

ESTTA Tracking number: **ESTTA812393**

Filing date: **04/07/2017**

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

Proceeding	92063674
Party	Defendant June Francis Rono, Ashley Kirsten C. Rono, and Justin Christian C. Rono
Correspondence Address	JAMES CAI SAC ATTORNEYS LLP 111 N MARKET STREET, SUITE 1020 SAN JOSE, CA 95113 UNITED STATES jcai@sacattorneys.com, mguedenet@sacattorneys.com, sgonza- lez@sacattorneys.com, jcai@sacattorneys.com
Submission	Opposition/Response to Motion
Filer's Name	James Cai
Filer's e-mail	jcai@sacattorneys.com
Signature	/s/ James Cai
Date	04/07/2017
Attachments	Opposition to MSJ.pdf(638402 bytes ) Decl. of June Rono.pdf(88542 bytes ) Decl. of James Cai.pdf(3768119 bytes ) Response to Separate Statement.pdf(796896 bytes ) RJN.pdf(2831040 bytes )

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

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KRISTEN  
C. RONO, AND JUSTIN CHRISTIAN C.  
RONO,

Registrants.

Cancellation No. 92063674

In the Matter of Registration No. 4,034,365

Mark: BARRIO FIESTA EXPRESS

Date Issued: October 4, 2011

*[Response to Separate Statement of  
Undisputed Facts; Request for Judicial  
Notice; Declaration of June Rono;  
Exhibits to Cai Declaration filed  
concurrently herewith]*

**REGISTRANTS' OPPOSITION TO PETITIONER'S MOTION**

**FOR SUMMARY JUDGMENT**

## TABLE OF CONTENTS

	Page(s)
INTRODUCTION.....	1
STATEMENT OF FACTS.....	1
LEGAL ARGUMENT.....	4
I. PETITIONER’S MOTION FOR SUMMARY JUDGMENT SHOULD BE DENIED.....	4
A. Petitioner and Barrio Fiesta Manufacturing Corporation are Distinct and Separate Entities and Petitioner Cannot Rely on Barrio Fiesta Manufacturing Corporation’s Alleged Use of the Mark Barrio Fiesta.....	4
B. Petitioner’s Reliance on <i>Grupo Gigante</i> and the “Famous Mark” Exception is Misplaced.....	5
C. Petitioner Has Not Shown Why It Is Entitled to the “Barrio Fiesta” Mark Created in the Philippines.....	6
D. Registrants Need Not Prove Prior Use of the Mark “Barrio Fiesta” To Survive a Motion For Summary Judgment.....	6
E. Barrio Fiesta Manufacturing Corporation’s Own Trademark Application States No Use in the United States as Late as 2013.....	8
F. Petitioner Cannot Establish That It Has Conducted Sufficient Business To Penetrate The Market In All 50 States Prior To 2011.....	10
G. Petitioner Cannot Establish That It More Than A de minimus Use In All 50 States Prior To 2011.....	11
H. Whether Barrio Fiesta Manufacturing Corporation’s Mark Of “Barrio Fiesta” Is A “Well-Known Mark” Is A Question of Fact.....	13
I. Registrants Have Never Attempted to Associate Themselves With The Ongpaucos.....	15
CONCLUSION.....	16

## TABLE OF CONTENTS

### Cases

	Page(s)
<i>Allard Enterprises, Inc. v. Advanced Programming Resources, Inc.</i> 249 F.3d 564, 567 (6th Cir. 2001).....	7
<i>Architemps, Inc. v. Architemps, Ltd.</i> , 704 F. Supp. 39 (S.D.N.Y. 1988).....	7
<i>Bayer Consumer Care AG v. Belmora LLC</i> , 90 USPQ2d 1587(TTAB 2009).....	5
<i>Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.</i> , 174 F.3d 1036 (9th Cir.1999).....	7
<i>Brother Records, Inc. v. Jardine</i> , 318 F.3d 900 (9th Cir. 2003).....	4
<i>Casual Corner Associates, Inc. v. Casual Stores of Nevada, Inc.</i> , 493 F.2d 709 (9th Cir.1974).....	7
<i>Chance v. Pac-Tel Teletrac Inc.</i> , 242 F.3d 1151, 1157 (9th Cir.2001).....	11
<i>Coca-Cola Co. v. Overland, Inc.</i> , 692 F.2d 1250 (9th Cir.1982).....	7
<i>Crystal Entertainment &amp; Filmworks, Inc. v. Jurado</i> , 643 F.3d 1313, 1322 (11th Cir. 2011).....	11
<i>Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.</i> 841 F.Supp. 1339 (1961).....	7
<i>Elder Mfg. Co. v. International Shoe Co.</i> , 194 F.2d 114, 118 (1952).....	11
<i>Entrepreneur Media, Inc. v. Smith</i> , 279 F.3d 1135 (9th Cir.2002).....	4

<i>Giant Food, Inc. v. Standard Terry Mills, Inc.</i> , 229 USPQ 955, 962 (TTAB 1986).....	15
<i>Glow Indus., Inc. v. Lopez</i> , 252 F.Supp.2d 962, 981 (C.D.Cal.2002).....	12
<i>Grupo Gigante SA De CV v. Dallo &amp; Co., Inc.</i> , 391 F.3d 1088. (9th Cir. 2004).....	13, 14
<i>ITC Ltd. V. Punchgini, Inc.</i> , 482F.3d 135 (2 <sup>nd</sup> Cir. 2007).....	5
<i>Llyod's Food Prods. Inc. v. Eli's Inc.</i> , 987 F.2d 766, 767 (Fed. Cir. 1993).....	4
<i>Natural Footwear, Ltd. v. Hart, Schaffner &amp; Marx</i> , 760 F. Supp. 1383 (3rd Cir. 1985).....	7
<i>Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.</i> , 69 F. Supp. 3d 175, 204 (D.D.C. 2014).....	13
<i>Quiksilver, Inc. v. Kymsta Corp.</i> , 466 F.3d 749 (9th Cir.2006).....	7
<i>Rolley, Inc. v. Younghusband</i> , 204 F.2d 209 (9th Cir.1953).....	6
<i>Sengoku Works Ltd. v. RMC Itern., Ltd.</i> 96 F.3d 1217, 1219 (9th Cir. 1996).....	6
<i>Smith v. Ames Dept. Stores, Inc.</i> , 172 F. 3d. 860 (3d Cir. 1998).....	12
<i>Sweetarts v. Sunline, Inc.</i> , 380 F.2d 923, 929 (8th Cir. 1967).....	12
<i>V &amp; V Food Products, Inc. v. Cacique Cheese Co., Inc.</i> , 683 F. Supp. 662 (6th Cir. 2001).....	8
<i>Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc.</i> , 220 U.S.P.Q. 740, 742 (T.T.A.B. 1983).....	4

<i>Vuitton et Fils S.A. v. J. Young Enterprises,</i> 644 F.2d 769 (9th Cir.1981).....	6
--	---

<i>Weiner King, Inc., v. Weiner King Corp.,</i> 615 F.2d 512 (1980).....	6
---	---

## **Federal Rules & Statutes**

15 U.S.C. § 1057.....	6
-----------------------	---

15 U.S.C. § 1115.....	6
-----------------------	---

Fed.R.Civ.P. 56.....	4
----------------------	---

## **INTRODUCTION**

June Rono, Ashley Rono and Justin Rono (the Registrants) are the holders of the federally registered mark “Barrio Fiesta Express” registration number 4034365 (‘365 Mark) and as such there is a presumption that Registrants have exclusive rights to use the mark Barrio Fiesta throughout the entire United States. It is the Petitioner’s burden to rebut this presumption. Even if Petitioner can prove prior use in the Philippines and an isolated and remote use in the Los Angeles, California area, that use would not grant Petitioner exclusive rights to use the mark Barrio Fiesta in the United States and certainly not as grounds to cancel Registrants’ mark. Assuming, without admitting, that even if Petitioner were found to have established common law trademark rights based on prior use in the local Los Angeles area, her right to use the mark would be limited only to that local Los Angeles market, while Registrants would be entitled to exclusive use of the mark in all other areas of the United States. For the reasons stated below, Petitioner’s motion for summary judgment must be denied.

## **STATEMENT OF FACTS**

The ‘365 Mark was issued on October 4, 2011 and is held by the Registrants. [Petitioner’s Facts ¶ 21]. Registrant June Rono had only had a limited understanding of Barrio Fiesta Manufacturing Corporation at the time he purchased the Barrio Fiesta restaurant in Milpitas. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 11-15)]. At the time June Rono purchased the Barrio Fiesta restaurant, he believed it to be the only operational restaurant using the mark Barrio Fiesta in the United States. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 8) & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 2 (June Depo. 142: 3-7))]. June Rono was not aware that Barrio Fiesta Manufacturing Corporation was importing products in any sort of significant quantity at the time

he purchased the Barrio Fiesta Restaurant in Milpitas, California. [Decl. of Cai Ex. 2 (Decl. of Cai Ex. 2 (June Depo. 157: 4-9))] (“Q: Were you aware at the time that you purchased the Milpitas restaurant of the products that were being imported into the United States by Barrio Fiesta Manufacturing Corporation? A: In 2011, I don’t recall that I was aware of their products at that time.”)]. It was not until late 2012 that June Rono became aware of Northridge Foods International, Inc.’s importation of products bearing the mark Barrio Fiesta. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 14)].

June Rono has never sought to intentionally or otherwise associate himself, his restaurants or products with the Ongpaucio Family brand of the Philippines or any associated mark. [Decl. of Rono ¶ 7]. If customers ask if Barrio Fiesta Express (the Milpitas/San Jose Restaurants or its products) are an affiliate or otherwise associated with the Barrio Fiesta restaurants in the Philippines, June Rono and his staff have always been very clear that they are not. [Decl. of Rono ¶ 8]. To the extent that June Rono continued to use the signage and menus from the Milpitas Restaurant, it was not done to associate with the Ongpaucio Family brand, but rather done for cost reasons because that is the way he purchased the restaurant and it was and is his understanding that all of the signage and logos were included with the purchase agreement. [Decl. of Rono ¶ 6]. Subsequently to purchasing the Milpitas Restaurant, June Rono had his own logo designed and created, which is displayed in the San Jose Restaurant and on the menus for both restaurants. [Decl. of Rono ¶ 6]. After purchasing the Milpitas restaurant, June Rono began expanding the restaurant into a chain, introduced a “take-out” option and began selling packaged foods bearing the mark Barrio Fiesta. [Decl. of Rono ¶¶ 9, 11]. June Rono undertook all of these

expansion efforts of the name and mark Barrio Fiesta Express without regard to the Ongpaucos alleged brand. [Decl. of Rono ¶ 10].

On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce in the United States. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)].

## LEGAL ARGUMENT

### I.

#### PETITIONER'S MOTION FOR SUMMARY JUDGMENT SHOULD BE DENIED

"Because of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena." *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 903 (9th Cir. 2003); *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir.2002) (Emphasis added). A court should only grant summary judgment if the pleadings and supporting documents, "show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). On a motion for summary judgment, the "non-moving party is not required to adduce evidence sufficient to prove its case..."; it only need show "that there is a genuine issue as to a material fact and that, therefore, there is a need for a trial." *Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc.*, 220 U.S.P.Q. 740, 742 (T.T.A.B. 1983). The evidence should be viewed in a light most favorable to the nonmoving party, and all justifiable inferences should be drawn in non-movant's favor. *Llyod's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993).

**A. Petitioner and Barrio Fiesta Manufacturing Corporation are Distinct and Separate Entities and Petitioner Cannot Rely on Barrio Fiesta Manufacturing Corporation's Alleged Use of the Mark Barrio Fiesta**

It is undisputed that Petitioner Consuelo Ongpauco-Cauton's sole alleged use of the Barrio Fiesta mark is a single restaurant located in the Los Angeles, California area. Petitioner seeks to piggyback on the alleged use of the mark Barrio Fiesta by Barrio Fiesta Manufacturing Corporation, this is not appropriate. Petitioner must show her own use and her own claim to the

name and mark Barrio Fiesta if she is to be successful in her motion for summary judgment seeking to cancel Registrants '365 Mark. Petitioner and Barrio Fiesta Manufacturing Corporation both seek exclusive rights of the mark and yet seem to be implying that each can benefit from the other's use of the mark and attribute that use as if it were their own. This is not the standard.

**B. Petitioner's Reliance on *Grupo Gigante* and the "Famous Mark" Exception is Misplaced**

Petitioner's cancellation request is based entirely on the Famous Mark exception and the holding of *Grupo Gigante* that a foreign mark holder need not even use the mark in the United States if that foreign mark has reached a certain level of in the United States. However, this argument is the minority view and has also already been rejected by the TTAB as an independent ground for cancellation of a federally registered mark. See *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009) (Section 44 of the Trademark Act does not afford the owner of a foreign trademark a separate basis for cancellation under a "famous mark" theory.) See also *ITC Ltd. V. Punchgini, Inc.*, 482F.3d 135 (2<sup>nd</sup> Cir. 2007) (federal law does not recognize a "famous mark" exception).

Therefore, in order to prevail on her cancellation action, Petitioner's failed assertion that she is the holder of a famous foreign mark is irrelevant. Rather she must show, prior to the registration of the '365 Mark that she had common law rights which would entirely trump any federal rights received by Registrants when they registered the mark in 2011. Petitioner simply cannot meet this burden.

**C. Petitioner Has Not Shown Why She Is Entitled to the “Barrio Fiesta” Mark Created in the Philippines.**

Petitioner has not even alleged that she has an agreement, license or has otherwise obtained the right to use the mark Barrio Fiesta created in the Philippines by the matriarch of the Ongpauco family (Sixta-Evagelista Ongpauco). Rather, Petitioner states in conclusory fashion that she is the true holder of the mark. However, Petitioner’s own moving papers are conflicting on this assertion as Petitioner and Barrio Fiesta Manufacturing Corporation, who are independent entities, are both claiming exclusive ownership of the same mark and yet neither has obtained a federally registered mark, whereas Registrants have done so. Therefore, any rights obtained by either Petitioner or Barrio Fiesta Manufacturing Corporation were obtained through common law and are subordinate to the rights of Registrants.

**D. Registrants Need Not Prove Prior Use Of The Mark “Barrio Fiesta” To Survive a Motion For Summary Judgment**

When proving ownership of a trademark, federal registration of the mark is prima facie evidence that the registrant is the owner of the mark. Lanham Act § 7(b), 15 U.S.C. § 1057(b); Lanham Act § 33(a), 15 U.S.C. § 1115(a). Therefore, the registrant is granted a presumption of ownership, dating to the filing date of the application for federal registration, and the challenger must overcome this presumption by a preponderance of the evidence. *Vuitton et Fils S.A. v. J. Young Enterprises*, 644 F.2d 769, 775–76 (9th Cir.1981); *Rolley, Inc. v. Younghusband*, 204 F.2d 209 (9th Cir.1953); *Sengoku Works Ltd. v. RMC Intern., Ltd.* 96 F.3d 1217, 1219 (9th Cir. 1996).

“There is a policy of encouraging prompt registration of marks by rewarding those who first seek registration under the Lanham Act.” *Weiner King, Inc., v. Weiner King Corp.*, 615 F.2d 512, 523 (1980). Federal registration of a trademark ‘constitutes prima facie evidence of the

validity of the registered mark and of [the registrant's] exclusive right to use the mark' in commerce." *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 755 (9th Cir.2006) (quoting *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1047 (9th Cir.1999); see also *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir.1982) (noting "[f]ederal registration of a trademark endows it with a strong presumption of validity.")).

To prevail over a junior user who is a registrant, a common law senior user must show continuous use prior to the date of the junior user's trademark registration. *Casual Corner Associates, Inc. v. Casual Stores of Nevada, Inc.*, 493 F.2d 709 (9th Cir.1974). In order to prevail on prior use defense to a trademark infringement claim, defendant claiming to be senior user must demonstrate present rights in the mark, acquired prior to the date of registration, continual use of the mark since that date, and use prior to registrant on good or services that are in issue. *Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.* 841 F.Supp. 1339 (1961).

"In the case in which a junior user applies for registration, however, the extent of the senior user/non-registrant's territory is frozen as of the date of actual registration to the junior user." *Allard Enterprises, Inc. v. Advanced Programming Resources, Inc.* 249 F.3d 564, 567 (6th Cir. 2001). The senior user/nonregistrant may retain exclusive rights only in the territory of its actual market penetration as of the date of the junior user's federal registration. *Natural Footwear, Ltd. v. Hart, Schaffner & Marx*, 760 F. Supp. 1383 (3rd Cir. 1985). See *Architemps, Inc. v. Architemps, Ltd.*, 704 F. Supp. 39 (S.D.N.Y. 1988). (Senior user/nonregistrant in New York must prove use in California predating Chicago junior user's federal registration in order to have exclusive rights in California. The senior user-non-registrant's rights are limited to those areas in which it established itself prior to plaintiff's registration; the junior user-federal

registrant has superior rights as to areas in which neither party has yet expanded.) The senior user can only establish prior common law rights in states where it made sales prior to the junior user's federal registration date; the junior user-registrant is presumed to have exclusive rights throughout the United States, even in territories in which it is not trading, except for the territories of the senior user's prior use. *V & V Food Products, Inc. v. Cacique Cheese Co., Inc.*, 683 F. Supp. 662 (6th Cir. 2001).

Based on the evidence provided by Petitioner, which at best shows the operation of a single restaurant in the Los Angeles, California area, Petitioner has not met her burden to show that she is entitled to summary judgment. Even assuming that Petitioner has priority of use in the local Los Angeles, California market at the time the '365 Mark was registered, Petitioner's limited area in which she had prior use would be frozen at the time the '365 Mark was registered. The burden to establish the exception to the general rule that a holder of a registered mark is presumed to have nationwide priority, rests upon the challenger claiming to be a senior user of the registered mark. Petitioner has not met this burden and certainly cannot use the same as grounds to cancel Registrants' '365 Mark.

**E. Barrio Fiesta Manufacturing Corporation's Own Trademark Application States No Use in the United States as Late as 2013**

The evidence submitted by Petitioner is directly contradicted by Barrio Fiesta Manufacturing Corporation's own application with the United States Patent and Appeal Board. On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark "Barrio Fiesta" (serial number 85384724). [Plaintiff's RJN Ex. A & Decl. of

Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff's RJN Ex. A & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce in the United States. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. B & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. C & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation's mark "Barrio Fiesta" (serial number 85384724) for failing to submit a statement of use. [Plaintiff's RJN Ex. D & Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)].

On one hand, Barrio Fiesta Manufacturing Corporation claims its products have been sold in all 50 states at the time June Rono purchased the Barrio Fiesta restaurant and subsequently registered the mark Barrio Fiesta Express in 2011 and on the other hand has submitted an application with the United States Patent and Trademark Office, under the penalty of perjury, stating that as of September 30, 2013, products were still not being used in commerce in the United States. Therefore, Petitioner's motion for summary judgment must be denied as there is a triable issue of material fact regarding the degree to which, if any, Barrio Fiesta Manufacturing Corporation's products were actually distributed throughout the United States and whether those products sufficiently penetrated the relevant markets as will be discussed below.

**F. Petitioner Cannot Establish That It Has Conducted Sufficient Business To Penetrate The Market In All 50 States Prior To 2011**

In order for Petitioner to show that she has retained common law trademark rights throughout the entire United States prior to registration of the '365 Mark, she must show that she had sufficiently penetrated all 50 States with sales of Barrio Fiesta products by that time. Even assuming that Petitioner can show priority of use in some parts the United States, it is not enough to grant protectable rights throughout the entire United States which would warrant the cancellation of Registrants' '365 Mark. The Petitioner must show actual use in each market in which it claims priority. Petitioner cannot do this as her only alleged use is a single restaurant in the Los Angeles area.

In support of her motion for summary judgment, Petitioner relies on the deposition of Erwin Santos to conclusory establish that Barrio Fiesta branded products produced by Barrio Fiesta Manufacturing Corporation had been distributed to all 50 states by 2011. [Decl. of Avanzado Ex. 3 (Avanzado Ex. C (Erwin Santos Depo. 17:22-18:5, 18:6-11))]. However, Petitioner has failed to produce any supporting documentation to support this claim or to support the volume of sales to each state to show a sufficient level of market penetration, which is her burden. Without supporting documentary evidence, it is very difficult to determine the volume of Petitioner's products being shipped to every state and if those shipments have been continuous in all 50 states. This is especially true in light of the fact that Mr. Santos' business is a retail grocery store in New Jersey (Phil-Am Food) and not a bona fide distributor of Barrio Fiesta products. Out of Phil-Am Food's entire inventory, only two to three percent of that inventory are products

bearing the mark Barrio Fiesta. [Decl. of Avanzado Ex. 3 (Avenzado Ex. C (Erwin Santos Depo. 28: 7-15))].

While testimony of a single witness can be sufficient, corroboration is usually needed. *Crystal Entertainment & Filmworks, Inc. v. Jurado*, 643 F.3d 1313, 1322 (11th Cir. 2011). “Oral testimony is obviously strengthened by corroborative documentary evidence.” *Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 118 (1952).

Here, Petitioner has not provided documentary evidence, rather, Petitioner has provided only declarations about the alleged product use with no mention of sale volume in general or a specific break down of sales to each individual state. If Petitioner had corroborative documentary evidence, it would have necessarily been included in its motion for summary judgment. By failing to produce records of sales in each state, there is a strong presumption that those records do not exist or that the sales in those markets were *de minimus* if existent at all.

**G. Petitioner Cannot Establish That It Has More Than A *de minimus* Use In All 50 States Prior To 2011**

Even assuming that Barrio Fiesta Manufacturing Corporation products have been distributed to all 50 states, the analysis is far from over. Petitioner must show that there is sufficient market penetration in each state, prior to the registration of the Barrio Fiesta Express mark to acquire protectable common law rights as Petitioner does not possess a federally registered mark. Again, Petitioner cannot rely on Barrio Manufacturing Corporation’s alleged use and cannot show more than use in a single restaurant in Los Angeles, California.

The use necessary to acquire protectable rights is more than token or *de minimus* use. See *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1157 (9th Cir.2001). The use of the mark must

be “sufficiently public” that the marked goods are “identified or distinguish[ed] ... in an appropriate segment of the public mind as those of [the adopter of the mark].” *Glow Indus., Inc. v. Lopez*, 252 F.Supp.2d 962, 981 (C.D.Cal.2002). (noting that, although plaintiff is likely to establish itself as the senior user of a mark, it must also demonstrate legally sufficient market penetration “to establish a likelihood of success on the merits”). *Id.* at 983.

A party asserting common law rights must not only establish that it is the senior user, it must also show that it has “legally sufficient market penetration” in a certain geographic market to establish those trademark rights. *Glow Industries, Inc. v. Lopez*, 252 F.Supp.2d 962, 983 (C.D.Cal.2002). Sufficient market penetration is determined by “examining the trademark user's volume of sales and growth, number of persons buying the trademarked product in relation to the number of potential purchasers, and the amount of advertising” in a given market. *Id.* In many states transactions were “nonexistent or so small, sporadic, and inconsequential that present or anticipated market penetration is de minimus.” *Sweetarts v. Sunline, Inc.*, 380 F.2d 923, 929 (8th Cir. 1967). See *Smith v. Ames Dept. Stores, Inc.*, 172 F. 3d. 860 (3d Cir. 1998) (Sale of 552 shirts and 324 hats geographically dispersed across 16 stores in seven states did not achieve priority because “these sales do not come close to the minimum level necessary to achieve market penetration.”) Petitioner has not established that there is sufficient market penetration in all 50 states that afford it with protectable rights in each market and as a grounds to cancel the ‘365 Mark.

**H. Whether Barrio Fiesta Manufacturing Corporation's Mark Of "Barrio Fiesta" Is A "Well-Known Mark" Is A Question of Fact**

To be "well-known," the Ninth Circuit held that a mark had to have more than just a "secondary meaning" in the relevant U.S. market: it had to be familiar or known to a "substantial percentage" of persons on the relevant American market. *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088. (9th Cir. 2004). In *Grupo*, the appellate court remanded for factual findings on the issue of whether the mark was "well-known."

To determine whether a mark is well-known, one court noted the appropriate threshold percentage of recognition "should be somewhere below, but still very close to, 50% of consumers in the relevant market. See *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.*, 69 F. Supp. 3d 175, 204 (D.D.C. 2014). Judge Graber also stated in the concurring opinion in *Grupo* that she thought a showing of 20%-22% recognition did not prove that the mark was well-known among a "significant" or "substantial percentage" of the market. *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088. (9th Cir. 2004).

