

ESTTA Tracking number: **ESTTA761015**

Filing date: **07/27/2016**

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	STEVEN J EYRE 3550 WILSHIRE BLVD, SUITE 420 LOS ANGELES, CA 90010 UNITED STATES stevenjeyre@gmail.com
Submission	Other Motions/Papers
Filer's Name	Steven J. Eyre
Filer's e-mail	stevenjeyre@gmail.com
Signature	/stevenjeyre/
Date	07/27/2016
Attachments	2016-07-27-1250-Opposition to Motion to Dismiss.pdf(164504 bytes)

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

JULIO CESAR ARAMBURO ARAMBURO
and FERNANDO CAMACHO TIRADO,

Petitioners and Counterdefendants,

vs.

MAXIMILIANO PERAZA CASTRO and
RAMON VERDUZCO MARTINEZ,

Respondents and Counterclaimants.

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

Counterclaim for Cancellation or
Modification in the Matter of
Registration No. 4,585,035

OPPOSITION TO MOTION TO DISMISS

Respondents and Counterclaimants Maximiliano Peraza Castro and Ramon Verduzco Martinez (“Counterclaimants”), by and through their counsel of record, hereby oppose the Motion to Dismiss of Petitioners and Counter-defendants Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado (“Counter-defendants”) as follows:

1. Counter-defendants do not dispute Counterclaimants’ standing to bring the Counterclaim, as standing is inherent.
2. Counter-defendants Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado¹ claim that the Counterclaim fails to state a claim for which relief may be granted.
3. However, as Counterclaimants state in the Counterclaim, the applied-for and registered mark BANDA RANCHO VIEJO LA BANDONONONA appears in none of the specimens of use submitted in connection with Counter-defendants’ application and statement

¹ Petitioners and counter-defendants are inadvertently identified with the names of Respondents and Counterclaimants Maximiliano Peraza Castro and Ramon Verduzco Martinez on page 4, par. 1 of the Counterclaim filed on May 31, 2016. However, the context of that and the remaining paragraphs of the Counterclaim demonstrates that those allegations are intended to refer to Counter-defendants Julio Cesar Aramburo Aramburo and Fernando Camacho Tirado.

of use. (Counterclaim, pp. 4-5, ¶¶ 1, 1.a. and 1.b.) The specimens of use submitted by Counter-defendants in support of registration show two different marks, neither of which is the applied-for and registered mark.

4. Counterclaimants assert that the counter-defendants did not have a bona fide intention to use the mark as applied-for and as registered, given the evidence contained in the application file, which constitutes a valid ground for cancellation of the mark. TBMP § 309.03(c)(5).

5. Further, Counterclaimants argue that the fact that counter-defendants applied to register one mark while the specimens of use showed two different marks demonstrates that Counter-defendants tried to “split and the difference” and obtain a registration that would cover various iterations and additions to the mark, none of which were the applied-for mark itself. Counter-defendants’ actions were akin to the application for a phantom mark that seeks to represent multiple marks in a single application, which is a valid separate ground for cancellation of the mark. TBMP § 309.03(c)(10).

WHEREFORE, Counterclaimants respectfully submit that they have stated adequate claims for which relief may be granted, including either the cancellation of Counter-defendants’ mark or the modification to disclaim the term BANDONONONA as descriptive. If the Board sustains the 12(b)(6) motion of Counter-defendants, Counterclaimants respectfully request leave to amend their Counterclaim.

By the same token, should the Board grant Petitioners and Counter-defendants’ motion to amend their Petition herein, Counterclaimants also request leave to amend their Counterclaim herein in connection with Counterclaimants’ Answer to the Amended Petition.

Dated: July 27, 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 **OPPOSITION TO MOTION TO DISMISS** was served on counsel for Petitioners and Counter-defendants this 27th day of July, 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