leave to Amend its Petition for Cancellation in order to include its common law "LA BANDONONONA" trademark as an additional basis upon which to cancel the Registrants' "LA BANDONONONA CLAVE NUEVA DE MAX PERAZA" trademark registration.

## ARGUMENTS

### I. Registrants Have Failed to State a Claim Upon Which Relief May Be Granted.

In order to state a claim upon which relief may be granted in a counterclaim, the Registrant must allege facts which, if proved, establish that (1) the Registrant has standing to challenge the

registration which the counterclaim is directed, and (2) that there is a valid ground for cancelling the registrant that is the subject of the counterclaim. *See* TBMP § 503.02; *see* Trademark Rule 2.112(a).

In the counterclaim at issue, the Registrants state that they will be damaged by the continued registration of Petitioners' "BANDA RANCHO VIEJO LA BANDONONONA" trademark registration. However, the Registrants never adequately alleges facts "which, if proved, would entitle the [Registrant] to the relief sought." *See, e.g., IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009). The approximately ten paragraphs that comprise Registrants' counterclaim fail to adequately plead a proper legal basis upon which cancellation may be sought.

The Registrants have not cited any statutory or legal grounds whatsoever upon which their counterclaim would be structured. Instead, the Registrants merely conclude that "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 otherwise restrict or rectify the registration of a registered mark." *See* [Registrants' Answer to Petitioner's Petition for Cancellation and Counterclaim, pg. 7, ¶ 10]. This wholly conclusory allegation fails to adequately plead a cause of action upon which a counterclaim may be structured. Furthermore, the Registrants' vague and nebulous allegations pertaining to the specimens Petitioners submitted to the USPTO do not constitute a cause of action upon which to file a counterclaim against Petitioners' trademark registration. *See* [Registrants' Answer to Petitioner's Petition for Cancellation and Counterclaim, pg. 4-7, ¶ 1-9]. Registrants' counterclaim violates the fair notice standard that is the proud hallmark of pleading requirements within American jurisprudence. Without understanding the cause of action Registrants are attempting to plead, Petitioners cannot possibly begin preparing a

defense of their trademark registration against this supposed counterclaim. Registrants' counterclaim should be dismissed for failure to state a claim upon which relief may be granted.

II. Petitioners' Motion for Leave to Amend the Petition for Cancellation Should be Granted.

Fed. R. Civ. P. 15(a) states that leave to amend "should be freely given when justice so requires." According to TBMP § 507.02, "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." Furthermore, the timing of the motion to amend is a "major factor" in the calculus. *See Media Online Inc. v. El Clasificado, Inc.*, 88 USPQ2d 1285 (TTAB 2008) [precedential].

Equity favors granting Petitioners' Motion for Leave to Amend the Petition for Cancellation. Petitioners have filed the present Motion for Leave to Amend its Petition for Cancellation just over a month after the Registrants filed their Answer and Counterclaim. The deadline by which to conduct the Discovery Conference in this case is about a month away, and the discovery period is not yet open. Given these facts, Petitioners did not unduly delay in filing its Motion for Leave to Amend the Petition for Cancellation. *See ChaCha Search, Inc.*, 105 USPQ2d at 1302. The requested amendment merely adds Petitioners' common law trademark to the Petition for Cancellation in addition to the trademark registration already identified in the Petition. Therefore, Registrants will not be prejudiced by the amendment. *See Hurley Intl., Inc.*, 82 USPQ2d at 1341.

CONCLUSION

For the foregoing reasons, it is evident that Registrants have not alleged facts that would, if proved, establish that it is entitled to the relief sought in any of its claims. *See TMEP* §503.02. For

this reason, Petitioners respectfully requests that the Board grant Petitioners' Motion to Dismiss for Failure to State a Claim and that Registrant's Counterclaim is dismissed with prejudice.

Furthermore, this Motion for Leave to Amend the Petition for Cancellation is being filed prior to the discovery period and prior to the Discovery Conference. As a result, Registrants would not suffer undue prejudice by permitting Petitioners to amend the Petition for Cancellation. Petitioners respectfully requests that the Board Grant its Motion for Leave to Amend the Petition for Cancellation in the form attached.