Petitioner has submitted no evidence to support the contention that Barrio Fiesta Manufacturing Corporation's mark is in fact a "well-known" mark. In support of this contention, Petitioner relies on June Rono's personal views of the mark "Barrio Fiesta." However, June Rono's personal view of the mark is far from determinative. Petitioner must show that a substantial percentage of persons in the relevant American market are familiar with the mark. Petitioner has not done this. Further, Petitioner relies on the Declaration of the Alianan to show that the mark is famous in the Philippines because the mark has been published in a book entitled "Philippines Greatest Brands." [Decl. of Avanzado Ex. 1 (Decl. of Alianan ¶ 6 & Ex. B)]. Again,

this evidence is insufficient to show that Petitioner's use of their mark Barrio Fiesta constitutes a well-known mark in the relevant American markets.

Grupo provides an instructive analysis of this. "Assume, for example, that Grupo Gigante had been using the mark in Arizona as well as in various parts of Mexico, and that it had met all other requirements of having a protectable interest in the mark, including having established a secondary meaning throughout Arizona. If the Dallos later began using the same mark in San Diego without knowledge of Grupo Gigante's earlier "remote" use in Arizona, whether Grupo Gigante could stop them would depend on what the mark meant to consumers in San Diego...Grupo Gigante would have priority in San Diego, and thus be able to stop the Dallos' use of the mark, only if the secondary meaning from Grupo Gigante's use of the mark in Arizona extended to San Diego as well. If on the other hand, the secondary meaning from Grupo Gigante's use were limited to Arizona, then the Dallos might be free to continue using the mark in San Diego." *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1097. (9th Cir. 2004).

Based on the evidence presented by the Petitioner, there has only been a showing of a remote use of the mark Barrio Fiesta in Los Angeles prior to the registration of the mark Barrio Fiesta Express, therefore, under no circumstance is the Petitioner entitled to nationwide protection or cancellation of the '365 Mark. There is an issue of material fact as to whether the Petitioner's use of the mark Barrio Fiesta is well-known in America and if it is, in which market(s) is it well-known. For the foregoing reasons, Petitioner's motion for summary judgment should be denied.

**I. Registrants Have Never Attempted to Associate Themselves With The Ongpauco**

As discussed above and detailed in the Declarations of June Rono, the Registrants have never sought to take advantage of the Ongpauco. June Rono was not aware of Consuelo Ongpauco-Cauton's restaurant at the time he purchased the Milpitas Barrio Fiesta Restaurant and was not aware that Petitioner (Barrio Fiesta Manufacturing Corporation) was importing products into the United States (if they actually were importing any such products into the United States) until late 2012 and is what led to the pending Federal Lawsuit. The Registrants vehemently deny any allegation or implication by the Petitioner that they are somehow improperly taking advantage of the Ongpauco's Family brand. June Rono simply registered the mark Barrio Fiesta Express after he purchased the Milpitas Restaurant to continue to develop and expand his own brand, which he has and hopes to continue to do.

To the extent that Petitioner is implying bad faith on the part of Registrants and June Rono, those allegations have already been refuted. Further, there is no doubt a dispute of material fact as to Registrants' understanding and knowledge of the Ongpauco's claimed mark at the time Registrants registered the '365 Mark. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 962 (TTAB 1986) (summary judgment is notoriously inappropriate for determination of claims in which issues of intent, good faith and other subjective feelings play dominant roles).

## **CONCLUSION**

For all the reasons stated above, Petitioner Consuelo Ongpauco-Cauton's motion for summary judgment must be denied.

Date: April 6, 2017

SAC Attorneys, LLP

/S/JAMES CAI

James Cai, Esq.  
Attorney for Registrants

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REGISTRANTS' OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served on counsel for petitioner on April 7, 2017, by sending the same via FEDEX overnight delivery, to:

Melvin N.A. Avanzado  
THE AVANZADO LAW FIRM  
1880 Century Park East, Suite 1100  
Los Angeles, CA 90067

/S/ JAMES CAI  
James Cai, Esq.  
Attorney for Registrants

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

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KRISTEN  
C. RONO, AND JUSTIN CHRISTIAN C.  
RONO,

Registrants.

Cancellation No. 92063674

In the Matter of Registration No. 4,034,365

Mark: BARRIO FIESTA EXPRESS

Date Issued: October 4, 2011

*[Opposition to Motion for Summary  
Judgment; Request for Judicial Notice;  
Response to Separate Statement of  
Undisputed Fact; Exhibits to Cai  
Declaration filed concurrently herewith]*

**SIGNATURE VIA FAX**

**DECLARATION OF JUNE RONO IN SUPPORT OF REGISTRANTS' OPPOSITION  
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT**


I, June Rono, declare as follows:

1. I am over 18 years of age and I have personal knowledge of the facts contained in this declaration and, if called, could and would testify competently thereto under oath.
2. I am the CEO and sole shareholder of Barrio Fiesta, LLC, who is the Plaintiff in a lawsuit pending before the United States District Court for the Northern District of California, Case Number 4:15-cv-02669 (the "Federal Lawsuit") entitled *Barrio Fiesta, LLC v. Northridge Foods International, Inc.*
3. I am also one of the Registrants of the BARRIO FIESTA EXPRESS mark issued on October 4, 2011 with Registration No. 4,034,365. The other two Registrants of the mark are my children Ashley and Justin Rono.
4. I bought the Barrio Fiesta Milpitas Restaurant in 2010, which is located at 1790 Milmont Dr. Milpitas, CA 95035 ("Milpitas Restaurant"). My understanding today is that this restaurant was originally opened by Reynaldo Ongpauco, a descendent of Sixta-Evangelista Ongpauco.
5. I also opened another Barrio Fiesta Restaurant on April 4, 2014, which is located at 5560 Monterey Highway, San Jose, CA 95138 ("San Jose Restaurant").
6. To the extent that I continued to use the signage and menus from the Milpitas Restaurant, it was not done to associate with the Ongpauco Family brand, but rather done for cost reasons because that is the way I purchased the restaurant and it was and is my understanding that all of the signage and logos were included with the purchase agreement. Further, I have had my own logo designed and created, and such logo is displayed in the San Jose Restaurant on the menus for both restaurants.

7. I have never attempted to intentionally or otherwise associate my Barrio Fiesta Restaurant in Milpitas (or any of my restaurants or other products) with the Ongpauco Family brand of the Philippines or the mark "The Original Barrio Fiesta of Manila."
8. If customers ask if Barrio Fiesta Express (the Milpitas/San Jose Restaurants or its products) are an affiliate or otherwise associated with the Barrio Fiesta restaurants in the Philippines, I have always been very clear that they are not. My staff has also been trained and instructed to tell customers that we are not associated with the Barrio Fiesta of the Philippines if ever asked.
9. After purchasing the Milpitas Restaurant, I began expanding the restaurants into a chain and introduced an "Express" (take-out) style to the restaurant. To my knowledge, the Ongpauco family has never served take-out.
10. I have done this in an attempt to develop and expand my own restaurant brand "Barrio Fiesta Express" without regard to the Ongpaucos.
11. I have also began developing and selling packaged foods bearing the Barrio Fiesta Express mark.

I declare under the penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 6th day of April, 2017 at San Jose, California.

  
\_\_\_\_\_  
June Rono

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing DECLARATION OF JUNE RONO IN SUPPORT OF REGISTRANTS' OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Petitioner on April 7, 2017, by sending the same via FEDEX overnight delivery, to:

Melvin N.A. Avanzado  
THE AVANZADO LAW FIRM  
1880 Century Park East, Suite 1100  
Los Angeles, CA 90067

/S/ JAMES CAI  
James Cai, Esq.  
Attorney for Registrants

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

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KRISTEN  
C. RONO, AND JUSTIN CHRISTIAN C.  
RONO,

Registrants.

Cancellation No. 92063674

In the Matter of Registration No. 4,034,365

Mark: BARRIO FIESTA EXPRESS

Date Issued: October 4, 2011

*[Opposition to Motion for Summary  
Judgment; Request for Judicial Notice;  
Response to Separate Statement of  
Undisputed Fact; Exhibits to Cai  
Declaration filed concurrently herewith]*

**DECLARATION OF JAMES CAI IN SUPPORT OF REGISTRANTS' OPPOSITION  
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

I, James Cai, declare as follows:

1. I am an attorney-at-law licensed to practice before all courts of the State of California and a member of the bar of this Court. I am a partner of SAC Attorneys LLP, counsel of record for Registrants June Rono, Ashley Rono and Justin Rono in this proceeding. I am also counsel of record for Barrio Fiesta, LLC in the action entitled, *Barrio Fiesta, LLC v. Northridge Foods International, Inc.*, which is pending in the United States District Court for the Northern District of California, Case Number 4:15-cv-02669 (the "Federal Lawsuit"). I have personal knowledge of the facts contained in the is declaration and, if called, could and would testify competently thereto under oath.
2. On September 9, 2016, Counsel for Northridge Foods International, Inc. filed a motion for summary judgment in the Federal Lawsuit seeking summary adjudication on all claims of Plaintiff Barrio Fiesta, LLC in the Federal Lawsuit. In opposition to that motion, I filed declarations with exhibits of June Rono and myself.
3. On September 23, 2016, SAC Attorneys LLP submitted the Declaration of June Rono in support of Barrio Fiesta, LLC's opposition to Northridge International, Inc.'s motion for summary judgment. A true and correct copy of that Declaration including the exhibits, which was filed in the Federal Lawsuit is attached hereto as Exhibit 1.
4. On September 23, 2016, SAC Attorneys LLP submitted the Declaration of James Cai in support of Barrio Fiesta, LLC's opposition to Northridge International, Inc.'s motion for summary judgment. A true and correct copy of that Declaration including the exhibits, which was filed in the Federal Lawsuit is attached hereto as Exhibit 2.

5. The facts set forth in the foregoing declarations filed in the Federal Lawsuit are still true and correct as of the date of this declaration.

I declare under the penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 6<sup>th</sup> day of April, 2017 at San Jose, California.

/S/JAMES CAI  
James Cai

# **EXHIBIT 1**

James Cai (SBN 200189)  
Marc Guèdenet (SBN 292868)  
SAC Attorneys, LLP  
111 N. Market Street, Suite 1020  
San Jose, California 95113  
Telephone: (408) 436-0789  
Facsimile: (408) 436-0758  
  
Attorneys for Plaintiff and Counter-Defendant  
BARRIO FIESTA, LLC.

UNITED STATES DISTRICT COURT  
  
NORTHERN DISTRICT OF CALIFORNIA  
  
OAKLAND DIVISION

BARRIO FIESTA, LLC., a California Limited  
Liability Company,

Plaintiff,

v.

NORTHRIDGE FOODS INTERNATIONAL,  
INC., and DOES 1 through 10 inclusive,

Defendants.

NORTHRIDGE FOODS INTERNATIONAL,  
INC., and DOES 1 through 10 inclusive,

Counterclaimant,

v.

BARRIO FIESTA, LLC., a California Limited  
Liability Company,

Counterdefendant.

CIVIL ACTION No.: 4:15-cv-02669-JSW

**DECLARATION OF JUNE RONO IN  
SUPPORT OF BARRIO FIESTA, LLC.'S  
OPPOSITION TO DEFENDANT  
NORTHRIDGE FOODS  
INTERNATIONAL, INC.'S MOTION  
FOR SUMMARY JUDGMENT**

**SIGNATURE VIA FAX**

Date: October 14, 2016

Time: 9:00 a.m.

Place: Courtroom 5

(Courtroom of the Honorable Jeffrey S White)

*[Declarations of June Rono, and James Cai;  
Request for Judicial Notice filed  
concurrently herewith]*

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**DECLARATION OF JUNE RONO**

I, June Rono, declare as follows:

1. I am over 18 years of age and am the CEO and sole shareholder of Barrio Fiesta, LLC.
2. I have personal knowledge of the facts contained in this declaration and, if called as a witness, could and would competently testify thereto under oath.
3. Ashley Rono, Justin Rono and myself are the current owners of the Barrio Fiesta Express trademark (US Trademark Reg. No. 4034365).
4. Ashley Rono subsequently delegated all decision making authority regarding the mark Barrio Fiesta Express to Justin Rono and myself.
5. In or about April 2015, Justin Rono and myself granted Barrio Fiesta, LLC. the exclusive right to enforce any and all trademark rights of Barrio Fiesta Express.
6. The granting of the exclusive right to enforce the trademark rights of Barrio Fiesta Express to Barrio Fiesta, LLC. was not in writing.
7. On September 16, 2016, Justin Rono, Ashley Rono and myself reaffirmed and memorialized that agreement in writing. A true and correct copy of that reaffirmation agreement is attached as Exhibit A.
8. When I purchased the Barrio Fiesta restaurant located in Milpitas, California in 2011, I believed it to be the only operational Barrio Fiesta restaurant in the United States.
9. I also believed that by purchasing the Barrio Fiesta restaurant in Milpitas, California, that I was also receiving any and all rights to the ownership and use of the Barrio Fiesta trademark.
10. When I purchased the Milpitas restaurant, I also believed that any and all history associated with Barrio Fiesta was part of the Milpitas restaurant.

- 1 11. When I purchased the Milpitas restaurant in 2011, I was unaware that the Barrio Fiesta  
2 Manufacturing Corporation (if the Barrio Fiesta Manufacturing Corporation was actually  
3 importing products into the United States) was regularly importing products into the United  
4 States.  
5
- 6 12. In 2011, when I purchased the Barrio Fiesta restaurant in Milpitas, I had no knowledge that  
7 Barrio Fiesta Manufacturing Corporation had continued selling or importing products into  
8 the United States through and up to the present, which displayed the mark Barrio Fiesta.  
9
- 10 13. When I purchased the Milpitas restaurant in 2011, I was unaware of Northridge Foods  
11 International, Inc. and therefore also unaware that Northridge Foods International, Inc. was  
12 importing Barrio Fiesta Manufacturing Corporation products into the United States.  
13
- 14 14. I was not aware of Northridge Foods International, Inc. importing Barrio Fiesta  
15 Manufacturing Corporation products until late 2012.  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 I declare under penalty of perjury under the laws of the United States that the foregoing is true  
2 and correct.

3  
4  
5 Dated: September 21, 2016

6  
7 By: June A. Rono  
8 June Rono  
9

# **EXHIBIT A**

**REAFFIRMATION OF EXCLUSIVE RIGHT TO ENFORCE TRADEMARK  
BETWEEN JUSTIN RONO, JUNE RONO, ASHLEY RONO  
&  
BARRIO FIESTA, LLC**

Whereas, Justin Rono and Ashley Rono are the original owners of the trademark Barrio Fiesta Express (US Trademark Reg. No. 4034365) (the "Trademark");

Whereas, Justin Rono and Ashley Rono signed a Trademark License Agreement (the "Agreement", a copy of which is attached on Exhibit A) with Barrio Fiesta, LLC ("BF") on or about January 4, 2012 to grant BF the right to use the Trademark and, according to Section 4(b) of the Agreement, to take such action, at BF's own expense, to sue for infringement of the Trademark by third party(ies) and collect monetary proceeds exclusively;

Whereas, Justin Rono and Ashley Rono assigned the ownership of the Trademark to Justin Rono, June Rono and Ashley Rono (collectively, the "Current Owners") on or about November 24, 2014;

Whereas, in late 2012, June Rono discovered potential infringement of the Trademark by Northridge Foods International, Inc.;

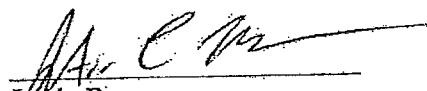
Whereas, Ashley Rono has delegated all decision makings regarding to Trademark enforcement to June Rono and Justin Rono; and

Whereas, in or about April 2015, Justin Rono and June Rono decided to grant BF the exclusive right, at BF's own expense, to enforce the Trademark rights by filing a lawsuit in the United States District Court of Northern District of California against Northridge Foods International, Inc., to collect all monetary proceeds exclusively and to seek injunctive relief for BF's own benefit; and

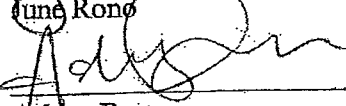
Whereas, said grant of exclusive right to enforce Trademark was not in writing by Justin Rono and June Rono.

Now, therefore, Justin Rono, June Rono and Ashley Rono hereby reaffirm the grant of exclusive right to enforce all rights related to the Trademark to Barrio Fiesta LLC.

Date: 9/16/2016

  
Justin Rono

  
June Rono

  
Ashley Rono

# **EXHIBIT A**

## TRADEMARK LICENSE AGREEMENT

This Trademark License Agreement (called "Agreement") is entered into by and between Justin-Christian Roño and Ashley Kirsten Roño (jointly called "Licensor") and Barrio Fiesta, LLC. (called "Licensee").

### RECITALS:

1. The Licensor is the owner of the trademark(s) (called "Licensed Marks") set forth in Exhibit A, attached hereto and incorporated by reference herein; and
2. The Licensor desires to license the use of the Licensed Marks to the Licensee; and
3. The Licensee desires to license the use of the Licensed Marks from the Licensor;

### NOW THEREFORE THE PARTIES AGREE AS FOLLOWS:

#### 1. GRANT OF LICENSE

- a. **Territory.** Licensor hereby grants a license to the Licensee to use the Licensed Marks in the territory of the United States of America.
- b. **Terms and Conditions of License.** The terms and conditions of the license of the Licensed Marks granted by this Agreement is such and to the extent to fully allow and permit Licensee to license the Licensed Marks to third party licensees pursuant to the terms and conditions of the third party License Agreement (including any changes hereinafter made therein) attached hereto as Exhibit B, (called "Third Party License Agreement").

#### 2. RIGHTS AND TITLE TO LICENSED RIGHTS

- a. **Licensed Marks Owner.** Licensor is the lawful holder of the Licensed Marks in the Licensee Territory and has the exclusive right therein to license the Licensed Marks to Licensee under the terms of this Agreement. Particulars of registrations for the Licensed Marks are available from Licensor. Licensor gives no warranty in relation thereto except as expressly provided herein nor as to the validity of any of the applications and registrations.
- b. **No Representation.** The Licensee acknowledges that Licensor has made no representation regarding the registration of the Licensed Marks, except that Licensor represents that as of the date of this Agreement that Licensor is not aware that the Licensed Marks infringe the rights of any third party, nor is Licensor aware of any third party claim that the Licensed Marks infringe the rights of any third party(s).
- c. **No Warranty.** THE LICENSED RIGHTS ARE PROVIDED TO LICENSEE "AS IS" AND WITHOUT WARRANTY OF ANY TYPE OR KIND. LICENSOR HEREBY DISCLAIMS ANY AND ALL WARRANTIES, WHETHER STATUTORY, EXPRESS, OR IMPLIED, INCLUDING WITHOUT LIMITATION, THE IMPLIED WARRANTIES OF MERCHANTABILITY AND FITNESS FOR A PARTICULAR PURPOSE, AND ANY WARRANTY OF NON-INFRINGEMENT OF THIRD PARTY RIGHTS EXCEPT THAT LICENSOR WARRANTS THAT IT IS NOT AWARE AS OF THE DATE OF THIS AGREEMENT OF ANY THIRD PARTY CLAIM(S) THAT THE LICENSED RIGHTS OR THEIR USE INFRINGES THE RIGHTS OF ANY THIRD PARTY OR PARTIES.
- d. **No Contest to Licensed Marks.** During the term of this Agreement and thereafter, the Licensee shall not undertake to do or permit to be done any act that would or might jeopardize or invalidate the Licensed Marks nor do any act that might assist or give rise to an

application to remove the Licensed Marks from any national register or that might prejudice the right of the Licensor to the Licensed Marks. Further, the Licensee shall not object to or otherwise contest Licensor's exclusive right, title and interest in and to, or the validity of, the Licensed Marks within the Licensee Territory or elsewhere.

- e. **Licensee Assistance in Maintaining Licensed Marks.** The Licensee shall on request give to the Licensor or its authorized representative any information as to its use of the Licensed Marks that Licensor may reasonably require and shall render any assistance reasonably required by Licensor in maintaining the registrations, and/or Licensor's common law rights.
- f. **Goodwill of Licensed Marks.** The Licensee shall not make any representation or do any act that may be taken to indicate that it has any right, title, or interest in, or to the ownership or use of the Licensed Marks except under the terms of this Agreement and acknowledges that nothing contained in this Agreement or actions pursuant to this Agreement shall give the Licensee any right, title, or interest in or to the Licensed Marks other than as provided in this Agreement. To the extent that any use of the Licensed Marks by the Licensee may result in a development of goodwill in the Licensed Marks, such goodwill shall inure to the sole benefit of the Licensor or its obligee. The Licensee shall at any and all times during the terms of this Agreement execute any documents reasonably required by Licensor to confirm Licensor's interests in all such rights.
- g. **Use of Similar Marks.** Licensee shall not employ any other trademarks that are confusingly similar to the Licensed Marks in connection with the performance of the terms of this Agreement, including all Exhibits.
- h. **Use Current Licensed Marks and Logo(s).** Licensee shall only use the most current logo in under the terms of this Agreement. In the event that the Licensor changes the logo(s), in order to have consistency of presentation and maintain the value of the Licensed Marks, the Licensee shall utilize the most recent version of the Licensed Marks. The Licensee shall have sixty (60) days from the date of notice of the change in Licensed Marks to make the change on all documents and publically identified materials utilized by the Licensee.
- i. **Industry Standards and Local Law.** In addition to other quality standards set forth in this Agreement, for the protection of the value of the Licensed Marks, the Licensee agrees that the nature and quality of the any performance of this Agreement shall be of high quality in the Licensee's industry, and shall not adversely affect the good name of the Licensed Marks. The Licensee further agrees that all acts involved in the performance of this Agreement shall be in conformity with all applicable laws and regulations of the State of Licensee's domicile, the local governments where performance is provided, and the United States of America.
- j. **Licensed Marks Reputation.** The use of the Licensed Marks by the Licensee shall at all times be in keeping with the distinctiveness and reputation of the Licensed Marks as determined by the Licensor and as set forth in this Agreement.
- k. **Marketing and Advertising.** The Licensee agrees that it shall not do anything that diminishes in any manner whatsoever the value of the Licensed Marks in all advertising, promotional and marketing literature, and media utilized by the Licensee.
- l. **Licensee Registration of Licensed Marks Prohibited.** The Licensee shall not use, register, or apply to register, any mark or name identical to or similar with the Licensed Marks in any Country throughout the world. Licensee may use the Licensed Marks only as provided in this Agreement.
- m. **Licensed Marks Limited.** Unless otherwise set forth in this Agreement, nothing contained in this Agreement shall entitle the Licensee to use or register the Licensed Marks as part of any corporate, business, or trading name of the Licensee. Further in any offering circular or similar document, Licensee shall set forth with clarity that Licensee is an independent

contractor and that Licensee's business operations are separate and distinct from the operations of the Licensor.

- n. ***Threat to Public Health and Safety.*** The Licensee shall not provide Restaurant Services where the Licensed Marks are utilized in any situations that may cause harm, threaten to cause harm, or threaten or harm the health and safety of the public and/or any individual.

### 3. USE OF LICENSED RIGHTS BY THE LICENSEE

- a. ***No Prescribed Marketing Plan.*** Licensor shall not and has not prescribed a marketing plan to Licensee for the use and exploitation of the Licensed Marks. Licensee shall be solely responsible with regard to establishing a designated facility and a marketing program, and Licensor shall have no responsibility, financial or otherwise, with regard to such facility or marketing program. Subject to the quality control standards set forth in this Agreement, Licensee shall have complete control with respect to the marketing and furnishing of its services or distribution of products under this Agreement, including without limitation, any and all prices at which the products or services are marketed, offered or sold to third party customers or sub-licensees.
- b. ***Public Use of Licensed Marks.*** For the purposes of protecting the value of the Licensed Marks, Licensee shall allow its sub-licensees to each hold itself out to the public as either an "Authorized Licensee of Barrio Fiesta Express Restaurants" or use the term "Barrio Fiesta Express" as the name of said sub-Licensee Restaurant provided that the term "Barrio Fiesta Express" is either preceded or immediately followed by a description of the restaurant's place; e.g. "Walnut Creek Barrio Fiesta Express" or "Barrio Fiesta Express of Walnut Creek" or other designation approved in writing in advance by the Licensee. Subject to the terms of this Agreement, Licensee shall have the right to use the Licensed Marks in all advertisements, signage, promotional material, correspondence, activities, and communications conducted by the Licensee to promote the distribution and availability of its Restaurant Services.
- c. ***Restricted Use of Licensed Marks.*** Licensee shall not use any of the Licensed Marks as any part of its legal business entity name such as a corporation, limited liability company, partnership, limited partnership or as the name of any other legal entity or the name of a bank account of any kind whatsoever. It may only use the Licensed Marks in a duly and properly filed "doing business as" (dba) legal format when identifying Licensee's business.
- d. ***Quality Control of Licensed Marks by Licensor through Terms of this Agreement.*** In the performance of this Agreement Licensee shall at all times exercise a quality control of the use of the Licensed Marks, to wit: The Licensee shall at all times utilize the Licensed Marks in conformity with the Lanham Act (Trademark Protection) thereby maintaining quality and uniformity of all uses of the Licensed Marks. Such control shall not extend in any manner whatsoever to direct the overall operations of Licensee's business, but shall solely and specifically be applied to the use of the Licensed Marks. To maintain quality and uniformity of use of the Licensed Marks, Licensee shall in all uses do the following:
- (i) Give notice that a mark is registered with the United States Patent and Trademark Office by using one of the following designations affixed next to the license mark:
    - (a). Use the symbol, "®,"
    - (b). Use the legend, "Registered, U.S. Patent and Trademark Office," or
    - (c). Use the abbreviation, "Reg. U.S. Pat. & Tm. Off."

- e. Licensee shall use and display the Licensed Marks only in the manner specified by the Licenser in Exhibit A.
- f. Licensee shall use the Licensed Marks solely in connection with the corresponding products and services covered or likely to be covered by this Agreement and not for any other goods and/or services.
- g. Licensee shall not use the Licensed Marks in connections with the distribution of goods or services that are misrepresented in any manner whatsoever as to their quality, content, warranty, or usage.
- h. Licensee shall not combine the Licensed Marks with any other trademark, trade name, other logo, words, graphics, photos, slogans, numbers, design features, or symbols.
- i. Licensee shall not use the Licensed Marks in any manner that may disparage the Licensed Marks or impair the validity, scope, title or goodwill of the Licenser and/or the Licensed Marks.
- j. Licensee shall not use the Licensed Marks in any manner that may cause or threat to cause harm to the health and safety of the public.
- k. The Licenser hereby retains the right to monitor and inspect the quality and uniformity of the use of the Licensed Marks under the terms of this Agreement, and further reserves the right to cancel the license if the quality standards are not maintained. The violation of any provision of this Paragraph shall be considered by the agreement of the parties a "Substantial and Material Breach" of this Agreement and subject to the termination provisions set forth herein.

#### 4. INFRINGEMENTS

- a. ***Infringements of the Licensed Marks.*** The Licensee shall immediately notify the Licenser in writing if the Licensee becomes aware of any unauthorized use or proposed use by any person or entity of a Licensed Marks or mode of promotion or advertising that is identical or confusingly similar to the Licensed Marks, and the Licenser may elect, in its sole discretion, to (a) take action against such person or entity, at its sole expense, in its own name, or in the name of the Licensee, or join the Licensee as a party, as Licenser in its sole discretion deems required, and Licenser shall retain all amounts awarded as damages, profits or otherwise in connection with such action, or (b) grant the Licensee the right to take such action, at the Licensee's own expense, and by attorneys of the Licensee's choice, as the Licensee in its sole discretion may deem advisable, including the right to sue for infringement in which case the monetary proceeds from any such action, claim or settlement arising from such action will belong exclusively to the Licensee after the deduction of all of the Licenser's own costs incurred as a result of such proceedings, if any.
- b. ***Infringement of Third Party Marks.*** If the Licensee becomes aware that any person alleges that the Licensed Marks are invalid or if either party to this Agreement becomes aware that any person alleges that the use of the Licensed Marks infringes any rights of another party, the Licensee or the Licenser, as appropriate, shall immediately notify the other party. The Licensee shall make no comment or admission to any third party in respect thereof except pursuant to any judicial order binding upon it.
- c. ***Cooperation.*** The Licensee shall at the request of the Licenser cooperate with the Licenser in any action, claim, proceedings brought or threatened in respect of the Licensed Marks and the Licenser. Licenser shall pay Licensee any reasonable expenses

incurred by the Licensee to third parties in giving such assistance. Where the Licensee requests the Licensor to bring proceedings that Licensor would not otherwise choose to bring in any particular situation, it shall be the Licensor's sole discretion whether or not any proceedings are brought or continued.

#### 5. LICENSE FEES

- a. Upon the execution of this Agreement, the Licensee shall pay the Licensor License Fee of One Hundred dollars (\$100.00) for the Initial Term of this Agreement.

#### 6. TERM OF AGREEMENT

- a. **Initial Term.** The Initial term of this Agreement shall be for ten (10) years beginning on the date of this Agreement.
- b. **Successive Terms and Renewal Fee.** The Licensee shall have the right to extend this Agreement for three (3) successive ten (10) year terms by giving Licensor written notice of such intention to extend within the last ninety (90) days of each applicable ten (10) year term subject to Licensee being in full compliance with the requirements of this Agreement and pay a renewal fee of One Hundred Dollars (\$100.00). The terms of this Agreement shall remain in full force and effect throughout any and all successive terms.

#### 7. TERMINATION

- a. **Termination by Either Party for Uncured Material Breach.** In the event of a default hereunder, the party who does not default shall provide written notice to the party in default in the manner set forth in Paragraph 10..D. hereof of the nature of such default. Unless such default is cured with thirty (30) days following delivery of such notice, the non-defaulting party may terminate this Agreement without prejudice to other remedies provided herein.
- b. **Termination by Licensor.** The Licensor may immediately terminate this Agreement forthwith by notice in writing if at any time the Licensee does the following:
  - (1) **Failure to Pay Fees.** The Licensee fails to pay any license fees or other sums due under this Agreement within ten (10) days of their due date; and/or
  - (2) **Failure to Provide Performance of the Agreement.** The Licensee for a period of ninety (90) days fails to provide the performance contemplated by this Agreement manner that appears to the reasonable person that the Licensee is abandoning the providing of said performance; and/or
  - (3) **Prohibited Assignment.** The Licensee makes an assignment for the benefit of its creditors, admits in writing to its inability to pay its debts as they come due, commences or is the subject of any proceeding under law relating to bankruptcy, insolvency, or readjustments of its debt, which proceeding is not dismissed within sixty (60) days after commencement; and/or
  - (4) **Legal Liability.** The Licensee's use of the Licensed Marks may reasonably lead to legal liability on the part of the Licensor, and Licensor provides the Licensee with notice of Termination; and/or
  - (5) **Incurable Breach.** Licensor determines that the Licensee has breached this Agreement and the breach is not curable within thirty (30) days of notice of said breach; and/

- (6) **Bankruptcy.** In the event of the filing of bankruptcy Chapter 7 by the Licensee, this Agreement shall terminate and all obligations hereunder shall terminate on said discharge of said bankruptcy; and/or
- c. **Rights upon Termination.** Upon Termination of this Agreement, the Licensed Marks shall terminate completely and all rights shall revert to Licensor.
- d. **Use of Licensed Marks upon Termination.** Upon the expiration or termination of this Agreement for whatever reason, the Licensee at its expense shall immediately cease to make any use of the Licensed Marks whatsoever, and shall forthwith cause the Licensed Marks to be removed from all sales and marketing literature and other materials of the Licensee. Licensee shall not hold itself out to the public or anyone as being affiliated in any manner whatsoever with the Licensor or the Licensed Marks including the Licensed Marks.
- e. **Right to Enjoin.** Licensor shall have the right to enjoin Licensee for the breach of the provisions of this Paragraph.

#### 8. INDEMNITY

- a. **Licensee Indemnity Obligations.** Licensee agrees at its expense to defend, indemnify and hold Licensor harmless from any and all third party claims, demands, causes of action and judgments (including attorney's fees, court costs and expert witness fees) arising out of (i) Licensee providing performance under the terms of this Agreement to third parties, (ii) Licensee's advertising, promotion, or sale of services or products contemplated by this Agreement, (iii) Licensee's misuse of the Licensed Marks, or (iv) Licensor withdrawing permission of the Licensee to use the Licensed Marks. The Licensor shall be consulted with regard to any admission or settlement that may adversely affect the interests of the Licensor. Under this indemnity provision in no event shall Licensor be liable for any damages, including without limitation, loss of profits, arising from or related to the Licensee's use of the Licensed Marks or the termination of this Agreement, even if Licensor has notice of the possibility of such damages.
- b. **Licensor Indemnity Obligations.** Licensor agrees at its expense to defend, indemnify and hold Licensee harmless from any and all third party claims, demands, causes of action and judgments (including attorney's fees, court costs and expert fees) that, if true, would constitute a breach of Licensor's warranties made under this Agreement.

#### 9. INDEPENDENT CONTRACTOR STATUS

- a. **Independent Contractor Status in General.** Notwithstanding any other provision of this Agreement, this Agreement shall not render the Licensee an employee, partner, agent of, or joint venturer with the Licensor for any purpose other than that the parties hereto shall be solely bound by the legal relationship of two independent contractors entering into an Agreement. The Licensor shall not be responsible for withholding taxes with respect to the Licensee's compensation hereunder. The Licensee shall have no claim against the Licensor hereunder or otherwise for vacation pay, sick leave, retirement benefits, social security, worker's compensation, health or disability benefits, unemployment insurance benefits, or employee benefits of any kind.

## 10. MISCELLANEOUS PROVISIONS

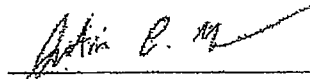
- a. **Assignment and Sub-License.** Except to license to third party licensees pursuant to the License Agreement set forth in Exhibit B, the Licensee shall not assign, sub-license, or in any other manner transfer to any third party the benefit and/or burden of the whole or any part of this Agreement or purport to do any of the same without the prior written consent of the Licensor. Consent shall not unreasonably be withheld where an assignment is part of a merger, restructuring, or transfer of business and a creditworthy and reputable assignee accepts all the obligations of this Agreement. Licensor has the sole discretion to determine the issue of "creditworthiness" and "reputation" of the new obligor to this Agreement.
- b. **Entire Agreement.** This Agreement, including Exhibits and documents referred to therein, constitutes the entire agreement and understanding of the parties relating to the subject matter of this Agreement and supersedes all prior oral or written agreements, understandings or arrangements between them relating to such subject matter. Neither party shall be entitled to rely on any agreement, understanding, arrangement, or representation relating to the subject matter of this Agreement that is not expressly contained in this Agreement.
- c. **Amendment of Agreement.** This Agreement (excluding Exhibits) shall not be amended or modified without the written consent of both parties hereto.
- d. **Notices.** Any notice or other document to be given under this Agreement shall be in writing in the English language, and shall be sent by hand delivery, courier with recorded delivery, by registered or certified post, or facsimile (subsequently confirmed by first class postage U.S. Post Office mail) to a party at the address below the signature to this Agreement unless a different address has been notified to the other in writing for this purpose. Notices shall be deemed to have been received by the addressee within three (3) postal delivery days of posting as above or within 24 hours if sent by hand delivery or facsimile to the addressee's correct address.
- e. **Waiver of Rights under This Agreement.** No failure or delay on the part of either party to exercise any right or remedy under this Agreement shall be construed or operate as a waiver thereof nor shall any single or partial exercise of any right or remedy preclude the further exercise of such right or remedy as the case may be.
- f. **Licensee Not Agent of Licensor.** This Agreement does not constitute Licensee as the agent or representative of Licensor and Licensee shall not act as or cause other persons to believe that Licensee is the agent or representative of Licensor or that Licensor is responsible in any way for Licensee's obligations. In no event shall either party have the right or authority to contract for or bind the other in any manner whatsoever.
- g. **Binding Effect.** This Agreement is binding upon the parties and their respective successors and assigns.
- h. **Exhibits Part of Agreement.** The Exhibits to this Agreement and any documents referred to therein (and as amended by Licensor) shall form part of this Agreement as if they were specifically set out herein.
- i. **Governing Law and Jurisdiction.** This Agreement shall be governed and construed in accordance with the laws of the State of California ("Controlling State"). Any litigation to enforce or interpret the provisions of this Agreement or the parties' rights or obligations arising out of this Agreement or the performance hereunder shall be maintained only in the courts of the Controlling State and the parties expressly consent to personal jurisdiction of such courts. The Licensee expressly

consents to the Licensor obtaining injunctive and equity relief to enforce the terms of this Agreement. Each of the parties hereby knowingly, voluntarily and intentionally agrees that any actions or proceedings arising directly or indirectly in connection with, out of, related to or from this Agreement shall be litigated exclusively in Federal or State courts having situs within the State of California, Santa Clara County. Each of the parties hereby irrevocably consents and submits to the exclusive jurisdiction and venue of any state or Federal court located within such county. Each of the parties hereby waives any right either of them may have to transfer or change the venue of any litigation brought against it or brought by it in accordance with this Section.


- j. **Severability.** This Agreement shall be liberally construed to maximize protection of each party's rights in the licensing relationship. If any provision of this Agreement is held to be invalid or otherwise unenforceable under the applicable law and circumstances by the reviewing court, the parties agree to a reduction of the scope of such provision as such court deems necessary and appropriate to permit its partial enforcement, and if partial enforcement is not possible, it shall be deemed severed, and the remainder shall remain in full force and effect. The invalidity or unenforceability, in whole or in part, of any provision of this Agreement shall not affect the validity or enforceability of any other provision. If any portion is held invalid or unenforceable with respect to particular circumstances, it nevertheless shall remain in full force and effect in all other circumstances.
- k. **Licensee Right to Counsel.** The Licensee represents and acknowledges that before signing this Agreement, the Licensee had the opportunity to seek legal counsel to advise Licensee on the terms and conditions of this Agreement.
- l. **Fax or Scanned Signatures.** The transmission of fax or scanned signatures sent via email of the parties shall be legally binding upon receipt by the other party. Licensor shall provide a fully executed original by mail to the Licensee within five (5) business days of the signing of the fax or scanned copy.
- m. **Attorneys' Fees.** Licensee covenants and agrees to pay on demand all costs, expenses and fees, including reasonable attorney's fees and court costs incurred by Licensor in enforcing Licensee's obligations under this Agreement.

THIS AGREEMENT consisting of nine (9) pages (excluding exhibits, schedules, addendums and amendments) including the signature page (which consists of two (2) pages) is executed in duplicate on this 4<sup>th</sup> day of January 2012 at Milpitas California.

**LICENSOR**

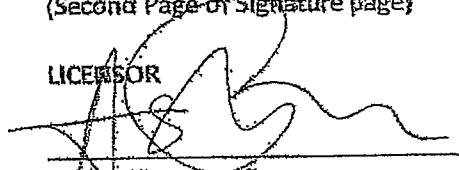
  
Justin Christian Roño  
1629 Wharton Road  
San Jose, CA 95132  
Phone: 408-823-9153  
Email: jccrono@gmail.com

**LICENSEE**

  
Barrio Fiesta, LLC.  
1790 Millmont Drive  
Milpitas, CA 95035  
Phone: 408-386-6683  
Email: jfrono@thebarriofiesta.com

{Second Page of Signature page}

LICENSOR



Ashley Kirsten Roño  
1629 Wharton Road  
San Jose, CA 95132  
Phone: 408-386-3893  
Email: ashleyrono@gmail.com

EXHIBIT A.  
Licensed Marks

1. Barrio Fiesta Express
2. Logo



3. Other TRADE NAMES and LOGOS developed by Licensor hereafter and added to the Licensed Rights by notice of Licensor
4. Logos of Purchasing Network members as permitted by separate agreement

# **EXHIBIT 2**

James Cai (SBN 200189)  
Marc Guèdenet (SBN 292868)  
SAC Attorneys, LLP  
111 N. Market Street, Suite 1020  
San Jose, California 95113  
Telephone: (408) 436-0789  
Facsimile: (408) 436-0758

Attorneys for Plaintiff and Counter-Defendant  
BARRIO FIESTA, LLC.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION

BARRIO FIESTA, LLC., a California Limited  
Liability Company,

Plaintiff,

v.

NORTHRIDGE FOODS INTERNATIONAL,  
INC., and DOES 1 through 10 inclusive,

Defendants.

NORTHRIDGE FOODS INTERNATIONAL,  
INC., and DOES 1 through 10 inclusive,

Counterclaimant,

v.

BARRIO FIESTA, LLC., a California Limited  
Liability Company,

Counterdefendant.

CIVIL ACTION No.: 4:15-cv-02669-JSW

**DECLARATION OF JAMES CAI IN  
SUPPORT OF BARRIO FIESTA, LLC.'S  
OPPOSITION TO DEFENDANT  
NORTHRIDGE FOODS  
INTERNATIONAL, INC.'S MOTION  
FOR SUMMARY JUDGMENT**

Date: October 14, 2016

Time: 9:00 a.m.

Place: Courtroom 5

(Courtroom of the Honorable Jeffrey S White)

*[Declarations of June Rono, and James Cai;  
Request for Judicial Notice filed  
concurrently herewith]*

**DECLARATION OF JAMES CAI**

I, James Cai, declare as follows:

1. I am over 18 years of age and am an attorney-at-law licensed to practice before all court of the State of California and a member of the bar of this Court. I am counsel of record for Plaintiff and Counterdefendant Barrio Fiesta, LLC.
2. I have personal knowledge of the facts contained in this declaration and, if called as a witness, could and would competently testify thereto under oath.
3. Counsel for Northridge conducted the first volume of the deposition of Plaintiff Barrio Fiesta, LLC on January 5, 2016 in San Jose, California. Plaintiff designated June Francis Rono as its corporate witness designee. The transcript of the first volume of Barrio Fiesta, LLC's deposition was transcribed, and certified as an accurate transcription, by court reporter Michelle D. Knowles. Attached as Exhibit 1 hereto is a true and correct copy of relevant portions of the first volume of Plaintiff's deposition transcript that are cited in Plaintiff's opposition papers and the reporter's certification thereof. Specifically Exhibit 1 includes the following pages from the certified copy of the first volume of Barrio Fiesta, LLC's deposition transcript: 57, 127.
4. Counsel for Northridge conducted the second volume of the deposition of Plaintiff Barrio Fiesta, LLC on May 12, 2016 in San Jose, California. Plaintiff designated June Francis Rono as its corporate witness designee. The transcript of the second volume of Barrio Fiesta, LLC's deposition was transcribed, and certified as an accurate transcription, by court reporter Linda Vaccarezza. Attached as Exhibit 2 hereto is a true and correct copy of relevant portions of the second volume of Plaintiff's deposition transcript that are cited in Plaintiff's opposition papers and the reporter's certification thereof. Specifically Exhibit 2 includes the

1 following pages from the certified copy of the first second of Barrio Fiesta, LLC's deposition  
2 transcript: 142-143, 156-157, certificate of Linda Vaccarezza.

- 3 5. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
4 Trademark/Service Mark Application (serial number 85384724) with the United States  
5 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
6 out a true and correct copy of Barrio Fiesta Manufacturing Corporation's Application from  
7 the USPTO's website, which is attached as Exhibit 3.  
8
- 9 6. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
10 Trademark/Service Mark Application (serial number 85384724) with the United States  
11 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
12 out a true and correct copy of Barrio Fiesta Manufacturing Corporation's Request for  
13 Extension of Time to File a Statement of Use from the USPTO's website, which is attached  
14 as Exhibit 4.  
15
- 16 7. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
17 Trademark/Service Mark Application (serial number 85384724) with the United States  
18 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
19 out a true and correct copy of Barrio Fiesta Manufacturing Corporation's second Request for  
20 Extension of Time to File a Statement of Use from the USPTO's website, which is attached  
21 as Exhibit 5.  
22
- 23 8. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
24 Trademark/Service Mark Application (serial number 85384724) with the United States  
25 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
26  
27  
28

1 out a true and correct copy of the United States Patent and Trademark Office's Notice of  
2 Abandonment of mark 85384724 from the USPTO's website, which is attached as Exhibit 6.

3 9. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
4 Trademark/Service Mark Application (serial number 86528183) with the United States  
5 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
6 out a true and correct copy of Barrio Fiesta Manufacturing Corporation's Application from  
7 the USPTO's website, which is attached as Exhibit 7.

8  
9 10. On September 13, 2016, I reviewed Barrio Fiesta Manufacturing Corporation's  
10 Trademark/Service Mark Application (serial number 86528183) with the United States  
11 Patent and Trademark Office (USPTO) via the USPTO's website (www.uspto.gov). I printed  
12 out a true and correct copy of the United States Patent and Trademark Office's Important  
13 Notice Regarding Your U.S. Trademark Application from the USPTO's website, which is  
14 attached as Exhibit 8.

15  
16 I declare under penalty of perjury under the laws of the United States and California that the  
17 foregoing is true and correct.  
18

19  
20  
21 Dated: September 23, 2016  
22

23 By:   
24 James Cai  
25  
26  
27  
28

# **EXHIBIT 1**

1 the food products. And we were also made aware of a  
2 Barrio Fiesta -- or someone using "Barrio Fiesta" in  
3 Calumet City, Illinois, and we have attempted to send  
4 them a cease and desist -- well, not -- we actually did  
5 send them a cease and desist letter.

6 Q. Have you had a response to the cease and  
7 desist letter from Calumet, Illinois?

8 A. We didn't get a response. The letter was  
9 actually returned back to us. According to the post  
10 office, the business was closed; so I'm not really sure  
11 at this moment whether they're operating or not.

12 Q. Okay. Did you -- when you were looking for  
13 opportunities for Filipino food distributors in the  
14 United States, did you contact Northridge Foods?

15 A. No.

16 Q. Is there a reason you didn't contact  
17 Northridge Foods?

18 A. I was not really aware of Northridge Foods at  
19 all. I did not know that they were the distributor for  
20 Barrio Fiesta bagoong products.

21 Q. Did you contact Barrio Fiesta Manufacturing  
22 Corp.?

23 A. No.

24 Q. Did you contact Splash Corporation?

25 A. No.

## CERTIFICATE OF REPORTER

I, MICHELLE D. KNOWLES, a Certified Shorthand Reporter, hereby certify that the witness in the foregoing deposition was by me duly sworn to tell the truth, the whole truth, and nothing but the truth in the within-entitled cause;

That said deposition is a true record and was taken in shorthand by me, a disinterested person, at the time and place therein stated, and that the testimony of said witness was thereafter reduced to typewriting, by computer, under my direction and supervision;

That before completion of the deposition, review of the transcript [ ] was [X] was not requested. If requested, any changes made by the deponent (and provided to the reporter) during the period allowed are appended hereto.

I further certify that I am not of counsel or attorney for any of the parties to the said deposition, nor in any way interested in the events of this cause, and that I am not related to any of the parties thereto.

Dated: January 15, 2016

*Michelle D. Knowles*

MICHELLE D. KNOWLES, CSR No. 8979



# **EXHIBIT 2**

1     Fiesta"?

2           A.    No.

3           Q.    So is it your testimony, sir, that at the  
4     time you purchased the Milpitas restaurant, you  
5     thought that was the only restaurant in the United  
6     States?

7           A.    At that time, yes.

8           Q.    You're since aware that that's mistaken,  
9     correct?

10          A.    I'm aware that after we purchased it, that  
11     another restaurant opened in Glendale, California.

12          Q.    You're aware that that restaurant in  
13     Glendale had been opened for some time before you  
14     purchased the restaurant?

15               MR. GUEDENET:  Objection.  Calls for  
16     speculation.

17     BY MR. AVANZADO:

18          Q.    I'm asking if you're aware of that.

19          A.    Ask the question again, please.

20          Q.    Let me ask it a different way.  Were you  
21     aware that there were Barrio Fiesta restaurants with  
22     this signage in Exhibit 30 that were open in the Los  
23     Angeles area since the 1980s?

24          A.    No, I was not aware of that.

25          Q.    At the time you purchased the Milpitas

Page 143

1 restaurant, were you aware of any other restaurants  
2 bearing this signage and these logos anywhere else in  
3 the United States?

4 A. At that time, my awareness was that there  
5 was no existing operational restaurant at that time.

6 Q. Were you aware that there were other  
7 restaurants that preceded the Milpitas restaurant,  
8 whether or not they were existing at that time?

9 A. Yes.

10 Q. What was your -- tell me what you knew in  
11 that regard.

12 A. What I knew was that there was a Barrio  
13 Fiesta that in Daly City, California, that had since  
14 closed. I'm not sure when.

15 Q. Any other places?

16 A. No.

17 Q. So is it your testimony that you were not  
18 aware of the southern California restaurants that had  
19 opened and either were still existing or had closed?