Respectfully submitted,

July 7, 2016  
Date

/2144-29/  
John S. Egbert  
Reg. No. 30,627  
Kevin S. Wilson  
Michael F. Swartz

Egbert Law Offices, PLLC  
1001 Texas, Suite 1250  
Houston, Texas 77002  
(713)224-8080  
(713)223-4873 (Fax)

ATTORNEYS FOR PETITIONERS  
JULIO CESAR ARAMBURO ARAMBURO and  
FERNANDO CAMACHO TIRADO



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

In the Matter of Registration No. 4,916,677  
Registered on March 15, 2016

JULIO CESAR ARAMBURO ARAMBURO §  
and FERNANDO CAMACHO TIRADO §

Petitioners, §

v. §

Cancellation No. 92063542

Maximiliano Peraza Castro and §  
Ramon Verduzco Martinez §

Registrants. §

**FIRST AMENDED PETITION FOR CANCELLATION**

The Petitioners, JULIO CESAR ARAMBURO ARAMBURO and FERNANDO CAMACHO TIRADO (hereinafter "Petitioners"), both individuals and citizens of Mexico, with JULIO CESAR ARAMBURO ARAMBURO having an address of Privada Simón Bolívar No. 59, Culiacán, Sinaloa MEXICO C.P.80040, and FERNANDO CAMACHO TIRADO having an address of Av. Santa Rosa No. 3404, Col. Burócrata, Mazatlán, Sinaloa MEXICO C.P.82163, believes it is and will be damaged by the continued registration of U.S. Registration 4,916,677 on the Principal Register and hereby petitions for cancellation of said registration.

As grounds for this petition, it is alleged that:

1. Upon information and belief, Maximiliano Peraza Castro and Ramon Verduzco Martinez (hereinafter "Registrants") are both individuals with an address of 2075 Ocean View Blvd, San Diego, CALIFORNIA UNITED STATES 92113. It is further believed that Maximiliano Peraza Castro is a citizen of Mexico and Ramon Verduzco Martinez is a citizen of the United States. Such individuals are listed as the owner of the "LA BANDONONONA CLAVE NUEVA DE MAX

PERAZA" Mark, U.S. Registration No. 4,916,677, registered on the Principal Register on March 15, 2016, for "Entertainment services in the nature of live audio performances by a musical band; Entertainment services in the nature of live musical performances; Entertainment services in the nature of live vocal performances by a musical band" in International Class 041 (hereinafter "Registrants' Mark"). Registrants have a constructive first use date of September 17, 2014, and Registrants claim an alleged date of first use in commerce of March 4, 2013.

2. Petitioners are leading entertainment artists and sellers of media featuring music in the United States in International Classes 9 and 41.

3. Commencing long prior to Registrants' alleged date of first use of Registrants' Mark in U.S. commerce of March 4, 2013, and long prior to the September 17, 2014 filing date of Registrants' Mark, Petitioners have engaged, and are now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of goods and services in International Class 009 and International Class 041 under Petitioners' "BANDA RANCHO VIEJO LA BANDONONONA" and "LA BANDONONONA" marks.

4. In connection therewith, Petitioners are the owner of the following marks:

- a. the "BANDA RANCHO VIEJO LA BANDONONONA" mark, U.S. Registration No. 4,585,035, filed on August 10, 2012, and registered on the Principal Register on August 12, 2014, 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" in International Class 009 and "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 International Class 041. *See* [Exhibit A, U.S. Reg. No. 4,585,035].

- b. the common law "LA BANDONONONA" mark used on media featuring music in International Class 009 and entertainment services in International Class 041 in the United States since at least as early as September 2011.

[Hereinafter collectively referred to as Petitioners' "LA BANDONONONA" Marks].

5. Petitioners' use of its "LA BANDONONONA" marks have been continuous, exclusive, public and substantial since a date of first use in commerce at least as early as September 2011.