20 A. Not in 2011.

21 Q. And that's when you purchased the  
22 restaurant?

23 A. Yes, yes.

24 Q. Now, the purchase of Milpitas, the Milpitas  
25 restaurant, the agreement was signed in 2010?

1 Q. So in that logo, there's a graphic to the  
2 left of the words "Barrio Fiesta." Do you see that?

3 A. Yes.

4 Q. You're aware of that graphic?

5 A. Yes.

6 Q. Do you know what that graphic is?

7 A. Yes.

8 Q. What is it?

9 A. It seems like it's a picture of a pot, a  
10 closed pot with what appear to be perhaps flames.

11 Q. A pot with flames?

12 A. Yes.

13 Q. The flames are a stylized version of the  
14 letters "BF," correct?

15 A. I actually never paid attention to that. I  
16 don't know that.

17 Q. You're aware that my clients are the  
18 distributor of products for a company called Barrio  
19 Fiesta Manufacturing Corporation, are you not?

20 A. Yes.

21 Q. And Barrio Fiesta Manufacturing  
22 Corporation -- strike that.

23 What was your understanding of Barrio Fiesta  
24 Manufacturing Corporation, if any, at the time you  
25 purchased the Milpitas restaurant?

Page 157

1           A.    At that time, I didn't have much  
2   understanding of Barrio Fiesta Manufacturing  
3   Corporation.

4           Q.    Were you aware at the time that you  
5   purchased the Milpitas restaurant of the products  
6   that were being imported into the United States by  
7   Barrio Fiesta Manufacturing Corporation?

8           A.    In 2011, I don't recall that I was aware of  
9   their products at that time.

10          Q.    So let me show you what's been previously  
11   marked as Exhibit 35, which is a -- this is a jar of  
12   some Barrio Fiesta Manufacturing Corporation  
13   products.

14                   (Exhibit 35 previously marked for  
15   identification.)

16   BY MR. AVANZADO:

17          Q.    Have you ever seen that kind of jar prior to  
18   your purchasing of the Milpitas restaurant, and that  
19   kind of jar meaning products that bear that logo.

20          A.    I do not recall in 2011. And just for the  
21   record, I don't know if I was supposed to have seen  
22   this before, but I don't recall seeing this before as  
23   an exhibit.

24          Q.    You didn't see it before as an exhibit?

25          A.    Okay. Okay, yeah.

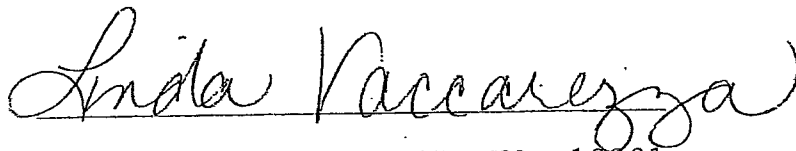
C E R T I F I C A T E

STATE OF CALIFORNIA )  
COUNTY OF SAN FRANCISCO )

I, LINDA VACCAREZZA, a Certified Shorthand  
Reporter for the State of California, do hereby  
that the above-named deponent, whose  
deposition is hereinbefore set forth, was duly  
sworn by me and that such deposition is a true  
record of the testimony given by such witness.

I further certify that I am not related to  
any of the parties to this action by blood or  
marriage; and that I am in no way interested in  
the outcome of this matter.

IN WITNESS WHEREOF, I have hereunto set my  
Hand this \_\_\_\_\_ day of JUN 17 2016 2015.



LINDA VACCAREZZA, CSR. NO. 10201

# **EXHIBIT 3**

# Trademark/Service Mark Application, Principal Register

Serial Number: 85384724  
Filing Date: 07/29/2011

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85384724
MARK INFORMATION	
*MARK	BARRIO FIESTA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Barrio Fiesta Manufacturing Corporation
INTERNAL ADDRESS	Barrio Fiesta Compound
*STREET	Restaurant Ave., Marcos Hi-way
*CITY	Deia Paz, Pasig City
*COUNTRY	Philippines
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Philippines
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	029
*IDENTIFICATION	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats
FILING BASIS	SECTION 1(b)
INTERNATIONAL CLASS	030
*IDENTIFICATION	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Michael J. Leonard

ATTORNEY DOCKET NUMBER	688303.0001
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Laura A. Genovese, Maureen C. Kassner and John P. Sullivan
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
NAME	Michael J. Leonard
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>CORRESPONDENCE INFORMATION</b>	
NAME	Michael J. Leonard
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	2

FEE PER CLASS	325
*TOTAL FEE DUE	650
*TOTAL FEE PAID	650
<b>SIGNATURE INFORMATION</b>	
ORIGINAL PDF FILE	hw 6320917811-150710462 . 00331707.PDF
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\853\847\85384724\xml1\APP0003.JPG
SIGNATORY'S NAME	Felino L. Padlan
SIGNATORY'S POSITION	Authorized Representative/Attorney-In-Fact

## Trademark/Service Mark Application, Principal Register

Serial Number: 85384724

Filing Date: 07/29/2011

### To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of  
Barrio Fiesta Compound,  
Restaurant Ave., Marcos Hi-way  
Dela Paz, Pasig City  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 030: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

### The applicant's current Attorney Information:

Michael J. Leonard and Laura A. Genovese, Maureen C. Kassner and John P. Sullivan of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0001.

The applicant hereby appoints Michael J. Leonard of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103  
United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.

### The applicant's current Correspondence Information:

Michael J. Leonard  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1390(phone)  
215-525-5311(fax)  
usptotm@panitchlaw.com (authorized)

A fee payment in the amount of \$650 has been submitted with the application, representing payment for 2 class(es).

**Declaration.**

**Original PDF file:**

hw\_6320917811-150710462 . 00331707.PDF

**Converted PDF file(s) (1 page)**

Signature File1

Signatory's Name: Felino L. Padlan

Signatory's Position: Authorized Representative/Attorney-In-Fact

RAM Sale Number: 1643

RAM Accounting Date: 08/01/2011

Serial Number: 85384724

Internet Transmission Date: Fri Jul 29 15:11:44 EDT 2011

TEAS Stamp: USPTO/BAS-XX.XXX.XXX.XX-2011072915114465

9388-85384724-480118d3a13c8c1aa88f011dbe

273a0c2-DA-1643-20110729150710462830

# BARRIO FIESTA

**Declaration**

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, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. Section 1051(b), 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.

**Signature Section:**

Signature: 

Signatory's Name: FELINO L. PADLAN

Signatory's Position: Authorized Representative/Attorney-In-Fact

Date Signed: July 28, 2011

**NOTE TO APPLICANT:** When filed as part of the electronic form (i.e., scanned and attached as an image file), the signature page must include both the signature information and the boilerplate declaration language. Do not include the entire application, but do ensure that the boilerplate declaration language actually appears; *a signature by itself will not be acceptable*. If, due to browser limitations, the boilerplate declaration language appears on a previous page when printed, you must "merge" the declaration and signature block onto a single page prior to signing, so that the *entire complete page* can be scanned to create an acceptable image file. It is recommended that you copy and paste the entire text form into another document, manipulate the spacing there to move the declaration and signature section to a separate page, and then print this new version of the text form to send to the signatory.

---

**To:** Barrio Fiesta Manufacturing Corporation ([usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85384724 - BARRIO FIESTA - 688303.0001  
**Sent:** 11/22/2011 6:28:09 PM  
**Sent As:** ECOM102@USPTO.GOV

**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)  
[Attachment - 9](#)  
[Attachment - 10](#)  
[Attachment - 11](#)  
[Attachment - 12](#)  
[Attachment - 13](#)  
[Attachment - 14](#)  
[Attachment - 15](#)  
[Attachment - 16](#)  
[Attachment - 17](#)  
[Attachment - 18](#)  
[Attachment - 19](#)  
[Attachment - 20](#)  
[Attachment - 21](#)  
[Attachment - 22](#)  
[Attachment - 23](#)  
[Attachment - 24](#)  
[Attachment - 25](#)  
[Attachment - 26](#)  
[Attachment - 27](#)  
[Attachment - 28](#)  
[Attachment - 29](#)  
[Attachment - 30](#)  
[Attachment - 31](#)  
[Attachment - 32](#)  
[Attachment - 33](#)  
[Attachment - 34](#)  
[Attachment - 35](#)  
[Attachment - 36](#)  
[Attachment - 37](#)  
[Attachment - 38](#)  
[Attachment - 39](#)  
[Attachment - 40](#)  
[Attachment - 41](#)  
[Attachment - 42](#)  
[Attachment - 43](#)  
[Attachment - 44](#)

# **EXHIBIT 4**

## Request for Extension of Time to File a Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85384724
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION	
MARK	BARRIO FIESTA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
OWNER SECTION	
NAME	Barrio Fiesta Manufacturing Corporation
STREET	T. Santiago St. corner R. Jacinto St.
CITY	Metro Manila
COUNTRY	Philippines
EMAIL	usptotm@panitchlaw.com
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	029
CURRENT IDENTIFICATION	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
GOODS OR SERVICES	KEEP ALL LISTED
INTERNATIONAL CLASS	030
CURRENT IDENTIFICATION	coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice
GOODS OR SERVICES	KEEP ALL LISTED
EXTENSION SECTION	
EXTENSION NUMBER	1
ALLOWANCE MAIL DATE	10/09/2012
STATEMENT OF USE	NO

**PAYMENT SECTION**

NUMBER OF CLASSES	2
SUBTOTAL AMOUNT	300
TOTAL AMOUNT	300

**SIGNATURE SECTION**

SIGNATURE	/michael leonard/
SIGNATORY'S NAME	Michael J. Leonard
SIGNATORY'S POSITION	Attorney of Record, PA Bar Member
DATE SIGNED	04/09/2013

**FILING INFORMATION**

SUBMIT DATE	Tue Apr 09 15:35:43 EDT 2013
TEAS STAMP	USPTO/ESU-XX.XXX.XXX.XXX- 20130409153543159180-8538 4724-50037394aa9a2c68a7b1 1721e91bb192e382725edabca deebac1325983bd317-DA-199 3-20130409153020196933

**SOU Extension Request  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA  
**SERIAL NUMBER:** 85384724

The applicant, Barrio Fiesta Manufacturing Corporation, having an address of  
T. Santiago St. corner R. Jacinto St.  
Metro Manila,  
Philippines

requests a six-month extension of time to file the Statement of Use under 37 C.F.R. Section 2.89 in this application. The Notice of Allowance mailing date was 10/09/2012.

For International Class 029:

Current identification: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

For International Class 030:

Current identification: coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder, salt, mustard; vinegar, condiments, namely, sauces; spices; ice

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

This is the first extension request.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 2 classes.

**Declaration**

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; 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.

Signature: /michael leonard/ Date Signed: 04/09/2013  
Signatory's Name: Michael J. Leonard  
Signatory's Position: Attorney of Record, PA Bar Member

RAM Sale Number: 85384724  
RAM Accounting Date: 04/10/2013

Serial Number: 85384724  
Internet Transmission Date: Tue Apr 09 15:35:43 EDT 2013  
TEAS Stamp: USPTO/ESU-XX.XXX.XXX.XXX-201304091535431  
59180-85384724-50037394aa9a2c68a7b11721e  
91bb192e382725edabcadeebac1325983bd317-D  
A-1993-20130409153020196933

# **EXHIBIT 5**

## Request for Extension of Time to File a Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85384724
LAW OFFICE ASSIGNED	LAW OFFICE 102
<b>MARK SECTION</b>	
MARK	BARRIO FIESTA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
<b>OWNER SECTION</b>	
NAME	Barrio Fiesta Manufacturing Corporation
STREET	T. Santiago St. corner R. Jacinto St.
CITY	Metro Manila
COUNTRY	Philippines
EMAIL	usptotm@panitchlaw.com
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	029
CURRENT IDENTIFICATION	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
GOODS OR SERVICES	KEEP ALL LISTED
INTERNATIONAL CLASS	030
CURRENT IDENTIFICATION	coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice
GOODS OR SERVICES	KEEP ALL LISTED
<b>EXTENSION SECTION</b>	
EXTENSION NUMBER	2
ONGOING EFFORT	product or service research or development; market research; promotional activities
ALLOWANCE MAIL DATE	10/09/2012

STATEMENT OF USE	NO
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	2
SUBTOTAL AMOUNT	300
TOTAL AMOUNT	300
<b>SIGNATURE SECTION</b>	
ORIGINAL PDF FILE	hw_6320917811-112729170 . 00553546.PDF
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\853\847\85384724\xml12\ESU0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\853\847\85384724\xml12\ESU0003.JPG
SIGNATORY'S NAME	Veneranda M. Tomas
SIGNATORY'S POSITION	Chief Financial Officer
<b>FILING INFORMATION</b>	
SUBMIT DATE	Mon Sep 30 11:31:09 EDT 2013
TEAS STAMP	USPTO/ESU-XX.XXX.XXX.XX-2 0130930113109062966-85384 724-500be2ee76f3da5c9e66c fd6dd68f63189c3015c7318bc e1a32971f43784d69-CC-1009 -20130930112729170401

**SOU Extension Request  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK: BARRIO FIESTA**  
**SERIAL NUMBER: 85384724**

The applicant, Barrio Fiesta Manufacturing Corporation, having an address of  
T. Santiago St. corner R. Jacinto St.  
Metro Manila,  
Philippines

requests a six-month extension of time to file the Statement of Use under 37 C.F.R. Section 2.89 in this application. The Notice of Allowance mailing date was 10/09/2012.

For International Class 029:

Current identification: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

For International Class 030:

Current identification: coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

This is the second extension request. The applicant has made the following ongoing efforts to use the mark in commerce on or in connection with each of those goods/services covered by the extension request: product or service research or development; market research; promotional activities

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 2 classes.

**Declaration**

**Original PDF file:**

hw 6320917811-112729170 . 00553546.PDF

**Converted PDF file(s) (2 pages)**

Signature File1

Signature File2

Signatory's Name: Veneranda M. Tomas  
Signatory's Position: Chief Financial Officer

RAM Sale Number: 85384724  
RAM Accounting Date: 10/01/2013

Serial Number: 85384724  
Internet Transmission Date: Mon Sep 30 11:31:09 EDT 2013  
TEAS Stamp: USPTO/ESU-XX XXX XXX XX-2013093011310906  
2966-85384724-500be2ee76f3da5c9e66cfd6dd  
68f63189c3015c7318bce1a32971f43784d69-CC  
-1009-20130930112729170401

# **EXHIBIT 6**

Side - 1



**NOTICE OF ABANDONMENT**  
**MAILING DATE: Jun 24, 2014**

The trademark application identified below was abandoned because the applicant failed to file for a statement of use or an extension of time.

If the delay in filing a response was unintentional, you may file a petition to revive the application with a fee. If the abandonment of this application was due to USPTO error, you may file a request for reinstatement. Please note that a petition to revive or request for reinstatement **must be received within two months from the mailing date of this notice.**

For additional information, go to <http://www.uspto.gov/teas/petinfo.htm>. If you are unable to get the information you need from the website, call the Trademark Assistance Center at 1-800-786-9199.

**SERIAL NUMBER:** 85384724  
**MARK:** BARRIO FIESTA  
**OWNER:** Barrio Fiesta Manufacturing Corporation

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE  
COMMISSIONER FOR TRADEMARKS  
P.O. BOX 1451  
ALEXANDRIA, VA 22313-1451

FIRST-CLASS MAIL  
U.S. POSTAGE  
PAID

MICHAEL J. LEONARD  
PANITCH SCHWARZE BELISARIO & NADEL LLP  
2005 MARKET ST STE 2200  
PHILADELPHIA, PA 19103-7086

# **EXHIBIT 7**

## Trademark/Service Mark Application, Principal Register

Serial Number: 86528183

Filing Date: 02/09/2015

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86528183
MARK INFORMATION	
*MARK	<u>BARRIO FIESTA</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Barrio Fiesta Manufacturing Corporation
*STREET	Re30 T. Santiago Street, Camunay West
*CITY	Valenzuela City, MMLa
*COUNTRY	Philippines
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Philippines
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	029
*IDENTIFICATION	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 10/00/1999
FIRST USE IN COMMERCE DATE	At least as early as 10/00/1999
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\865281\86528183\xml1\ RFA0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\865281\86528183\xml1\ RFA0004.JPG
SPECIMEN DESCRIPTION	product label
INTERNATIONAL CLASS	030

*IDENTIFICATION	meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 04/00/2013
FIRST USE IN COMMERCE DATE	At least as early as 04/00/2013
SPECIMEN FILE NAME(S)	
JPG FILE(S)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0006.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0007.JPG
ORIGINAL PDF FILE	SPE010-6320917811-20150123080740123602 . USA-BF New Logo-DAU for Class 30.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0005.JPG
SPECIMEN DESCRIPTION	product packaging
<b>ATTORNEY INFORMATION</b>	
NAME	Patricia Smink Rogowski
ATTORNEY DOCKET NUMBER	688303.0002
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Tamika Crawl-Bey and Jefferson Cheatham
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
NAME	Patricia Smink Rogowski
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
EMAIL ADDRESS	usptotm@panitchlaw.com

AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
-------------------------------------	-----

**CORRESPONDENCE INFORMATION**

NAME	Patricia Smink Rogowski
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
*EMAIL ADDRESS	usptotm@panitchlaw.com; progowski@panitchlaw.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes

**FEE INFORMATION**

APPLICATION FILING OPTION	TEAS RF
NUMBER OF CLASSES	2
FEE PER CLASS	275
*TOTAL FEE DUE	550
*TOTAL FEE PAID	550

**SIGNATURE INFORMATION**

ORIGINAL PDF FILE	hw 6320917811-080204717 . 00703928.PDF
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0008.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0009.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0010.JPG
SIGNATORY'S NAME	/Rolando B. Hortaleza, M.D.
SIGNATORY'S POSITION	Authorized Signatory for Barrio Fiesta Manufacturing Corporation
SIGNATORY'S PHONE NUMBER	215-965-1330

## Trademark/Service Mark Application, Principal Register

Serial Number: 86528183

Filing Date: 02/09/2015

### To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of  
Re30 T. Santiago Street, Canumay West  
Valenzuela City, MM1a  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

In International Class 029, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 10/00/1999, and first used in commerce at least as early as 10/00/1999, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, consisting of a(n) product label.

Specimen File1

Specimen File2

International Class 030: meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;

In International Class 030, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 04/00/2013, and first used in commerce at least as early as 04/00/2013, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, consisting of a(n) product packaging.

**JPG file(s):**

Specimen File1

Specimen File2

**Original PDF file:**

SPE010-6320917811-20150123080740123602 . USA-BF New Logo- DAU for Class 30.pdf

**Converted PDF file(s) (1 page)**

Specimen File1

The applicant's current Attorney Information:

Patricia Smink Rogowski and Tamika Crawl-Bey and Jefferson Cheatham of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0002.

The applicant hereby appoints Patricia Smink Rogowski of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103

United States  
as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.  
The applicant's current Correspondence Information:

Patricia Smink Rogowski  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1330(phone)  
215-965-1331(fax)

usptotm@panitchlaw.com; progowski@panitchlaw.com (authorized)  
**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or applicant's attorney at the e-mail address provided above. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in an additional processing fee of \$50 per international class of goods/services.

A fee payment in the amount of \$550 has been submitted with the application, representing payment for 2 class(es).

#### Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

#### Declaration Signature

Signature: Not Provided Date: Not Provided  
Signatory's Name: /Rolando B. Hortaleza, M.D.  
Signatory's Position: Authorized Signatory for Barrio Fiesta Manufacturing Corporation  
RAM Sale Number: 86528183  
RAM Accounting Date: 02/09/2015

Serial Number: 86528183  
Internet Transmission Date: Mon Feb 09 08:08:26 EST 2015  
TEAS Stamp: USPTO/BAS-XX.XXX.XXX.XX-2015020908082673  
3301-86528183-530b442ade12c4ffa78b7d9b9d  
a87d53119cc5aace4b39b6f696c726430a441a-C  
C-8492-20150209080204717546

# BARRIO FIESTA

A quality product of  
Product of Canada Inc.

**splash**  
A quality product of  
Product of Canada Inc.

211 W. Main Street, Suite 111  
Amherst, Ontario L5B 1A1  
Canada (416) 441-1111

**SEALING PROCESS HOTLINE**  
1-800-367-0000  
Fax: (416) 441-1111

FOR EXPORT MARKETING

LOT 00000000000000000000  
BEST BEFORE/CONSUME AVANT

NOTE: When you see the words "Best Before" or "Consume Avant", it means the product is at its peak quality. It does not mean the product is no longer safe to eat.

NOTE: The product is not intended for use as a food supplement. It is a food product. It is not intended to be used as a food supplement.

**HACCP**  
CERTIFIED

For more information, please contact  
the manufacturer or distributor.



**SAUTÉÉ**

**Bando**  
**FIESTA**

**Sautéed Shrimp Paste**  
Pâte de Crevettes Rissolée  
Sweet/Douce



NET WT. 50g (1.76oz)

**Nutrition Facts**

Serving Size 15g (1/2 oz)  
Amount Per Serving

	Amount Per Serving	% Daily Value
Total Fat	1.0g	2%
Sodium	1.0g	20%
Total Crap	1.0g	2%
Total Fat	1.0g	2%
Sodium	1.0g	20%
Total Crap	1.0g	2%
Total Fat	1.0g	2%
Sodium	1.0g	20%
Total Crap	1.0g	2%
Total Fat	1.0g	2%
Sodium	1.0g	20%
Total Crap	1.0g	2%

AGREEMENT: Based on the  
Contract: Based on the  
Contract: Based on the

Contract: Based on the

Contract: Based on the

Contract: Based on the

Contract: Based on the

Contract: Based on the





**Bagoong**  
(Sautéed Shrimp Paste)

Net Wt. 250g (8.8 oz)

**Barrio  
FIESTA**

**Bagoong**  
(Sautéed Shrimp Paste)

Net Wt. 250g (8.8 oz)



**Barrio  
FIESTA**

**Bagoong**  
(Sautéed Shrimp Paste)

Net Wt. 250g (8.8 oz)



**Boulio<sup>®</sup> FIESTA**

**Afritada**  
Meat Stew Mix

Net Wt. 405g (14.21 oz.)



**Boulio<sup>®</sup> FIESTA**

**All-Around Gata**  
Coconut Milk Powder Mix

Net Wt. 405g (14.21 oz.)



**Boulio<sup>®</sup> FIESTA**

**Kare**  
Ice Mix

Net Wt. 405g (14.21 oz.)





**Trademark/Service Mark Application, Principal Register**  
**Handwritten Signature:**

**To the Commissioner for Trademarks:**

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of

Re30 T. Santiago Street, Camamay West  
Valenzuela City, MM1a  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

In International Class 029, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 10/00/1999, and first used in commerce at least as early as 10/00/1999, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) product label.  
Specimen-1 [SPE010-6320917811-20150123080740123602\_BF-SSP-Sweet\_CO\_500g-DAU6-Class\_29.jpg]

International Class 030: meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;

In International Class 030, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 04/00/2013, and first used in commerce at least as early as 04/00/2013, and is now in use in such commerce. The applicant is

submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) product packaging.  
Specimen-1 [SPE010-6320917811-20150123080740123602 \_USA-BF\_New\_Logo-  
\_DAU\_for\_Class\_30.pdf]

The applicant's current Attorney Information:

Patricia Smink Rogowski and Tamika Crawl-Bey and Jefferson Cheatham of Panitch  
Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0002.

The applicant hereby appoints Patricia Smink Rogowski of Panitch Schwarze Belisario & Nadel  
LLP

2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103  
United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark  
may be served.

The applicant's current Correspondence Information:

Patricia Smink Rogowski  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1330(phone)  
215-965-1331(fax)

uspto@panitchlaw.com;proowski@panitchlaw.com (authorized)


**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the  
application to the applicant or applicant's attorney at the e-mail address provided below. I  
understand that a valid e-mail address must be maintained and that the applicant or the  
applicant's attorney must file the relevant subsequent application-related submissions via the  
Trademark Electronic Application System (TEAS). Failure to do so will result in an additional  
processing fee of \$50 per international class of goods and/or services.

A fee payment in the amount of \$550 will be submitted with the application, representing  
payment for 2 class(es).

### Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

### Signature Section:

Signature: 

Signatory's Name: / ROLANDO B. HORTALEZA, M.D.

Signatory's Position: Authorized Signatory for Barrio Fiesta Manufacturing Corporation

Signatory's Phone Number: 215-965-1330

Date Signed: \_\_\_\_\_

# **EXHIBIT 8**

---

To: Barrio Fiesta Manufacturing Corporation ([usptoim@panitchlaw.com](mailto:usptoim@panitchlaw.com))  
Subject: U.S. TRADEMARK APPLICATION NO. 86528183 - BARRIO FIESTA - 688303.0002  
Sent: 5/14/2015 1:01:55 PM  
Sent As: ECOM112@USPTO.GOV  
Attachments:

---

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON 5/14/2015 FOR U.S. APPLICATION SERIAL NO. 86528183

Please follow the instructions below:

(1) **TO READ THE LETTER:** Click on this link or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) **TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from 5/14/2015 (or sooner if specified in the Office action). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

(3) **QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For technical assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**WARNING**

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies not associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).

---

**To:** Barrio Fiesta Manufacturing Corporation ([usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86528183 - BARRIO FIESTA - 688303.0002  
**Sent:** 5/14/2015 1:01:54 PM  
**Sent As:** ECOM112@USPTO.GOV

**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)  
[Attachment - 9](#)  
[Attachment - 10](#)  
[Attachment - 11](#)  
[Attachment - 12](#)  
[Attachment - 13](#)  
[Attachment - 14](#)  
[Attachment - 15](#)  
[Attachment - 16](#)  
[Attachment - 17](#)  
[Attachment - 18](#)  
[Attachment - 19](#)  
[Attachment - 20](#)  
[Attachment - 21](#)  
[Attachment - 22](#)  
[Attachment - 23](#)  
[Attachment - 24](#)  
[Attachment - 25](#)  
[Attachment - 26](#)  
[Attachment - 27](#)  
[Attachment - 28](#)  
[Attachment - 29](#)  
[Attachment - 30](#)  
[Attachment - 31](#)  
[Attachment - 32](#)  
[Attachment - 33](#)  
[Attachment - 34](#)  
[Attachment - 35](#)  
[Attachment - 36](#)  
[Attachment - 37](#)  
[Attachment - 38](#)  
[Attachment - 39](#)  
[Attachment - 40](#)  
[Attachment - 41](#)

---

U.S. APPLICATION SERIAL NO. 86528183

MARK: BARRIO FIESTA

**\*86528183\***

**CORRESPONDENT ADDRESS:**

PATRICIA SMINK ROGOWSKI  
PANITCH SCHWARZE BELISARIO & NADEL LLP  
2005 MARKET ST STE 2200  
PHILADELPHIA, PA 19103-7086

**CLICK HERE TO RESPOND TO THIS**

**LETTER:**

[http://www.uspto.gov/trademarks/tcas/response\\_forms.jsp](http://www.uspto.gov/trademarks/tcas/response_forms.jsp)

**VIEW YOUR APPLICATION FILE**

**APPLICANT:** Barrio Fiesta Manufacturing Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO.:**

688303.0002

**CORRESPONDENT E-MAIL ADDRESS:**

[usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 5/14/2015

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**Summary of Issues That Applicant Must Address**

- Section 2(d) Refusal—Likelihood of Confusion
- Prior-filed Pending Applications
- Identification of Goods

**Section 2(d) Refusal—Likelihood of Confusion**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4034365. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration as EXHIBIT A.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. See *In re Vittera Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant applied to register BARRIO FIESTA for "meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping" in class 29 and "meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices" in class 30.

The registered mark is BARRIO FIESTS EXPRESS, Reg. No. 4034365, for "fast-food restaurants."

#### Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

Applicant's mark is similar to the registered mark because they both include the dominant portion BARRIO FIESTA. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

Applicant's deletion of the word EXPRESS does not obviate this refusal. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark.

Therefore, applicant's mark is very similar to the registered mark.

#### Comparison of the Goods and Services

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant's goods are related to the registered services because restaurants often provide prepared foods, sauces, and condiments. See attached EXHIBIT C from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. This evidence shows that the goods and services listed therein, namely, restaurant services and food products in classes 29 and 30, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). In fact, the registrant has a prior-filed pending application that includes many of the goods listed in the application. See below.

Therefore, applicant's goods are highly related to the registered services.

#### Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Since the marks are similar and the goods and services are related, there is a likelihood of confusion as to the source of applicant's goods and

services. Therefore, applicant's mark is not entitled to registration.

#### **Prior-filed Pending Applications**

The filing dates of pending U.S. Application Serial Nos. 85951658 and 86490510 precede applicant's filing date. See attached EXHIBIT B. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

#### **Identification of Goods**

The identification of goods is indefinite and must be clarified as indicated below. See TMEP §1402.01. Applicant may adopt the following identification, if accurate:

Class 29: meat, *not live* fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping; *dips*.

Class 30: *Food* flavorings and powdered *food* mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces; spices; *milk products, namely, ice cream, ice milk and frozen yogurt*.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

#### **Contacting the Examining Attorney**

If applicant has any questions concerning the above action, it is encouraged to contact the examining attorney at the number listed below.

/DETJr/  
David E. Tooley, Jr.  
Trademark Examining Attorney  
Law Office 112  
571-272-8206  
[david.tooley@uspto.gov](mailto:david.tooley@uspto.gov)

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

## EXHIBIT A

Print: May 14, 2015

85243004

**DESIGN MARK**

**Serial Number**

85243004

**Status**

REGISTERED

**Word Mark**

BARRIO FIESTA EXPRESS

**Standard Character Mark**

Yes

**Registration Number**

4034365

**Date Registered**

2011/10/04

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

RONO, JUSTIN CHRISTIAN C. INDIVIDUAL UNITED STATES 4034365 SAN JOSE  
CALIFORNIA 95132

**Owner**

RONO, ASHLEY KIRSTEN C. INDIVIDUAL UNITED STATES 1629 WHARTON ROAD SAN  
JOSE CALIFORNIA 95132

**Owner**

RONO, JUNE FRANCIS INDIVIDUAL UNITED STATES 1629 WHARTON ROAD SAN JOSE  
CALIFORNIA 95132

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Fast-food  
restaurants. First Use: 2011/01/03. First Use In Commerce:  
2011/01/03.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EXPRESS" APART FROM  
THE MARK AS SHOWN.

**Translation Statement**

**Print: May 14, 2015**

**85243004**

The English translation of "Barrio Fiesta" in the mark is  
"Neighborhood Party".

**Filing Date**  
2011/02/15

**Examining Attorney**  
FELDMAN, DAWN

**Attorney of Record**  
James Cai

# Barrio Fiesta Express

## EXHIBIT B

**Print: May 14, 2015**

**85951658**

**DESIGN MARK**

**Serial Number**

85951658

**Status**

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

**Word Mark**

THE ORIGINAL BARRIO FIESTA OF MANILA

**Standard Character Mark**

No

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

CONSUELO ONGPAUCO CAUTON INDIVIDUAL PHILIPPINES 10252 HADLEY AVENUE  
NORTHRIDGE CALIFORNIA 91324

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services. First Use: 1987/08/15. First Use In Commerce: 1987/08/15.

**Description of Mark**

The mark consists of a design of a pot, with a lid, over flames and  
the stylized words The Original Barrio Fiesta of Manila.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Translation Statement**

The English translation of Barrio Fiesta in the mark is Village Feast..

**Filing Date**

2013/06/05

**Examining Attorney**

LEWIS, SHAILA

**Attorney of Record**

David L. Hoffman



*The Original*

**Bonito FIESTA**

*of Mexico*

Print: May 14, 2015

86490510

**DESIGN MARK**

**Serial Number**

86490510

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

BARRIO FIESTA EXPRESS

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

[4] STANDARD CHARACTER MARK

**Owner**

Justin C. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Owner**

Ashley K. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Owner**

June F. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Frozen meat,  
deserts, cooked packaged food, mixes for marinades, candies, frozen  
vegetables, frozen cooked vegetables, preserved and dried fruits.  
First Use: 2014/12/06. First Use In Commerce: 2014/12/06.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: beverage, bread,  
pastry, sauces, spices.

**Filing Date**

2014/12/24

**Examining Attorney**

GOLDEN, LAURA

Print: May 14, 2015

86490510

Attorney of Record  
James Cai

# Barrio Fiesta Express

## EXHIBIT C

Print: May 14, 2015

86156164

**DESIGN MARK**

**Serial Number**

86156164

**Status**

REGISTERED

**Word Mark**

ADEGA MODERN MEDITERRANEAN

**Standard Character Mark**

No

**Registration Number**

4717620

**Date Registered**

2015/04/07

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

Geis Hospitality, LLC LIMITED LIABILITY COMPANY OHIO 2017 East 9th  
Street Cleveland OHIO 44115

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared entrees  
consisting primarily of meat, fish, poultry, or vegetables for dine-in  
or carry-out. First Use: 2013/10/04. First Use In Commerce:  
2014/09/05.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant and  
bar services; Catering services. First Use: 2013/10/04. First Use In  
Commerce: 2014/09/05.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Prepared entrees  
consisting primarily of pasta or rice for dine-in or carry-out. First  
Use: 2013/10/04. First Use In Commerce: 2014/09/05.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MODERN MEDITERRANEAN"

Print: May 14, 2015

86156164

APART FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the word "ADEGA" above the word "MODERN", which is above the word "MEDITERRANEAN", all in stylized writing.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Translation Statement**

The English translation of "ADEGA" in the mark is "cellar".

**Filing Date**

2014/01/02

**Examining Attorney**

CASE, LEIGH CAROLINE

**Attorney of Record**

Steven J. Solomon

adega

MODERN  
MEDITERRANEAN

Print: May 14, 2015

86161658

**DESIGN MARK**

**Serial Number**

86161658

**Status**

REGISTERED

**Word Mark**

THE LAST TRUE CHICKEN SANDWICH

**Standard Character Mark**

Yes

**Registration Number**

4713692

**Date Registered**

2015/03/31

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

YEB I LLC LIMITED LIABILITY COMPANY DELAWARE 7100 Corporate Drive  
Plano TEXAS 75024

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Chicken. First  
Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches. First  
Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services; take-out restaurant services. First Use: 2014/04/09. First  
Use In Commerce: 2014/04/09.

**Filing Date**

2014/01/09

**Examining Attorney**

GAYNOR, BARBARA

Print: May 14, 2015

86161658

**Attorney of Record**  
Leanne Stendell

# THE LAST TRUE CHICKEN SANDWICH

Print: May 14, 2015

86161681

**DESIGN MARK**

**Serial Number**  
86161681

**Status**  
REGISTERED

**Word Mark**  
SUPER CHIX CHICKEN & FRIES

**Standard Character Mark**  
No

**Registration Number**  
4587081

**Date Registered**  
2015/02/17

**Type of Mark**  
TRADEMARK; SERVICE MARK

**Register**  
PRINCIPAL

**Mark Drawing Code**  
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**  
YEB I LLC LIMITED LIABILITY COMPANY DELAWARE 7100 Corporate Drive  
Plano TEXAS 75024

**Goods/Services**  
Class Status -- ACTIVE. IC 029. US 046. G & S: Chicken; French  
fries, French fried potatoes, French fried onions; salads, namely,  
vegetable salads with and without chicken. First Use: 2014/04/09.  
First Use In Commerce: 2014/04/09.

**Goods/Services**  
Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches; dipping  
sauces; frozen custards. First Use: 2014/04/09. First Use In  
Commerce: 2014/04/09.

**Goods/Services**  
Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services; take-out restaurant services. First Use: 2014/04/09. First  
Use In Commerce: 2014/04/09.

**Disclaimer Statement**  
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CHICKEN & FRIES" APART

Print: May 14, 2015

86161681

FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the words "SUPER" and "CHIX" in a stylized format above the words "CHICKEN & FRIES" in a stylized format.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Filing Date**

2014/01/09

**Examining Attorney**

GAYNOR, BARBARA

**Attorney of Record**

Leanne Stendell

# **SUPER CHIX**

**CHICKEN & FRIES**

Print: May 14, 2015

86281982

**DESIGN MARK**

**Serial Number**

86281982

**Status**

REGISTERED

**Word Mark**

LAS ALIADAS

**Standard Character Mark**

Yes

**Registration Number**

4663148

**Date Registered**

2014/12/30

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

ARINDA GARZA ARANGUA INDIVIDUAL MEXICO Pablo M de Sarasate #104, San Jeronimo Monterrey, NL MEXICO 64630

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Seasoned meat, seafood and poultry. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sauces. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Café and restaurant services. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Translation Statement**

The English translation of "Las Aliadas" in the mark is "The Allied".

**Filing Date**

**Print: May 14, 2015**

**86281982**

2014/05/15

**Examining Attorney**  
POWELL, LINDA

# LAS ALIADAS

Print: May 14, 2015

86292281

**DESIGN MARK**

**Serial Number**

86292281

**Status**

REGISTERED

**Word Mark**

OREN'S HUMMUS SHOP

**Standard Character Mark**

No

**Registration Number**

4698745

**Date Registered**

2015/03/10

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Oren's Hummus, LLC LIMITED LIABILITY COMPANY CALIFORNIA 261 University Avenue Palo Alto CALIFORNIA 94301

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100.101. G & S: Restaurant and catering services. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Hummus; vegetable-based spreads and dips; snack dips; pre-cut salads consisting of lettuce, vegetables, fruit, proteins, grains, and cheese. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Hot sauce; hot chili pepper sauce; chili paste for use as a seasoning; garlic-based sauce; bread and pastry; rugelach; babka; white and whole wheat pita bread. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Disclaimer Statement**

Print: May 14, 2015

86292281

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HUMMUS SHOP" APART FROM THE MARK AS SHOWN.

**Name/Portrait Statement**

The name(s), portrait(s), and/or signature(s) shown in the mark identifies Oren Dobronsky, whose consent(s) to register is made of record.

**Description of Mark**

The mark consists of a horizontal black oval with the words "Oren's Hummus shop" in black centered within it and a stylized green olive branch on the left side of the oval.

**Colors Claimed**

The color(s) green and black is/are claimed as a feature of the mark.

**Filing Date**

2014/05/27

**Examining Attorney**

STEIN, JAMES

**Attorney of Record**

Lisa Liu



Print: May 14, 2015

86316957

**DESIGN MARK**

**Serial Number**

86316957

**Status**

REGISTERED

**Registration Number**

4730521

**Date Registered**

2015/05/05

**Type of Mark**

TRADEMARK; SERVICE MARK; COLLECTIVE SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(2) DESIGN ONLY

**Owner**

Cajun Funding Corp. DBA Church's Chicken CORPORATION DELAWARE Suite  
1100 980 Hammond Drive Atlanta GEORGIA 30328

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared meals consisting primarily of chicken for consumption on or off the premises; prepared side dishes, namely, mashed potatoes, fried potatoes, pickled jalapenos, breaded and fried jalapeno peppers, coleslaw, and fried okra. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Biscuits; prepared side dishes, namely, macaroni and cheese and corn on the cob; desserts, namely, pies; tea-based beverages; and sauces. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100.101. G & S: Restaurant services. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Description of Mark**

The mark consists of a picture of two golden brown fried chicken legs which overlap to form the shape of a heart.

**Colors Claimed**

The color(s) golden brown is/are claimed as a feature of the mark.

**Print: May 14, 2015**

**86316957**

**Filing Date**  
2014/06/23

**Examining Attorney**  
BROOKSHIRE, DAVID



Print: May 14, 2015

86316988

**DESIGN MARK**

**Serial Number**

86316988

**Status**

REGISTERED

**Word Mark**

HAVE THE LOVE

**Standard Character Mark**

Yes

**Registration Number**

4678773

**Date Registered**

2015/01/27

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Cajun Funding Corp. DBA Church's Chicken CORPORATION DELAWARE Suite  
1100 980 Hammond Drive Atlanta GEORGIA 30328

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared meals consisting primarily of chicken for consumption on or off the premises; prepared side dishes, namely, mashed potatoes, fried potatoes, pickled jalapenos, breaded and fried jalapeno peppers, coleslaw, and fried okra. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Biscuits; prepared side dishes, namely, macaroni and cheese and corn on the cob; desserts, namely, pies; tea-based beverages; and sauces. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant services. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Print: May 14, 2015**

**86316988**

**Filing Date**  
2014/06/23

**Examining Attorney**  
BROOKSHIRE, DAVID

HAVE THE LOVE

Print: May 14, 2015

86351130

**DESIGN MARK**

**Serial Number**

86351130

**Status**

REGISTERED

**Word Mark**

SUBWAY FRESH FIT FOR KIDS

**Standard Character Mark**

Yes

**Registration Number**

4699469

**Date Registered**

2015/03/10

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Doctor's Associates Inc. CORPORATION FLORIDA 325 Bic Drive Milford  
CONNECTICUT 06461

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services, First Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches. First  
Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Processed apples.  
First Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Prior Registration(s)**

1174608; 4205708; 4217167; AND OTHERS

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FRESH" AND "FOR KIDS".  
APART FROM THE MARK AS SHOWN.

Print: May 14, 2015

86351130

**Filing Date**

2014/07/29

**Examining Attorney**

HOFFMAN, DAVID

**Attorney of Record**

Jessica Johnson- Connecticut Bar Member

SUBWAY FRESH FIT FOR KIDS

Print: May 14, 2015

86375918

**DESIGN MARK**

**Serial Number**

86375918

**Status**

REGISTERED

**Word Mark**

RICK'S BARBECUE

**Standard Character Mark**

Yes

**Registration Number**

4723150

**Date Registered**

2015/04/21

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Rick's Barbecue, Inc. CORPORATION TENNESSEE P.O. Box 725 Lawrenceburg.  
TENNESSEE 38464

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Precooked meats  
sold in vacuum-sealed packages. First Use: 1990/10/25. First Use In  
Commerce: 1990/10/26.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sauces. First Use:  
2009/03/23. First Use In Commerce: 2009/03/23.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant and  
catering services. First Use: 1984/01/01. First Use In Commerce:  
1984/01/01.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BARBECUE" APART FROM  
THE MARK AS SHOWN.

**Print: May 14, 2015**

**86375918**

**Filing Date**  
2014/08/25

**Examining Attorney**  
BOULTON, KELLY

**Attorney of Record**  
John C. Blattner

# Rick's Barbecue

Print: May 14, 2015

86387148

**DESIGN MARK**

**Serial Number**

86387148

**Status**

REGISTERED

**Word Mark**

SWEET BUTTER KITCHEN • CAFÉ MARKET

**Standard Character Mark**

No

**Registration Number**

4731147

**Date Registered**

2015/05/05

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Rberge Holdings LLC LIMITED LIABILITY COMPANY CALIFORNIA 13824 Ventura Blvd. Sherman Oaks CALIFORNIA 91423

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Jellies and jams; Potato chips; Salads, namely, fruit salads; Soups; Vegetable salads. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Candy; Chocolate covered pretzels; Cookie dough; Cookies; Crackers; Croissants; Fudge; Hot sauce; Macaroons; Peanut brittle; Popcorn; Sandwiches; Toast; Tortilla chips. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Café and restaurant services; Catering; Catering services; Restaurant; Restaurant and Café services; Restaurant and catering services; Take-out restaurant services. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

Print: May 14, 2015

86387148

**Prior Registration(s)**

3932528

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KITCHEN" AND "CAFE"  
AND "MARKET" APART FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the words "SWEET BUTTER KITCHEN . CAFE . MARKET"  
surrounded by a fanciful oval border with a series of wide stripes in  
the background. The gray is intended to show shading only and color is  
not claimed as a feature of the mark.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Filing Date**

2014/09/05

**Examining Attorney**

BUCHANAN WILL, NORA

**Attorney of Record**

J. Harrison Colter



**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing DECLARATION OF JAMES CAI IN SUPPORT OF REGISTRANTS' OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served on counsel for Petitioner on April 6, 2017, by sending the same via FEDEX overnight delivery, to:

Melvin N.A. Avanzado  
THE AVANZADO LAW FIRM  
1880 Century Park East, Suite 1100  
Los Angeles, CA 90067

/S/ JAMES CAI  
James Cai, Esq.  
Attorney for Registrants

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

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KIRSTEN  
C. RONO AND JUSTIN CHRISTIAN C.  
RONO,

Registrants.

Cancellation No. 92063674

In the Matter of Registration No. 4,034,365

Mark: BARRIO FIESTA EXPRESS

Date Issued: October 4, 2011

*[Opposition to Motion for Summary  
Judgment; Request for Judicial Notice;  
Declaration of June Rono; Exhibits to Cai  
Declaration filed concurrently herewith]*

**REGISTRANTS' RESPONSE TO PETITIONER'S SEPARATE STATEMENT**

**OF UNDISPUTED FACTS**

Registrants June Rono, Ashley Rono, and Justine Rono hereby submit its response to Petitioner's separate statement of undisputed facts in support of its motion for summary judgment on its petition to cancel (the "Petition") the mark, BARRIO FIESTA EXPRESS, Registration No. 4,034,365 (the "365 Mark") issued on October 4, 2011.