6. Such first use date for Petitioners' "LA BANDONONONA" Marks is long prior to the September 17, 2014 constructive first use date of Registrants' "LA BANDONONONA CLAVE NUEVA DE MAX PERAZA" mark, Registration No. 4,916,677.

7. Registrants' Mark is confusingly similar to Petitioners' "LA BANDONONONA" Marks because:

- a. Registrants' mark is substantially similar in appearance to Petitioners' "LA BANDONONONA" Marks;
- b. Registrants' mark is substantially similar in sound to Petitioners' "LA BANDONONONA" Marks;
- c. Registrants' mark is confusingly similar in connotation to Petitioners' "LA BANDONONONA" Marks;

- d. the services of Petitioners and the goods and services of Registrants are identical and are marketed through the same channels of trade and to the same general class of consumers; and
- e. Petitioners' "LA BANDONONONA" Marks enjoy a high level of distinctiveness.
- f. The dominant term of Registrants' "LA BANDONONONA CLAVENUEVA DE MAX PERAZA" is the highly unusual term "BANDONONONA", which is identical to the dominant term in Petitioners' "LA BANDONONONA" Marks.

8. As a result of Petitioners' promotion and use of Petitioners' "LA BANDONONONA" Marks in connection with its goods and services, the trade and purchasing public have come to know and recognize Petitioners' "LA BANDONONONA" Marks and have associated the same with Petitioners and Petitioners' goods and services.

9. Petitioners' "LA BANDONONONA" Marks constitute the lawful, valued, subsisting, and exclusive property of Petitioners. As a result of the high quality of Petitioners' goods and services, and the extensive goods and services sold and advertised under Petitioners' "LA BANDONONONA" Marks, the aforementioned marks have become an intrinsic and essential part of the valuable goodwill and property of Petitioners and is recognizable and associated by the public as a symbol identifying and distinguishing Petitioners' goods and services as those of exceptional quality.

10. Registrants' Mark so resembles Petitioners' "LA BANDONONONA" Marks as to be likely to cause confusion or mistake, to suggest a connection, or to deceive purchasers into believing

that Registrants' services originate with Petitioners and/or are endorsed or sponsored by the Petitioners, and/or that Registrants and/or its services are otherwise affiliated with the Petitioners and its goods and services.

11. The continuing use by Registrants of the confusingly similar "LA BANDONONONA CLAVE NUEVA DE MAX PERAZA" mark will inexorably have an adverse effect upon the value of Petitioners' "LA BANDONONONA" Marks. If this Cancellation is not sustained, any defect, objection to, or fault found with Registrants' services rendered under Registrants' Mark would necessarily reflect on and seriously injure the valuable goodwill and reputation that Petitioners have established for its goods and services.

12. As a result of Petitioners' prior use of Petitioners' "LA BANDONONONA" Marks on identical services, Registrants' mark is not allowed to continue its registration under Section 2(d) of the Trademark Act and should be cancelled in this proceeding accordingly.

13. Based on the foregoing, the continued registration of U.S. Registration No. 4,916,677 for "LA BANDONONONA CLAVE NUEVA DE MAX PERAZA" for use on services in International Class 041 has, and will continue to, cause injury and damage to Petitioners.

WHEREFORE, Petitioners respectfully request that the Trademark Trial and Appeal Board cancel U.S. Registration No, 4,916,677 .

Petitioners have already submitted the requisite filing fee of \$300.00 for the Petition to Cancel Registrants' registration in International Class 041.

Respectfully submitted,

July 7, 2016  
Date

/2144-29/  
John S. Egbert  
Reg. No. 30,627  
Kevin S. Wilson  
Michael F. Swartz

Egbert Law Offices, PLLC  
1001 Texas, Suite 1250  
Houston, Texas 77002  
(713)224-8080  
(713)223-4873 (Fax)

ATTORNEYS FOR PETITIONERS  
JULIO CESAR ARAMBURO ARAMBURO and  
FERNANDO CAMACHO TIRADO