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p style="text-align: center;"><b>THE BACKGROUND BEHIND AND CREATION OF “BARRIO FIESTA”</b></p>	
<p>1. The “Barrio Fiesta” mark was first used in 1958 by Sixta-Evangelista Ongpauco (“Mrs. Ongpauco”) who started a restaurant in the Philippines which has become an iconic restaurant brand.</p> <p>Bonifacio Ongpauco (“Bonifacio”) Depo. at 8:5-9:20 (Avanzado Ex. 3-A); Alianan Decl. ¶ 6 &amp; Ex. B (“Philippines’ Greatest Brands”) (Avanzado Ex. 1 &amp; Ex. 1-B)</p>	<p>Disputed.</p> <p>The cited facts do not support the contention that Barrio Fiesta is an “iconic restaurant brand” in the United States.</p>
<p>2. Mrs. Ongpauco had eight children, each of whom opened one or more “Barrio Fiesta” restaurants in the Philippines.</p> <p>Bonifacio Depo. at 8:5-16, 9:21-10:16, 27:11-21 (Avanzado Ex. 3-A); Cesar Cauton (“Cauton”) Depo. at 7:12-8:12, 9:19-20:24 (Avanzado Ex. 3-B)</p>	<p>Undisputed.</p>
<p>3. In 1987, one of the Ongpauco children, Corazon E. Ongpauco-Tamayo and her husband (collectively “Ongpauco-Tamayo”), opened the first “Barrio Fiesta” restaurant in the United States on 6th Street in Los Angeles, California called “The Original Barrio Fiesta of Manila” (the “Los Angeles BF Restaurant”).</p> <p>Bonifacio Depo. at 11:12-12:15, 30:2-16 (Avanzado Ex. 3-A); Cauton Depo. at 11:4-12:19, 14:7-11 (Avanzado Ex. 3-B)</p>	<p>Undisputed.</p>
<p>4. In or about 1994, Ongpauco-Tamayo transferred the Los Angeles BF Restaurant to another Ongpauco sibling, Consuelo Ongpauco-Cauton and her husband Cesar Cauton (collectively, the “Cautons”).</p> <p>Cauton Depo. at 11:7-12:8, 20:7-21:4 (Avanzado Ex. 3-B)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>5. The Cautons have been operating one or more “Barrio Fiesta” branded restaurants in various locations in the Los Angeles area from 1994 through the present.</p> <p>Cauton Depo. at 11:7-12:8, 14:7-11, 17:14-19:18, 22:25-23:9 (Avanzado Ex. 3-B)</p>	<p>Disputed.</p> <p>At the time June Rono purchased the Barrio Fiesta restaurant, he believed it to be the only operational restaurant using the mark Barrio Fiesta in the United States. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 8) &amp; Decl. of Cai Ex. 2 (Decl. of Cai. Ex. 2 (June Dep. 142: 3-11)).</p>
<p>6. Since 1987, there has been at least one restaurant in the Los Angeles area doing business under “The Original Barrio Fiesta of Manila” brand name and marks continuously through today.</p> <p>Cauton Depo. at 11:7-12:8, 14:7-19:6 (Avanzado Ex. 3-B) &amp; Avanzado Ex. 3-R (Barrio Fiesta product), Ex. 3-S (Milpitas BF Restaurant exterior)</p>	<p>Disputed.</p> <p>At the time June Rono purchased the Barrio Fiesta restaurant, he believed it to be the only operational restaurant using the mark Barrio Fiesta in the United States. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 8) &amp; Decl. of Cai Ex. 2 (Decl. of Cai. Ex. 2 (June Dep. 142: 3-11)).</p>
<p>7. In or around 1992, another Ongpauco sibling, Reynaldo Ongpauco (“Reynaldo”), opened a restaurant in Milpitas, California also called “The Original Barrio Fiesta of Manila” (the “Milpitas BF Restaurant”).</p> <p>Cauton Depo. at 21:5-22:11 (Avanzado Ex. 3-B) &amp; Avanzado Ex. 3-S (Milpitas BF Restaurant)</p>	<p>Undisputed.</p>
<p>8. The Milpitas BF Restaurant opened after the Los Angeles BF Restaurant.</p> <p>Cauton Depo. at 11:7-12:15, 50:18-21 (Avanzado Ex. 3-B) (“Q: Is there any doubt in your mind that the 6th Street Barrio Fiesta branch was the first one in the United States? A: No doubt.”)</p>	<p>Disputed.</p> <p>At the time June Rono purchased the Barrio Fiesta restaurant, he believed it to be the only operational restaurant using the mark Barrio Fiesta in the United States. [Decl. of Cai Ex. 1 (Decl. of June Rono ¶ 8) &amp; Decl. of Cai Ex. 2 (Decl. of Cai. Ex. 2 (June Dep. 142: 3-11)).</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p style="text-align: center;"><b>BFMC'S DISTRIBUTION OF "BARRIO FIESTA" PRODUCTS IN THE UNITED STATES</b></p>	
<p>9. Bonifacio started BFMC in 1987 in the Philippines.</p> <p>Bonifacio Depo. at 18:24-21:1 (Avanzado Ex. 3-A); RJN ¶ G; Avanzado Exs. 3-T &amp; 3-U (BFMC by-laws &amp; articles of incorporation)</p>	<p>Undisputed.</p>
<p>10. By November 1987, BFMC started manufacturing packaged food products under the "Barrio Fiesta" label.</p> <p>Bonifacio Depo. at 22:2-23:18 (Avanzado Ex. 3-A) &amp; Ex. 3-R (Barrio Fiesta product)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>11. From its inception in 1987, BFMC exported its products bearing the “Barrio Fiesta” name to the United States. At first, BFMC sold products through the Los Angeles BF Restaurant.</p> <p>Bonifacio Depo. at 23:19-27:2, 69:12-17 (Avanzado Ex. 3-A) &amp; Avanzado Ex. 3-R (Barrio Fiesta product)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>12. BFMC's products would be used and sold at the Los Angeles BF Restaurant and also sold to consumers through grocery stores in the United States.</p> <p>Bonifacio Depo. at 26:15-27:2 (Avanzado Ex. 3-A)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark "Barrio Fiesta" (serial number 85384724). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation's mark "Barrio Fiesta" (serial number 85384724) for failing to submit a statement of use. [Plaintiff's RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>13. Later, BFMC used other companies to distribute its products in the United States.</p> <p>Bonifacio Depo. at 30:17-40:17, 89:3-15 (Avanzado Ex. 3-A)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>14. In 1990s, BFMC products were distributed in the United States through Town Fiesta Trading, Inc. ("Town Fiesta") and a wholesaler called Global Foods to grocery stores throughout California and Las Vegas, Nevada. Bonifacio also personally sold Barrio Fiesta brand products in New York.</p> <p>Bonifacio Depo. at 30:17-34:10; 35:16-36:18; 74:6-15; 89:3-15 (Avanzado Ex. 3-A) &amp; Avanzado Ex. 3-W (Town Fiesta entity detail)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark "Barrio Fiesta" (serial number 85384724). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation's mark "Barrio Fiesta" (serial number 85384724) for failing to submit a statement of use. [Plaintiff's RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>15. In or about 1992, BEO Trading Corporation (“BEO Trading”) began to distribute Barrio Fiesta products in the United States. BFMC, through BEO Trading, sold Barrio Fiesta products to a company called Ilocos Best, which in turn sold such products to Global Foods. BEO Trading’s arrangement with Ilocos Best lasted from 1992 until approximately 2006.</p> <p>Bonifacio Depo. at 34:24-37:13, 38:10-40:17, 40:25-43:22 (Avanzado Ex. 3-A) &amp; Avanzado Ex. 3-X (BEO Trading entity detail)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>16. Global Foods is a Northern California based company whose formal corporate name is Global Commodities Corporation. Global Foods has been in business since 1985. Global Foods distributes imported food products from the Philippines and Asia to retailers and other wholesale distributors throughout the United States.</p> <p>Declaration of Ronald Yu ("Yu") ¶¶ 1-3 (Avanzado Ex. 2)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>17. Global Foods has distributed Barrio Fiesta products since at least 1989.</p> <p>Yu Decl. ¶¶ 5-13 (Avanzado Ex. 2) &amp; Avanzado Exs. 2-A through 2-D; Bonifacio Depo. at 34:11-23, 35:16-25, 36:22-38:9 (Avanzado Ex. 3-A)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>18. The Barrio Fiesta products distributed by Global Foods ultimately are sold to consumers.</p> <p>Yu Decl. ¶¶ 3-7 (Avanzado Ex. 2); Bonifacio Depo. at 37:5-11 (Avanzado Ex. 3-A)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark “Barrio Fiesta” (serial number 85384724). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff’s RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its “Barrio Fiesta” mark application (serial number 85384724). [Plaintiff’s RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation’s mark “Barrio Fiesta” (serial number 85384724) for failing to submit a statement of use. [Plaintiff’s RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>19. Since 2006, Northridge Foods International, Inc. ("Northridge") and its affiliate in the Philippines, Northridge Foods Import &amp; Export, Inc. ("Northridge Philippines"), have been BFMC's exclusive United States distributor of "Barrio Fiesta" products.</p> <p>Bonifacio Depo. at 39:16-40:14, 43:3-12 (Avanzado Ex. 3-A); Declaration of Erlinda Alianan ("Alianan") ¶¶ 3-5 (Avanzado Ex. 1)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>20. Since Northridge and Northridge Philippines started distributing BFMC's Barrio Fiesta products, those products have been sold to nearly every state in the United States – not just California. By 2011, BFMC's "Barrio Fiesta" products were sold almost everywhere in the world, including all 50 states in the United States.</p> <p>Bonifacio Depo. at 72:19-74:15, 85:1-12, 91:15-19 (Avanzado Ex. 3-A); Erwin Santos ("Santos") Depo. at 17:22-18:5, 18:6-11 ("Q: Do you have records as to where you have shipping Barrio Fiesta branded products? ... A: We shipped to every single 50 states..."), 26:17-19, 30:22-31:10, 35:7-16 (Avanzado Ex. 3-C)</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark "Barrio Fiesta" (serial number 85384724). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation's mark "Barrio Fiesta" (serial number 85384724) for failing to submit a statement of use. [Plaintiff's RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>

UNDISPUTED FACTS And SUPPORTING EVIDENCE	RESPONSE
FACTS UNDERLYING THE REGISTRATION OF THE '365 MARK	
<p>21. Registrants are the current owners of the '365 Mark in the International Class 043 (fast food restaurants). The '365 Mark was issued on October 4, 2011. Registrants alleged that their first use of BARRIO FIESTA EXPRESS for the '365 Mark was January 3, 2011.</p> <p>RJN ¶¶ C, D, E &amp; F &amp; RJN Ex. 3; Avanzado Exs. 3-O, 3-P &amp; 3-JJ</p>	Undisputed.
<p>22. In 2010, Registrant June executed an agreement to purchase an existing "Barrio Fiesta" restaurant in Milpitas, California – <i>i.e.</i> the Milpitas BF Restaurant – effective January 2011.</p> <p>Deposition of June Francis Rono ("June") at 10:15-21 (Avanzado Ex. 3-E) &amp; Avanzado Ex. 3-N (Purchase Agreement)</p>	Undisputed.
<p>23. Until his purchase of this existing restaurant, June's only connection with "Barrio Fiesta" was as a consumer.</p> <p>June Depo. at 10:15-21, 65:13-20, 70:9-13, 103:12-18 (Avanzado Ex. 3-E)</p>	Undisputed.
<p>24. June acknowledges that he was aware of BFMC's distribution of "Barrio Fiesta" products in the United States <i>before</i> he purchased the Milpitas BF Restaurant.</p> <p>June Depo. at 36:6-38:4 (Avanzado Ex. 3-E)</p>	<p>Disputed.</p> <p>June Rono was not aware that Barrio Fiesta Manufacturing Corporation was importing products in any sort of significant quantity at the time he purchased the Barrio Fiesta restaurant in Milpitas California. [Decl. of Cai. Ex. 2 (Decl. of Cai. Ex. 2 (June Depo at 157:4-9))]. It was not until late 2012 that June Rono became aware of Northridge Foods International, Inc.'s importation of products during the mart Barrio Fiesta. [Decl. of Cai. Ex. 1 (Decl. of Rono ¶ 14)]</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>25. June's specific testimony on this point was as follows:</p> <p>Q: Are you able to estimate a date that you purchased Barrio Fiesta food products of Barrio Fiesta Manufacturing Corporation in the United States?</p> <p>A: Again, I don't recall specifically. I do remember, perhaps, buying it mid- - mid-2000s, perhaps.</p> <p>Q: Okay. But certainly before you purchased the Barrio Fiesta Restaurant located in Milpitas?</p> <p>A: Yes.</p> <p>June Depo. at 37:17-24 (Avanzado Ex. 3-E)</p>	<p>Undisputed.</p>
<p>26. Registrants were also aware that Barrio Fiesta restaurants in the Philippines had been in existence for decades.</p> <p>June Depo. at 161:22-162:4 (Avanzado Ex. 3-F)</p>	<p>Undisputed.</p>
<p>27. June visited and ate at one of the Barrio Fiesta restaurants in the Philippines prior to his purchase of the Milpitas BF Restaurant.</p> <p>June Depo. at 27:18-28:8 (Avanzado Ex. 3-E) &amp; June Depo. at 161:22-162:16, 294:22-295:4 (Avanzado Ex. 3-F)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>28. On or about September 14, 2010, June incorporated a California corporation, Barrio Fiesta LLC (“BFLLC”). June is the sole officer and shareholder of BFLLC.</p> <p>RJN ¶ A &amp; RJN Ex. 1; June Depo. at 14:6-14:11 (Avanzado Ex. 3-E); June Depo. at 174:3-4 &amp; 222:20-22 (Avanzado Ex. 3-F); Justin Rono (“Justin”) Depo. at 11:5-7 (Avanzado Ex. 3-G)</p>	<p>Undisputed.</p>
<p>29. BFLLC owns and operates the Milpitas BF Restaurant, which is still called “The Original Barrio Fiesta of Manila” and uses its original signage.</p> <p>June Depo. at 94:19-22 (“Q: So the signage at Barrio Fiesta, the restaurant location in Milpitas, says “The Original Barrio Fiesta of Manila? A: Yes.”) (Avanzado Ex. 3-E); June Depo. at 139:23-140:7, 140:8-15 (“Q: After you acquired the Milpitas restaurant, did you change the signage? A: Well, no.”), 150:7-23) (Avanzado Ex. 3-F); Avanzado Ex. 3-LL (photo of Milpitas BF Restaurant exterior)</p>	<p>Undisputed.</p>
<p>30. On February 15, 2011, Registrants Justin Christian C. Rono (“Justin”) and Ashley Kirsten C. Rono (“Ashley”) filed application serial number 85/243,004 (the “‘004 Application”) with the USPTO to register the ‘365 Mark (BARRIO FIESTA EXPRESS) in the fast food restaurants classification.</p> <p>June Depo. at 176:23-193:21 (Avanzado Ex. 3-F) &amp; RJN ¶ C &amp; Avanzado Ex. 3-JJ (2011 trademark application)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>31. June completed the application himself and caused his children, Justin and Ashley, to file the application.</p> <p>June Depo. at 174:12-175:16, 177:2-180:22 (Avanzado Ex. 3-F); RJN ¶ C &amp; Avanzado Ex. 3-JJ (2011 trademark application)</p>	<p>Undisputed.</p>
<p>32. On November 24, 2014, Justin and Ashley filed an assignment of ownership of the BARRIO FIESTA EXPRESS mark to include June.</p> <p>June Depo. at 59:20-60:22 (Avanzado Ex. 3-E); Justin Depo. at 21:10-22:1 (Avanzado Ex. 3-G); Deposition of Ashley Rono (“Ashley”) at 35:4-36:17 (Avanzado Ex. 3-G); RJN ¶¶ E-F &amp; Avanzado Ex. 3-P (trademark assignment), Avanzado Ex. 3-O (updated registration certificate)</p>	<p>Undisputed.</p>
<p>33. On October 4, 2011, Justin and Ashley obtained the registration of the BARRIO FIESTA EXPRESS service mark for fast food restaurants.</p> <p>June Depo. at 192:4-7 (Avanzado Ex. 3-F) &amp; RJN ¶ D &amp; RJN Ex. 3 (2011 registration)</p>	<p>Undisputed.</p>
<p style="text-align: center;"><b>REGISTRANTS’ INTENTIONAL ASSOCIATION WITH THE EXISTING AND MORE FAMOUS “BARRIO FIESTA” MARKS</b></p>	
<p>34. In the ‘004 Application, Registrants used the Barrio Fiesta logo and design created in the Philippines by the Ongpaucos that were depicted in the Milpitas BF Restaurant’s menus.</p> <p>June Depo. at 178:5-182:18 (Avanzado Ex. 3-F) &amp; RJN ¶ C &amp; Avanzado Ex. 3-JJ (2011 application)</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>35. BFLLC's Milpitas BF Restaurant expressly associates itself with Barrio Fiesta restaurants in the Philippines by adopting a purported "history dating back to 1952" on its website.</p> <p>June Depo. at 33:20-34:11 (Avanzado Ex. 3-E); June Depo. at 159:24-161:24, 172:1-7 (Avanzado Ex. 3-F) &amp; Avanzado Ex. 3-L (Plaintiff's website)</p>	<p>Disputed.</p> <p>June Rono has never sought to intentionally or otherwise associate himself, his restaurants or products with the Ongpauco Family brand of the Philippines or any associated mark. [Decl. of Rono ¶ 7]. If customers ask if Barrio Fiesta Express (the Milpitas/San Jose Restaurants or its products) are an affiliate or otherwise associated with the Barrio Fiesta restaurants in the Philippines, June Rono has always been very clear that they are not. [Decl. of Rono ¶ 8]. To the extent that June Rono continued to use the signage and menus from the Milpitas Restaurant, it was not done to associate with the Ongpauco Family brand, but rather done for cost reasons because that is the way he purchased the restaurant and it was and is his understanding that all of the signage and logos were included with the purchase agreement. [Decl. of Rono ¶ 6]. Subsequently to purchasing the Milpitas Restaurant, June Rono had his own logo designed and created, which is displayed in the San Jose Restaurant and on the menus for both restaurants. [Decl. of Rono ¶ 6]. After purchasing the Milpitas restaurant, June Rono began expanding the restaurant into a chain, introduced a "take-out" option and began selling packaged foods bearing the mark Barrio Fiesta. [Decl. of Rono ¶¶ 9, 11]. June Rono undertook all of these expansion efforts of the name and mark Barrio Fiesta Express without regard to the Ongpaucos alleged brand. [Decl. of Rono ¶ 10].</p>
<p>36. Registrants admit that Barrio Fiesta is a famous restaurant created in the Philippines.</p> <p>June Depo. at 66:22-24 (Avanzado Ex. 3-E); June Depo. at 161:18-162:16, 163:4-15, 165:2-166:11 (Avanzado Ex. 3-F)</p>	<p>Disputed.</p> <p>The cited facts do not support the contention that Barrio Fiesta is an "famous restaurant" in the United States.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>37. Registrants admit that Filipinos in the United States associate Filipino restaurant brands in the United States with Filipino restaurant brands created in the Philippines. Plaintiff also admits that Filipinos in the United States eat in Filipino restaurants in the United States because they associate those brands with the brands at “home.”</p> <p>June Depo. at 165:2-167:1, 167:23-168:5 (Avanzado Ex. 3-F); <i>see also</i> Justin Depo. at 38:21-39:10, 40:9-40:15, 41:12-41:20 (customer association of Philippine “Barrio Fiesta” brand and Milpitas BF Restaurant) (Avanzado Ex. 3-G)</p>	<p>Undisputed.</p>
<p>38. Registrants admit that the Barrio Fiesta brand is more “powerful,” “widespread” and well-known in the Philippines because of its “established history there dating back to the ‘50s” and that the Barrio Fiesta brand is seen in the Philippines as “the place you want to eat at.”</p> <p>Justin Depo. at 38:21-39:21 (Avanzado Ex. 3-G)</p>	<p>Disputed.</p> <p>The cited facts do not support the contention that Barrio Fiesta is a “powerful,” and “widespread” mark in the United States.</p>
<p>39. BFLLC’s customers are familiar with the Barrio Fiesta restaurants in the Philippines and come to the Milpitas BF Restaurant expecting the same food and service.</p> <p>Justin Depo. at 40:9-40:15 (Avanzado Ex. 3-G)</p>	<p>Disputed.</p> <p>The cited facts do not support the contention that Barrio Fiesta LLC’s customers are familiar with Barrio Fiesta restaurants in the Philippines come to the Milpitas BF Restaurant expecting the same food and service.</p>
<p>40. “Barrio Fiesta” is recognized as one of the iconic brands of the Philippines.</p> <p>Alianan Decl. ¶ 6 &amp; Ex. B (“Philippines’ Greatest Brands”) (Avanzado Ex. 1 &amp; Ex. 1-B)</p>	<p>Disputed.</p> <p>The cited facts do not support the contention that Barrio Fiesta is an “iconic restaurant brand.”</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p style="text-align: center;"><b>RELATED "BARRIO FIESTA" TRADEMARK APPLICATIONS &amp; REGISTRATIONS</b></p>	
<p>41. While their priority of use of "Barrio Fiesta" marks cannot be disputed, efforts by BFMC and the Ongpauco family to obtain registrations for "Barrio Fiesta" marks in the past have had mixed results. Bonifacio filed documents with the State of California and the USPTO seeking trademark registrations relating to BFMC's exportation and distribution of Barrio Fiesta products in the United States. Bonifacio filed an application to register the "Barrio Fiesta" trademark in connection with BFMC's packaged food products on November 25, 1992 with the Secretary of State of the State of California.</p> <p>RJN ¶¶ H &amp; H-1, RJN Ex. 4</p>	<p>Disputed.</p> <p>On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application, Principal Register with the United States Patent and Trademark Office to register the mark "Barrio Fiesta" (serial number 85384724). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. The Filing Basis was notated as SECTION 1(b). [Plaintiff's RJN Ex. A &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 3)]. A section 1(b) designation is used when an applicant has yet to use the product in commerce. On October 9, 2012, Barrio Fiesta Manufacturing Corporation filed its first Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. B &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 4)]. On September 30, 2013, Barrio Fiesta Manufacturing Corporation filed its second Request for Extension of Time to File a Statement of Use regarding its "Barrio Fiesta" mark application (serial number 85384724). [Plaintiff's RJN Ex. C &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 5)]. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment of Barrio Fiesta Manufacturing Corporation's mark "Barrio Fiesta" (serial number 85384724) for failing to submit a statement of use. [Plaintiff's RJN Ex. D &amp; Decl. of Cai Ex. 2 (Decl. of Cai Ex. 6)]</p>
<p>42. Bonifacio's application was granted by the State of California on June 14, 1993, and Bonifacio thereby obtained a California trademark for "BARRIO FIESTA" registration number 097662.</p> <p>RJN ¶ H-2 &amp; Avanzado Ex. 3-BB</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>43. Bonifacio attempted to register the “Barrio Fiesta” mark and logo with the USPTO on May 18, 2006 in connection with packaged food products. Bonifacio filed trademark application serial number 78/886,373 with the USPTO on May 18, 2006 for the “Barrio Fiesta” mark and logo in connection with packaged food products (the “‘373 Application”). The ‘373 Application specifies the first use of the “Barrio Fiesta” mark in commerce as December 10, 1987.</p> <p>RJN ¶ H-3 &amp; Avanzado Ex. 3-CC</p>	<p>Undisputed.</p>
<p>44. BFMC attempted to register the “Barrio Fiesta” mark and logo with the USPTO on May 11, 2007 in connection with packaged food products. BFMC filed trademark application serial number 77/179,318 with the USPTO on May 11, 2007 for the “Barrio Fiesta” mark and logo in connection with packaged food products (the “‘318 Application”). The ‘318 Application specifies that the “Barrio Fiesta” mark was first used in commerce as early as December 10, 1987.</p> <p>RJN ¶ H-4 &amp; Avanzado Ex. 3-DD</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>45. Members of the Ongpauco family also filed for trademark registrations relating to the family's various restaurant operations. The Manila Restaurant, Inc. filed an application with the California Secretary of State to register the service mark and logo "Barrio Fiesta" in connection with restaurant services for the Los Angeles BF Restaurant on October 1, 1986. The application specifies the date of first use of the "Barrio Fiesta" mark anywhere in commerce was 1958 and first used in commerce in California was December 4, 1985.</p> <p>RJN ¶ I-1 &amp; Avanzado Ex. 3-FF</p>	<p>Undisputed.</p>
<p>46. That application was granted on October 29, 1986, registration number 28689.</p> <p>RJN ¶ I-2 &amp; Avanzado Ex. 3-EE</p>	<p>Undisputed.</p>
<p>47. The Manila Restaurant, Inc. filed with the California Secretary of State a written assignment of its registered service mark "Barrio Fiesta" (registration number 28689) to Manuel Tamayo, Corazon Ongpauco-Tamayo and Sixta Evangelista on April 23, 1990.</p> <p>RJN ¶ I-3 &amp; Avanzado Ex. 3-FF</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>48. Consuelo Ongpauco-Cauton (“Ongpauco-Cauton”) obtained a registration for the service mark “The Original Barrio Fiesta of Manila” – registration number 055400 – in connection with restaurant services with the State of California Secretary of State on October 3, 2001. Ongpauco-Cauton’s application specifies that the first use of “The Original Barrio Fiesta” mark in commerce in California was in 1987 and first used anywhere in commerce in 1959.</p> <p>RJN ¶ I-4 &amp; Avanzado Ex. 3-GG</p>	<p>Undisputed.</p>
<p>49. Ongpauco-Cauton renewed her registration for the service mark “The Original Barrio Fiesta of Manila” – registration number 055400 – on May 26, 2011 with the California Secretary of State.</p> <p>RJN ¶ I-5 &amp; Avanzado Ex. 3-HH</p>	<p>Undisputed.</p>
<p>50. Ongpauco-Cauton petitioned to cancel the federal registration of the mark “The Original Barrio Fiesta of Manila” held by Barrio Fiesta International, Inc. – registration number 1,712,454 – with the USPTO on July 9, 2013. Barrio Fiesta International, Inc. used “The Original Barrio Fiesta of Manila” mark in connection with restaurant services. Ongpauco-Cauton sought to cancel registration number 1,712,454 on abandonment grounds.</p> <p>RJN ¶ I-6 &amp; Avanzado Ex. 3-II</p>	<p>Undisputed.</p>

<p style="text-align: center;"><b>UNDISPUTED FACTS And SUPPORTING EVIDENCE</b></p>	<p style="text-align: center;"><b>RESPONSE</b></p>
<p>51. The USPTO granted Ongpauco-Cauton's petition and cancelled "The Original Barrio Fiesta of Manila" mark held by Barrio Fiesta International, Inc. on September 18, 2015.</p> <p>RJN ¶ I-7 &amp; RJN Ex. 4</p>	<p>Undisputed.</p>
<p>52. The USPTO examining attorney has suspended BPMC's pending application to re-register a "Barrio Fiesta" mark, Application No. 86528183, because of potential confusion under Section 2(d) with Registrants' '365 Mark.</p> <p>RJN ¶ J &amp; RJN Exs. 5 &amp; 6</p>	<p>Undisputed.</p>

Date: April 6, 2017

SAC Attorneys, LLP

/S/JAMES CAI

James Cai, Esq.  
Attorney for Registrants

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANTS' RESPONSE TO PETITIONER'S SEPARATE STATEMENT OF UNDISPUTED FACTS was served on counsel for Petitioner on April 7, 2017, by sending the same via FEDEX overnight delivery, to:

Melvin N.A. Avanzado  
THE AVANZADO LAW FIRM  
1880 Century Park East, Suite 1100  
Los Angeles, CA 90067

/S/ JAMES CAI  
James Cai, Esq.  
Attorney for Registrants

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

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KRISTEN  
C. RONO, AND JUSTIN CHRISTIAN C.  
RONO,

Registrants.

Cancellation No. 92063674

In the Matter of Registration No. 4,034,365  
Mark: BARRIO FIESTA EXPRESS  
Date Issued: October 4, 2011

*[Opposition to Motion for Summary  
Judgment; Response to Separate  
Statement of Undisputed Facts;  
Declaration of June Rono; Exhibits to Cai  
Declaration filed concurrently herewith]*

**REGISTRANTS' REQUEST FOR JUDICIAL NOTICE IN SUPPORT OF ITS  
OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE THAT Registrants JUNE RONO, ASHLEY RONO and JUSTIN RONO, in support of their opposition to Petitioner's Motion for Summary Judgment, will and hereby do request that this Board take judicial notice of the following matters and documents pursuant to Rule 201 of the Federal Rules of Evidence. To the extent that the documents were authenticated in depositions, those documents are attached as exhibits to the Declaration of James Cai. To the extent that the documents are public records, those documents are attached as exhibits to this request for judicial notice.

A. On July 29, 2011, Barrio Fiesta Manufacturing Corporation submitted a Trademark/Service Mark Application with the Principal Register of the United States Patent and Trademark Office with serial number 85384724. A true and correct copy of the application from the United States Patent and Trademark Office website is attached as Exhibit A.

B. On October 9, 2012, Barrio Fiesta Manufacturing Corporation submitted a Request for Extension of Time to File a Statement of Use in connection with Barrio Fiesta Manufacturing Corporation's serial number 85384724 application. A true and correct copy of the request from the United States Patent and Trademark Office website is attached as Exhibit B.

C. On September 30, 2013, Barrio Fiesta Manufacturing Corporation submitted a second Request for Extension of Time to File a Statement of Use in connection with Barrio Fiesta Manufacturing Corporation's serial number 85384724 application. A true and correct copy of the request from the United States Patent and Trademark Office website is attached as Exhibit C.

D. On June 24, 2014, the United States Patent and Trademark Office mailed a Notice of Abandonment in connection to Barrio Fiesta Manufacturing Corporation's serial number

85384724 application. A true and correct copy of the notice from the United States Patent and Trademark Office website is attached as Exhibit D.

E. On February 9, 2015, Barrio Fiesta Manufacturing Corporation submitted another Trademark/Service Mark Application with the Principal Register of the United States Patent and Trademark Office with serial number 86528183. A true and correct copy of the application from the United States Patent and Trademark Office website is attached as Exhibit E.

F. On May 14, 2015, the United States Patent and Trademark Office mailed an Important Notice Regarding Your U.S. Trademark Application to Barrio Fiesta Manufacturing Corporation in connection with its trademark application with serial number 86528183. A true and correct copy of that notice from the United States Patent and Trademark Office website is attached as Exhibit F.

Date: April 6, 2017

SAC Attorneys, LLP

/S/JAMES CAI

James Cai, Esq.  
Attorney for Registrants

# **EXHIBIT A**

# Trademark/Service Mark Application, Principal Register

Serial Number: 85384724

Filing Date: 07/29/2011

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85384724
MARK INFORMATION	
*MARK	BARRIO FIESTA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Barrio Fiesta Manufacturing Corporation
INTERNAL ADDRESS	Barrio Fiesta Compound
*STREET	Restaurant Ave., Marcos Hi-way
*CITY	Dela Paz, Pasig City
*COUNTRY	Philippines
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Philippines
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	029
*IDENTIFICATION	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats
FILING BASIS	SECTION 1(b)
INTERNATIONAL CLASS	030
*IDENTIFICATION	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Michael J. Leonard

ATTORNEY DOCKET NUMBER	688303.0001
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Laura A. Genovese, Maureen C. Kassner and John P. Sullivan
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
NAME	Michael J. Leonard
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>CORRESPONDENCE INFORMATION</b>	
NAME	Michael J. Leonard
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1390
FAX	215-525-5311
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	2

FEE PER CLASS	325
*TOTAL FEE DUE	650
*TOTAL FEE PAID	650
<b>SIGNATURE INFORMATION</b>	
ORIGINAL PDF FILE	hw 6320917811-150710462 . 00331707.PDF
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\853\847\85384724\xml1\APP0003.JPG
SIGNATORY'S NAME	Felino L. Padlan
SIGNATORY'S POSITION	Authorized Representative/Attorney-In-Fact

## Trademark/Service Mark Application, Principal Register

Serial Number: 85384724

Filing Date: 07/29/2011

### To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of  
Barrio Fiesta Compound,  
Restaurant Ave., Marcos Hi-way  
Dela Paz, Pasig City  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 030: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

### The applicant's current Attorney Information:

Michael J. Leonard and Laura A. Genovese, Maureen C. Kassner and John P. Sullivan of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0001.

The applicant hereby appoints Michael J. Leonard of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103  
United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.

### The applicant's current Correspondence Information:

Michael J. Leonard  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1390(phone)  
215-525-5311(fax)  
usptotm@panitchlaw.com (authorized)

A fee payment in the amount of \$650 has been submitted with the application, representing payment for 2 class(es).

**Declaration**

**Original PDF file:**

hw\_6320917811-150710462 . 00331707.PDF

**Converted PDF file(s) (1 page)**

Signature File1

Signatory's Name: Felino L. Padlan

Signatory's Position: Authorized Representative/Attorney-In-Fact

RAM Sale Number: 1643

RAM Accounting Date: 08/01/2011

Serial Number: 85384724

Internet Transmission Date: Fri Jul 29 15:11:44 EDT 2011

TEAS Stamp: USPTO/BAS-XX.XXX.XXX.XX-2011072915114465

9388-85384724-480118d3a13c8claa88f011dbe

273a0c2-DA-1643-20110729150710462830

# BARRIO FIESTA

**Declaration**

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, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. Section 1051(b), 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.

**Signature Section:**

Signature: 

Signatory's Name: FELINO L. PADLAN

Signatory's Position: Authorized Representative/Attorney-In-Fact

Date Signed: July 28, 2011

**NOTE TO APPLICANT:** When filed as part of the electronic form (i.e., scanned and attached as an image file), the signature page must include both the signature information and the boilerplate declaration language. Do not include the entire application, but do ensure that the boilerplate declaration language actually appears; *a signature by itself will not be acceptable*. If, due to browser limitations, the boilerplate declaration language appears on a previous page when printed, you must "merge" the declaration and signature block onto a single page prior to signing, so that the *entire complete page* can be scanned to create an acceptable image file. It is recommended that you copy-and-paste the entire text form into another document, manipulate the spacing there to move the declaration and signature section to a separate page, and then print this new version of the text form to send to the signatory.

**To:** Barrio Fiesta Manufacturing Corporation ([usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85384724 - BARRIO FIESTA - 688303.0001  
**Sent:** 11/22/2011 6:28:09 PM  
**Sent As:** ECOM102@USPTO.GOV

**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)  
[Attachment - 9](#)  
[Attachment - 10](#)  
[Attachment - 11](#)  
[Attachment - 12](#)  
[Attachment - 13](#)  
[Attachment - 14](#)  
[Attachment - 15](#)  
[Attachment - 16](#)  
[Attachment - 17](#)  
[Attachment - 18](#)  
[Attachment - 19](#)  
[Attachment - 20](#)  
[Attachment - 21](#)  
[Attachment - 22](#)  
[Attachment - 23](#)  
[Attachment - 24](#)  
[Attachment - 25](#)  
[Attachment - 26](#)  
[Attachment - 27](#)  
[Attachment - 28](#)  
[Attachment - 29](#)  
[Attachment - 30](#)  
[Attachment - 31](#)  
[Attachment - 32](#)  
[Attachment - 33](#)  
[Attachment - 34](#)  
[Attachment - 35](#)  
[Attachment - 36](#)  
[Attachment - 37](#)  
[Attachment - 38](#)  
[Attachment - 39](#)  
[Attachment - 40](#)  
[Attachment - 41](#)  
[Attachment - 42](#)  
[Attachment - 43](#)  
[Attachment - 44](#)

# EXHIBIT B

## Request for Extension of Time to File a Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85384724
LAW OFFICE ASSIGNED	LAW OFFICE 102
<b>MARK SECTION</b>	
MARK	BARRIO FIESTA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIESTA
<b>OWNER SECTION</b>	
NAME	Barrio Fiesta Manufacturing Corporation
STREET	T. Santiago St. corner R. Jacinto St.
CITY	Metro Manila
COUNTRY	Philippines
EMAIL	usptotm@panitchlaw.com
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	029
CURRENT IDENTIFICATION	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
GOODS OR SERVICES	KEEP ALL LISTED
INTERNATIONAL CLASS	030
CURRENT IDENTIFICATION	coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice
GOODS OR SERVICES	KEEP ALL LISTED
<b>EXTENSION SECTION</b>	
EXTENSION NUMBER	1
ALLOWANCE MAIL DATE	10/09/2012
STATEMENT OF USE	NO

<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	2
SUBTOTAL AMOUNT	300
TOTAL AMOUNT	300
<b>SIGNATURE SECTION</b>	
SIGNATURE	/michael leonard/
SIGNATORY'S NAME	Michael J. Leonard
SIGNATORY'S POSITION	Attorney of Record, PA Bar Member
DATE SIGNED	04/09/2013
<b>FILING INFORMATION</b>	
SUBMIT DATE	Tue Apr 09 15:35:43 EDT 2013
TEAS STAMP	USPTO/ESU-XX.XXX.XXX.XXX- 20130409153543159180-8538 4724-50037394aa9a2c68a7b1 1721e91bb192e382725edabca deebac1325983bd317-DA-199 3-20130409153020196933

**SOU Extension Request  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA  
**SERIAL NUMBER:** 85384724

The applicant, Barrio Fiesta Manufacturing Corporation, having an address of  
T. Santiago St. corner R. Jacinto St.  
Metro Manila,  
Philippines

requests a six-month extension of time to file the Statement of Use under 37 C.F.R. Section 2.89 in this application. The Notice of Allowance mailing date was 10/09/2012.

For International Class 029:

Current identification: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

For International Class 030:

Current identification: coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

This is the first extension request.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 2 classes.

**Declaration**

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; 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.

Signature: /michael leonard/ Date Signed: 04/09/2013  
Signatory's Name: Michael J. Leonard  
Signatory's Position: Attorney of Record, PA Bar Member

RAM Sale Number: 85384724  
RAM Accounting Date: 04/10/2013

Serial Number: 85384724  
Internet Transmission Date: Tue Apr 09 15:35:43 EDT 2013  
TEAS Stamp: USPTO/ESU-XX.XXX.XXX.XXX-201304091535431  
59180-85384724-50037394aa9a2c68a7b11721e  
91bb192e382725edabcadeebac1325983bd317-D  
A-1993-20130409153020196933

# **EXHIBIT C**

## Request for Extension of Time to File a Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85384724
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 102
<b>MARK SECTION</b>	
<b>MARK</b>	BARRIO FIESTA
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>LITERAL ELEMENT</b>	BARRIO FIESTA
<b>OWNER SECTION</b>	
<b>NAME</b>	Barrio Fiesta Manufacturing Corporation
<b>STREET</b>	T. Santiago St. corner R. Jacinto St.
<b>CITY</b>	Metro Manila
<b>COUNTRY</b>	Philippines
<b>EMAIL</b>	usptotm@panitchlaw.com
<b>GOODS AND/OR SERVICES SECTION</b>	
<b>INTERNATIONAL CLASS</b>	029
<b>CURRENT IDENTIFICATION</b>	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>INTERNATIONAL CLASS</b>	030
<b>CURRENT IDENTIFICATION</b>	coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour, preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice
<b>GOODS OR SERVICES</b>	KEEP ALL LISTED
<b>EXTENSION SECTION</b>	
<b>EXTENSION NUMBER</b>	2
<b>ONGOING EFFORT</b>	product or service research or development; market research; promotional activities
<b>ALLOWANCE MAIL DATE</b>	10/09/2012

STATEMENT OF USE	NO
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	2
SUBTOTAL AMOUNT	300
TOTAL AMOUNT	300
<b>SIGNATURE SECTION</b>	
ORIGINAL PDF FILE	hw_6320917811-112729170 . 00553546.PDF
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\853\847\85384724\xml12\ESU0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\853\847\85384724\xml12\ESU0003.JPG
SIGNATORY'S NAME	Veneranda M. Tomas
SIGNATORY'S POSITION	Chief Financial Officer
<b>FILING INFORMATION</b>	
SUBMIT DATE	Mon Sep 30 11:31:09 EDT 2013
TEAS STAMP	USPTO/ESU-XX.XXX.XXX.XX-2 0130930113109062966-85384 724-500be2ee76f3da5c9e66c fd6dd68f63189c3015c7318bc e1a32971f43784d69-CC-1009 -20130930112729170401

**SOU Extension Request  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

**MARK: BARRIO FIESTA**  
**SERIAL NUMBER: 85384724**

The applicant, Barrio Fiesta Manufacturing Corporation, having an address of  
T. Santiago St. corner R. Jacinto St.  
Metro Manila,  
Philippines

requests a six-month extension of time to file the Statement of Use under 37 C.F.R. Section 2.89 in this application. The Notice of Allowance mailing date was 10/09/2012.

For International Class 029:

Current identification: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

For International Class 030:

Current identification: coffee and artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour; preparations made from cereals, namely, cereal-derived food bars; bread, pastry and confectionery, namely, bases for bakery goods, brownie mixes, cake mixes, cookie mixes, frosting and icing mixes, mixes for baking batters, muffin mixes, pudding mixes, pastry mixes, mixes for candy making; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, condiments, namely, sauces; spices; ice

For a trademark/service mark: The applicant has a continued bona fide intention, and is entitled, to use the mark in commerce on or in connection with all of the goods/services listed in the Notice of Allowance or as subsequently modified for this specific class; for a collective/certification mark: the applicant has a continued bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce on or in connection with the goods/services/collective membership organization listed in the Notice of Allowance, or as subsequently modified for this specific class.

This is the second extension request. The applicant has made the following ongoing efforts to use the mark in commerce on or in connection with each of those goods/services covered by the extension request: product or service research or development; market research; promotional activities

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 2 classes.

**Declaration**

**Original PDF file:**

hw\_6320917811-112729170 . 00553546.PDF

**Converted PDF file(s) (2 pages)**

Signature File1

Signature File2

Signatory's Name: Veneranda M. Tomas  
Signatory's Position: Chief Financial Officer

RAM Sale Number: 85384724  
RAM Accounting Date: 10/01/2013

Serial Number: 85384724  
Internet Transmission Date: Mon Sep 30 11:31:09 EDT 2013  
TEAS Stamp: USPTO/ESU-XX.XXX.XXX.XX-2013093011310906  
2966-85384724-500be2ee76f3da5c9e66cfd6dd  
68f63189c3015c7318bce1a32971f43784d69-CC  
-1009-20130930112729170401

# **EXHIBIT D**

Side - 1



**NOTICE OF ABANDONMENT**  
**MAILING DATE: Jun 24, 2014**

The trademark application identified below was abandoned because the applicant failed to file for a statement of use or an extension of time.

If the delay in filing a response was unintentional, you may file a petition to revive the application with a fee. If the abandonment of this application was due to USPTO error, you may file a request for reinstatement. Please note that a petition to revive or request for reinstatement **must be received within two months from the mailing date of this notice.**

For additional information, go to <http://www.uspto.gov/teas/petinfo.htm>. If you are unable to get the information you need from the website, call the Trademark Assistance Center at 1-800-786-9199.

**SERIAL NUMBER:** 85384724  
**MARK:** BARRIO FIESTA  
**OWNER:** Barrio Fiesta Manufacturing Corporation

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE  
COMMISSIONER FOR TRADEMARKS  
P.O. BOX 1451  
ALEXANDRIA, VA 22313-1451

FIRST-CLASS MAIL  
U.S POSTAGE  
PAID

MICHAEL J. LEONARD  
PANITCH SCHWARZE BELISARIO & NADEL LLP  
2005 MARKET ST STE 2200  
PHILADELPHIA, PA 19103-7086

# **EXHIBIT E**

## Trademark/Service Mark Application, Principal Register

Serial Number: 86528183

Filing Date: 02/09/2015

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86528183
<b>MARK INFORMATION</b>	
*MARK	<u>BARRIO FIESTA</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BARRIO FIBSTA
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	Barrio Fiesta Manufacturing Corporation
*STREET	Re30 T. Santiago Street, Canumay West
*CITY	Valenzuela City, MMLa
*COUNTRY	Philippines
<b>LEGAL ENTITY INFORMATION</b>	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Philippines
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
INTERNATIONAL CLASS	029
*IDENTIFICATION	meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 10/00/1999
FIRST USE IN COMMERCE DATE	At least as early as 10/00/1999
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\865281\86528183\xml1\ RFA0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\865281\86528183\xml1\ RFA0004.JPG
SPECIMEN DESCRIPTION	product label
INTERNATIONAL CLASS	030

*IDENTIFICATION	meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 04/00/2013
FIRST USE IN COMMERCE DATE	At least as early as 04/00/2013
SPECIMEN FILE NAME(S)	
JPG FILE(S)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0006.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0007.JPG
ORIGINAL PDF FILE	SPE010-6320917811-20150123080740123602 . USA-BF New Logo-DAU for Class 30.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0005.JPG
SPECIMEN DESCRIPTION	product packaging
<b>ATTORNEY INFORMATION</b>	
NAME	Patricia Smink Rogowski
ATTORNEY DOCKET NUMBER	688303.0002
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
EMAIL ADDRESS	usptotm@panitchlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Tamika Crawl-Bey and Jefferson Cheatham
<b>DOMESTIC REPRESENTATIVE INFORMATION</b>	
NAME	Patricia Smink Rogowski
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
EMAIL ADDRESS	usptotm@panitchlaw.com

AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>CORRESPONDENCE INFORMATION</b>	
NAME	Patricia Smink Rogowski
FIRM NAME	Panitch Schwarze Belisario & Nadel LLP
STREET	2005 Market Street, Suite 2200
CITY	Philadelphia
STATE	Pennsylvania
COUNTRY	United States
ZIP/POSTAL CODE	19103
PHONE	215-965-1330
FAX	215-965-1331
*EMAIL ADDRESS	usptotm@panitchlaw.com;progowski@panitchlaw.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
APPLICATION FILING OPTION	TEAS RF
NUMBER OF CLASSES	2
FEE PER CLASS	275
*TOTAL FEE DUE	550
*TOTAL FEE PAID	550
<b>SIGNATURE INFORMATION</b>	
ORIGINAL PDF FILE	hw 6320917811-080204717 . 00703928.PDF
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0008.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0009.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\865\281\86528183\xml1\RFA0010.JPG
SIGNATORY'S NAME	/Rolando B. Hortaleza, M.D.
SIGNATORY'S POSITION	Authorized Signatory for Barrio Fiesta Manufacturing Corporation
SIGNATORY'S PHONE NUMBER	215-965-1330

## Trademark/Service Mark Application, Principal Register

Serial Number: 86528183

Filing Date: 02/09/2015

### To the Commissioner for Trademarks:

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of  
Re30 T. Santiago Street, Canumay West  
Valenzuela City, MM1a  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

In International Class 029, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 10/00/1999, and first used in commerce at least as early as 10/00/1999, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, consisting of a(n) product label.

Specimen File1

Specimen File2

International Class 030: meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;

In International Class 030, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 04/00/2013, and first used in commerce at least as early as 04/00/2013, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, consisting of a(n) product packaging.

**JPG file(s):**

Specimen File1

Specimen File2

**Original PDF file:**

SPE010-6320917811-20150123080740123602 . USA-BF New Logo- DAU for Class 30.pdf

**Converted PDF file(s) (1 page)**

Specimen File1

The applicant's current Attorney Information:

Patricia Smink Rogowski and Tamika Crawl-Bey and Jefferson Cheatham of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0002.

The applicant hereby appoints Patricia Smink Rogowski of Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103

United States  
as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.  
The applicant's current Correspondence Information:

Patricia Smink Rogowski  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1330(phone)  
215-965-1331(fax)

usptotm@panitchlaw.com;progowski@panitchlaw.com (authorized)

**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or applicant's attorney at the e-mail address provided above. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in an additional processing fee of \$50 per international class of goods/services.

A fee payment in the amount of \$550 has been submitted with the application, representing payment for 2 class(es).

#### **Declaration**

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

#### **Declaration Signature**

Signature: Not Provided Date: Not Provided  
Signatory's Name: /Rolando B. Hortaleza, M.D.  
Signatory's Position: Authorized Signatory for Barrio Fiesta Manufacturing Corporation  
RAM Sale Number: 86528183  
RAM Accounting Date: 02/09/2015

Serial Number: 86528183  
Internet Transmission Date: Mon Feb 09 08:08:26 EST 2015  
TEAS Stamp: USPTO/BAS-XX.XXX.XXX.XX-2015020908082673  
3301-86528183-530b442ade12c4ffa78b7d9b9d  
a87d53119cc5aace4b39b6f696c726430a441a-C  
C-8492-20150209080204717546

# BARRIO FIESTA

A quality product of  
Product of quality fish

**splash**  
Hawaii's favorite brand

25.34 Net Wt (560g) 1.13  
Net Wt (560g) 1.13  
Gross Wt (1.13kg) 2.53

**SPLASH FOODS HOTLINE**  
FOR MORE INFORMATION  
CALL 1-800-841-1133  
OR VISIT US AT [www.splashfoods.com](http://www.splashfoods.com)

FOR EXPORT MARKET ONLY

LOT CODE/NUMERO DU LOT  
BEST BEFORE/CONSUMER AVANT

NOTE: When you see the splash logo of the  
product, please check the date of expiration  
because the date may change the quality of the  
product.

NOTE: The product is sealed in airtight  
containers for freshness. It is not  
recommended to eat it after the date of  
expiration as it may affect the quality of the product.

**HACCP**  
CERTIFIED

Refrigerate after opening.  
Use within 3 days of opening.



**Sautéed Shrimp Paste**  
Pâte de Crevettes Rissolée  
Sweet/Douce



Net Wt (560g) (1.13kg)

**Nutrition Facts**

Serving Size: 100g (3.5oz)  
Amount Per Serving: 100g (3.5oz)

	Amount Per Serving	% Daily Value
Total Fat	100g	20%
Sodium	100g	10%
Total Protein	100g	10%
Total Sugar	100g	10%
Total Fat	100g	20%
Sodium	100g	10%
Total Protein	100g	10%
Total Sugar	100g	10%
Total Fat	100g	20%
Sodium	100g	10%
Total Protein	100g	10%
Total Sugar	100g	10%

**INGREDIENTS:** Shrimp, shrimp oil,  
cornstarch, sugar, onion, garlic,  
and Monosodium Glutamate

**Contains Shrimp**

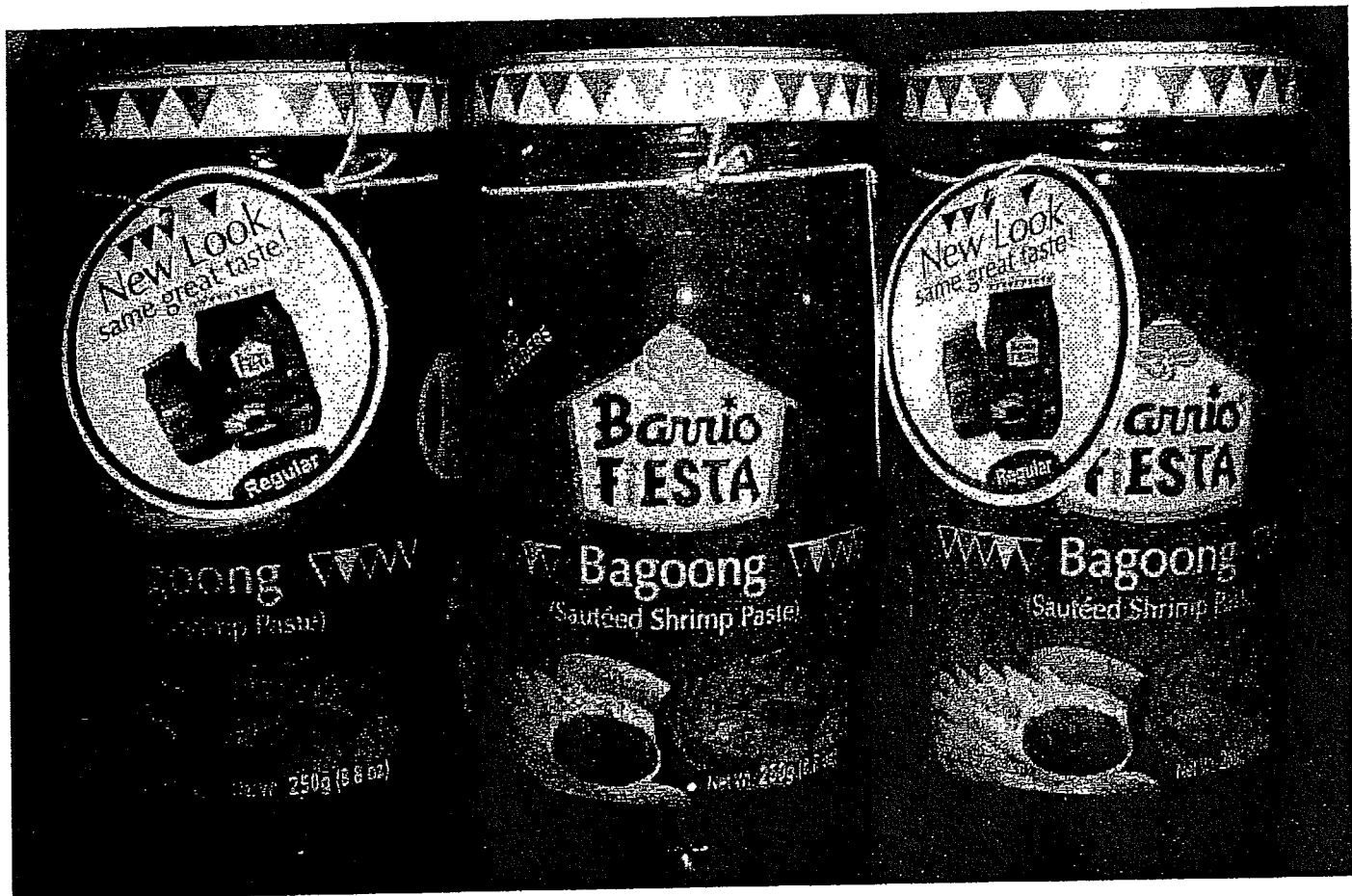
**ALLERGENIC:** Contains Shrimp  
Based on the label, shrimp, fish,  
eggs, and Monosodium Glutamate

**PRODUCT OF THE PHILIPPINES**

**Manufactured by**  
Bento Foods

**Bento Foods**  
Manufacturing Corporation  
11th Floor, Bldg. 11, EDSA  
Buenavista, Marikina City  
Metro Manila, Philippines











**Trademark/Service Mark Application, Principal Register**  
**Handwritten Signature:**

**To the Commissioner for Trademarks:**

**MARK:** BARRIO FIESTA (Standard Characters, see mark)

The literal element of the mark consists of BARRIO FIESTA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barrio Fiesta Manufacturing Corporation, a corporation of Philippines, having an address of

Re30 T. Santiago Street, Canumay West  
Valenzuela City, MM1a  
Philippines

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 029: meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping

In International Class 029, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 10/00/1999, and first used in commerce at least as early as 10/00/1999, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) product label.  
Specimen-1 [SPE010-6320917811-20150123080740123602\_BF-SSP-Sweet\_CO\_500g-DAU6-Class\_29.jpg]

International Class 030: meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices;

In International Class 030, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 04/00/2013, and first used in commerce at least as early as 04/00/2013, and is now in use in such commerce. The applicant is

submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) product packaging.  
Specimen-1 [SPE010-6320917811-20150123080740123602 \_USA-BF\_New\_Logo-  
\_DAU\_for\_Class\_30.pdf]

**The applicant's current Attorney Information:**

Patricia Smink Rogowski and Tamika Crawl-Bey and Jefferson Cheatham of Panitch  
Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
United States

The attorney docket/reference number is 688303.0002.

The applicant hereby appoints Patricia Smink Rogowski of Panitch Schwarze Belisario & Nadel  
LLP

2005 Market Street, Suite 2200  
Philadelphia Pennsylvania 19103  
United States

as applicant's representative upon whom notice or process in the proceedings affecting the mark  
may be served.

**The applicant's current Correspondence Information:**

Patricia Smink Rogowski  
Panitch Schwarze Belisario & Nadel LLP  
2005 Market Street, Suite 2200  
Philadelphia, Pennsylvania 19103  
215-965-1330(phone)  
215-965-1331(fax)

usptotm@panitchlaw.com;progowski@panitchlaw.com (authorized)

**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the  
application to the applicant or applicant's attorney at the e-mail address provided below. I  
understand that a valid e-mail address must be maintained and that the applicant or the  
applicant's attorney must file the relevant subsequent application-related submissions via the  
Trademark Electronic Application System (TEAS). Failure to do so will result in an additional  
processing fee of \$50 per international class of goods and/or services.

A fee payment in the amount of \$550 will be submitted with the application, representing  
payment for 2 class(es).

### Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

### Signature Section:

Signature: \_\_\_\_\_

Signatory's Name: / ROLANDO B. HORTALEZA, M.D.

Signatory's Position: Authorized Signatory for Barrio Fiesta Manufacturing Corporation

Signatory's Phone Number: 215-965-1330

Date Signed: \_\_\_\_\_

# **EXHIBIT F**

---

**To:** Barrio Fiesta Manufacturing Corporation ([usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86528183 - BARRIO FIESTA - 688303.0002  
**Sent:** 5/14/2015 1:01:55 PM  
**Sent As:** ECOM112@USPTO.GOV  
**Attachments:**

---

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON 5/14/2015 FOR U.S. APPLICATION SERIAL NO. 86528183**

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this link or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from 5/14/2015 *(or sooner if specified in the Office action)*. For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

**Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**(3) QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**WARNING**

**Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application.** For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).

---

**To:** Barrio Fiesta Manufacturing Corporation ([usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 86528183 - BARRIO FIESTA - 688303.0002  
**Sent:** 5/14/2015 1:01:54 PM  
**Sent As:** ECOM112@USPTO.GOV

**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)  
[Attachment - 9](#)  
[Attachment - 10](#)  
[Attachment - 11](#)  
[Attachment - 12](#)  
[Attachment - 13](#)  
[Attachment - 14](#)  
[Attachment - 15](#)  
[Attachment - 16](#)  
[Attachment - 17](#)  
[Attachment - 18](#)  
[Attachment - 19](#)  
[Attachment - 20](#)  
[Attachment - 21](#)  
[Attachment - 22](#)  
[Attachment - 23](#)  
[Attachment - 24](#)  
[Attachment - 25](#)  
[Attachment - 26](#)  
[Attachment - 27](#)  
[Attachment - 28](#)  
[Attachment - 29](#)  
[Attachment - 30](#)  
[Attachment - 31](#)  
[Attachment - 32](#)  
[Attachment - 33](#)  
[Attachment - 34](#)  
[Attachment - 35](#)  
[Attachment - 36](#)  
[Attachment - 37](#)  
[Attachment - 38](#)  
[Attachment - 39](#)  
[Attachment - 40](#)  
[Attachment - 41](#)

U.S. APPLICATION SERIAL NO. 86528183

MARK: BARRIO FIESTA

**\*86528183\***

**CORRESPONDENT ADDRESS:**

PATRICIA SMINK ROGOWSKI  
PANITCH SCHWARZE BELISARIO & NADEL LLP  
2005 MARKET ST STE 2200  
PHILADELPHIA, PA 19103-7086

**CLICK HERE TO RESPOND TO THIS  
LETTER:**

[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

[VIEW YOUR APPLICATION FILE](#)

**APPLICANT:** Barrio Fiesta Manufacturing Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO. :**

688303.0002

**CORRESPONDENT E-MAIL ADDRESS:**

[usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 5/14/2015

**TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE:** Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**Summary of Issues That Applicant Must Address**

- Section 2(d) Refusal—Likelihood of Confusion
- Prior-filed Pending Applications
- Identification of Goods

**Section 2(d) Refusal—Likelihood of Confusion**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4034365. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration as EXHIBIT A.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. See *In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant applied to register BARRIO FIESTA for "meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, ice cream, ice milk and frozen yogurt; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping" in class 29 and "meal flavorings and powdered meal mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces and dips; spices" in class 30.

The registered mark is BARRIO FIESTS EXPRESS, Reg. No. 4034365, for "fast-food restaurants."

#### Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

Applicant's mark is similar to the registered mark because they both include the dominant portion BARRIO FIESTA. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

Applicant's deletion of the word EXPRESS does not obviate this refusal. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark.

Therefore, applicant's mark is very similar to the registered mark.

#### Comparison of the Goods and Services

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant's goods are related to the registered services because restaurants often provide prepared foods, sauces, and condiments. See attached EXHIBIT C from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. This evidence shows that the goods and services listed therein, namely, restaurant services and food products in classes 29 and 30, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). In fact, the registrant has a prior-filed pending application that includes many of the goods listed in the application. See below.

Therefore, applicant's goods are highly related to the registered services.

#### Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Since the marks are similar and the goods and services are related, there is a likelihood of confusion as to the source of applicant's goods and

services. Therefore, applicant's mark is not entitled to registration.

#### **Prior-filed Pending Applications**

The filing dates of pending U.S. Application Serial Nos. 85951658 and 86490510 precede applicant's filing date. See attached EXHIBIT B. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

#### **Identification of Goods**

The identification of goods is indefinite and must be clarified as indicated below. See TMEP §1402.01. Applicant may adopt the following identification, if accurate:

Class 29: meat, *not live* fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; edible oils and fats; confectionery, namely, non-dairy based mix for making whipped topping; *dips*.

Class 30: *Food* flavorings and powdered *food* mixes; salt; mustards; vinegars; condiments, namely, vinegars, sauces; spices; *milk products, namely, ice cream, ice milk and frozen yogurt*.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netathtml/tidm.html>. See TMEP §1402.04.

#### **Contacting the Examining Attorney**

If applicant has any questions concerning the above action, it is encouraged to contact the examining attorney at the number listed below.

/DETjr/  
David E. Tooley, Jr.  
Trademark Examining Attorney  
Law Office 112  
571-272-8206  
[david.tooley@uspto.gov](mailto:david.tooley@uspto.gov)

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

## EXHIBIT A

Print: May 14, 2015

85243004

**DESIGN MARK**

**Serial Number**

85243004

**Status**

REGISTERED

**Word Mark**

BARRIO FIESTA EXPRESS

**Standard Character Mark**

Yes

**Registration Number**

4034365

**Date Registered**

2011/10/04

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

RONO, JUSTIN CHRISTIAN C. INDIVIDUAL UNITED STATES 4034365 SAN JOSE CALIFORNIA 95132

**Owner**

RONO, ASHLEY KIRSTEN C. INDIVIDUAL UNITED STATES 1629 WHARTON ROAD SAN JOSE CALIFORNIA 95132

**Owner**

RONO, JUNE FRANCIS INDIVIDUAL UNITED STATES 1629 WHARTON ROAD SAN JOSE CALIFORNIA 95132

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Fast-food restaurants. First Use: 2011/01/03. First Use In Commerce: 2011/01/03.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "EXPRESS" APART FROM THE MARK AS SHOWN.

**Translation Statement**

**Print: May 14, 2015**

**85243004**

The English translation of "Barrio Fiesta" in the mark is  
"Neighborhood Party".

**Filing Date:**  
2011/02/15

**Examining Attorney**  
FELDMAN, DAWN

**Attorney of Record**  
James Cai

# Barrio Fiesta Express

## EXHIBIT B

Print: May 14, 2015

85951658

**DESIGN MARK**

**Serial Number**

85951658

**Status**

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

**Word Mark**

THE ORIGINAL BARRIO FIESTA OF MANILA

**Standard Character Mark**

No

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

CONSUELO ONGPAUCO CAUTON INDIVIDUAL PHILIPPINES 10252 HADLEY AVENUE  
NORTHRIDGE CALIFORNIA 91324

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services. First Use: 1987/08/15. First Use In Commerce: 1987/08/15.

**Description of Mark**

The mark consists of a design of a pot, with a lid, over flames and  
the stylized words The Original Barrio Fiesta of Manila.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Translation Statement**

The English translation of Barrio Fiesta in the mark is Village Feast..

**Filing Date**

2013/06/05

**Examining Attorney**

LEWIS, SHAILA

**Attorney of Record**

David L. Hoffman



*The Original*

**Bonito FIESTA**

*of Florida*

Print: May 14, 2015

86490510

**DESIGN MARK**

**Serial Number**

86490510

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

BARRIO FIESTA EXPRESS

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Justin C. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Owner**

Ashley K. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Owner**

June F. Rono INDIVIDUAL UNITED STATES 1629 Wharton Road San Jose  
CALIFORNIA 95132

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Frozen meat,  
deserts, cooked packaged food, mixes for marinades, candies, frozen  
vegetables, frozen cooked vegetables, preserved and dried fruits.  
First Use: 2014/12/06. First Use In Commerce: 2014/12/06.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: beverage, bread,  
pastry, sauces, spices.

**Filing Date**

2014/12/24

**Examining Attorney**

GOLDEN, LAURA

**Print: May 14, 2015**

**86490510**

**Attorney of Record**  
James Cai

# Barrio Fiesta Express

## EXHIBIT C

Print: May 14, 2015

86156164

**DESIGN MARK**

**Serial Number**

86156164

**Status**

REGISTERED

**Word Mark**

ADEGA MODERN MEDITERRANEAN

**Standard Character Mark**

No

**Registration Number**

4717620

**Date Registered**

2015/04/07

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

Geis Hospitality, LLC LIMITED LIABILITY COMPANY OHIO 2017 East 9th  
Street Cleveland OHIO 44115

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared entrees  
consisting primarily of meat, fish, poultry, or vegetables for dine-in  
or carry-out. First Use: 2013/10/04. First Use In Commerce:  
2014/09/05.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101: G & S: Restaurant and  
bar services; Catering services. First Use: 2013/10/04. First Use In  
Commerce: 2014/09/05.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Prepared entrees  
consisting primarily of pasta or rice for dine-in or carry-out. First  
Use: 2013/10/04. First Use In Commerce: 2014/09/05.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MODERN MEDITERRANEAN"

Print: May 14, 2015

86156164

APART FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the word "ADEGA" above the word "MODERN", which is above the word "MEDITERRANEAN", all in stylized writing.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Translation Statement**

The English translation of "ADEGA" in the mark is "cellar".

**Filing Date**

2014/01/02

**Examining Attorney**

CASE, LEIGH CAROLINE

**Attorney of Record**

Steven J. Solomon

adeqa

MODERN  
MEDITERRANEAN

Print: May 14, 2015

86161658

**DESIGN MARK**

**Serial Number**

86161658

**Status**

REGISTERED

**Word Mark**

THE LAST TRUE CHICKEN SANDWICH

**Standard Character Mark**

Yes

**Registration Number**

4713692

**Date Registered**

2015/03/31

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

[4] STANDARD CHARACTER MARK

**Owner**

YEB I LLC LIMITED LIABILITY COMPANY DELAWARE 7100 Corporate Drive  
Plano TEXAS 75024

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Chicken. First  
Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches. First  
Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services; take-out restaurant services. First Use: 2014/04/09. First  
Use In Commerce: 2014/04/09.

**Filing Date**

2014/01/09

**Examining Attorney**

GAYNOR, BARBARA

Print: May 14, 2015

86161658

**Attorney of Record**  
Leanne Stendell

# THE LAST TRUE CHICKEN SANDWICH

Print: May 14, 2015

86161681

**DESIGN MARK**

**Serial Number**

86161681

**Status**

REGISTERED

**Word Mark**

SUPER CHIX CHICKEN & FRIES

**Standard Character Mark**

No

**Registration Number**

4687081

**Date Registered**

2015/02/17

**Type of Mark**

TRADEMARK, SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

YEB I LLC LIMITED LIABILITY COMPANY DELAWARE 7100 Corporate Drive  
Plano TEXAS 75024

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Chicken; French fries, French fried potatoes, French fried onions; salads, namely, vegetable salads with and without chicken. First Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches; dipping sauces; frozen custards. First Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant services; take-out restaurant services. First Use: 2014/04/09. First Use In Commerce: 2014/04/09.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CHICKEN & FRIES" APART

**Print: May 14, 2015**

**86161681**

FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the words "SUPER" and "CHIX" in a stylized format above the words "CHICKEN & FRIES" in a stylized format.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Filing Date**

2014/01/09

**Examining Attorney**

GAYNOR, BARBARA

**Attorney of Record**

Leanne Stendell

# **SUPER CHIX**

**CHICKEN & FRIES**

Print: May 14, 2015

86281982

**DESIGN MARK**

**Serial Number**

86281982

**Status**

REGISTERED

**Word Mark**

LAS ALIADAS

**Standard Character Mark**

Yes

**Registration Number**

4663148

**Date Registered**

2014/12/30

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

ARINDA GARZA ARANGUA INDIVIDUAL MEXICO Pablo M de Sarasate #104, San Jeronimo Monterrey, NL MEXICO 64630

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Seasoned meat, seafood and poultry. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sauces. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Café and restaurant services. First Use: 2014/04/30. First Use In Commerce: 2014/04/30.

**Translation Statement**

The English translation of "Las Alliadas" in the mark is "The Allied".

**Filing Date**

**Print: May 14, 2015**

**86281982**

2014/05/15

**Examining Attorney**

POWELL, LINDA

# LAS ALIADAS

Print: May 14, 2015

86292281

**DESIGN MARK**

**Serial Number**

86292281

**Status**

REGISTERED

**Word Mark**

OREN'S HUMMUS SHOP

**Standard Character Mark**

No

**Registration Number**

4698745

**Date Registered**

2015/03/10

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Oren's Hummus, LLC LIMITED LIABILITY COMPANY CALIFORNIA 261 University Avenue Palo Alto CALIFORNIA 94301

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100.101. G & S: Restaurant and catering services. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Hummus; vegetable-based spreads and dips; snack dips; pre-cut salads consisting of lettuce, vegetables, fruit, proteins, grains, and cheese. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Hot sauce; hot chili pepper sauce; chili paste for use as a seasoning; garlic-based sauce; bread and pastry; rugelach; babka; white and whole wheat pita bread. First Use: 2011/06/01. First Use In Commerce: 2011/06/01.

**Disclaimer Statement**

**Print: May 14, 2015**

**86292281**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HUMMUS SHOP" APART FROM THE MARK AS SHOWN.

**Name/Portrait Statement**

The name(s), portrait(s), and/or signature(s) shown in the mark identifies Oren Dobronsky, whose consent(s) to register is made of record.

**Description of Mark**

The mark consists of a horizontal black oval with the words "Oren's Hummus shop" in black centered within it and a stylized green olive branch on the left side of the oval.

**Colors Claimed**

The color(s) green and black is/are claimed as a feature of the mark.

**Filing Date**

2014/05/27

**Examining Attorney**

STEIN, JAMES

**Attorney of Record**

Lisa Liu.



OREN'S  
HUMMUS  
shop

Print: May 14, 2015

86316957

**DESIGN MARK**

**Serial Number**

86316957

**Status**

REGISTERED

**Registration Number**

4730521

**Date Registered**

2015/05/05

**Type of Mark**

TRADEMARK; SERVICE MARK; COLLECTIVE SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(2) DESIGN ONLY

**Owner**

Cajun Funding Corp. DBA Church's Chicken CORPORATION DELAWARE Suite  
1100 980 Hammond Drive Atlanta GEORGIA 30328

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared meals consisting primarily of chicken for consumption on or off the premises; prepared side dishes, namely, mashed potatoes, fried potatoes, pickled jalapenos, breaded and fried jalapeno peppers, coleslaw, and fried okra. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Biscuits; prepared side dishes, namely, macaroni and cheese and corn on the cob; desserts, namely, pies; tea-based beverages; and sauces. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100.101. G & S: Restaurant services. First Use: 2014/08/11. First Use In Commerce: 2014/08/11.

**Description of Mark**

The mark consists of a picture of two golden brown fried chicken legs which overlap to form the shape of a heart.

**Colors Claimed**

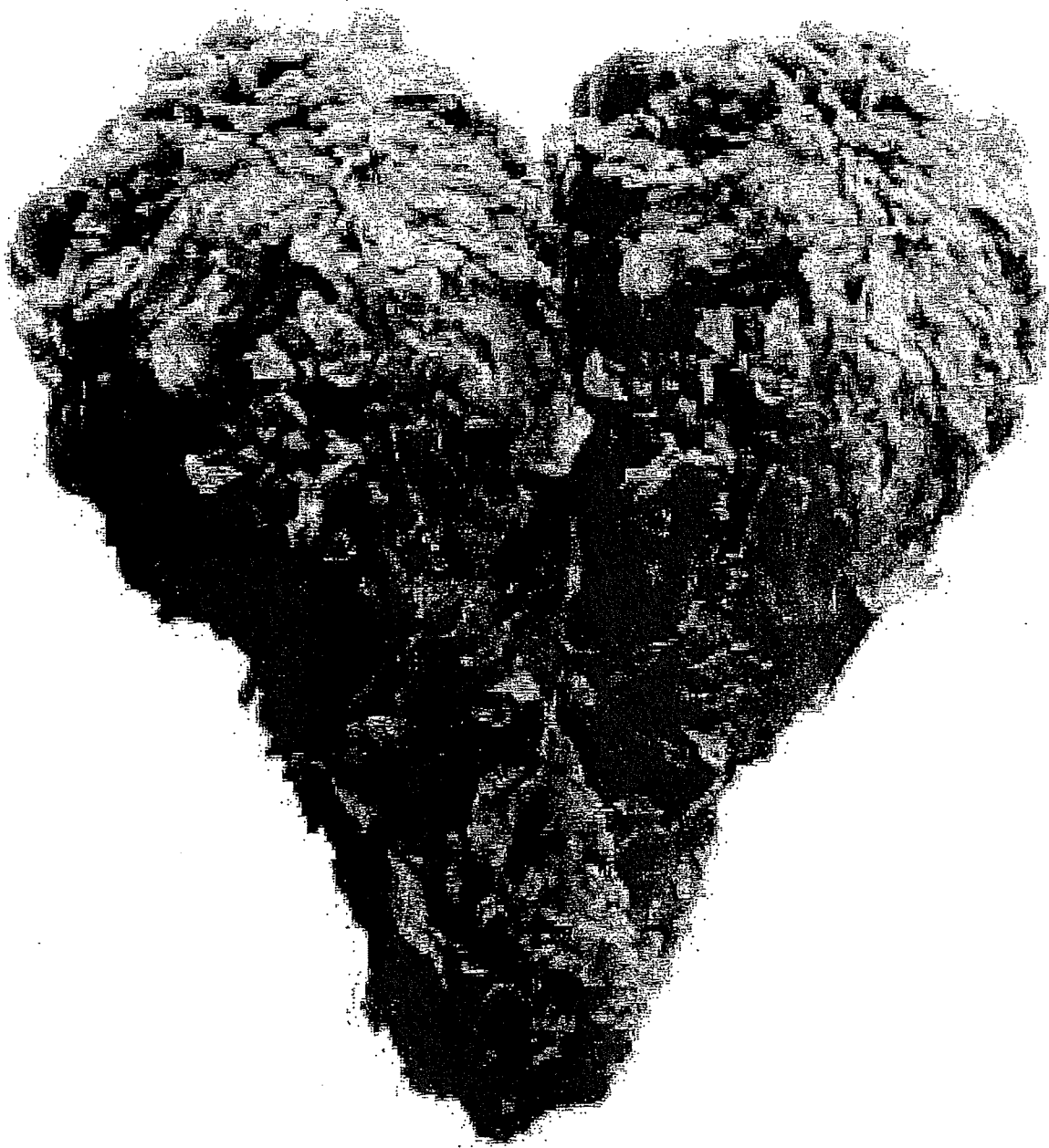
The color(s) golden brown is/are claimed as a feature of the mark.

**Print: May 14, 2015**

**86316957**

**Filing Date**  
2014/06/23

**Examining Attorney**  
BROOKSHIRE, DAVID



Print: May 14, 2015

86316988

**DESIGN MARK**

**Serial Number**

86316988

**Status**

REGISTERED

**Word Mark**

HAVE THE LOVE

**Standard Character Mark**

Yes

**Registration Number**

4678773

**Date Registered**

2015/01/27

**Type of Mark**

TRADEMARK, SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Cajun Funding Corp. DBA Church's Chicken CORPORATION DELAWARE Suite  
1100 980 Hammond Drive Atlanta GEORGIA 30328

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Prepared meals consisting primarily of chicken for consumption on or off the premises; prepared side dishes, namely, mashed potatoes, fried potatoes, pickled jalapenos, breaded and fried jalapeno peppers, coleslaw, and fried okra. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Biscuits; prepared side dishes, namely, macaroni and cheese and corn on the cob; desserts, namely, pies; tea-based beverages; and sauces. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant services. First Use: 2014/07/21. First Use In Commerce: 2014/07/21.

**Print: May 14, 2015**

**86316988**

**Filing Date**  
2014/06/23

**Examining Attorney**  
BROOKSHIRE, DAVID

HAVE THE LOVE

Print: May 14, 2015

86351130

**DESIGN MARK**

**Serial Number**

86351130

**Status**

REGISTERED

**Word Mark**

SUBWAY FRESH FIT FOR KIDS

**Standard Character Mark**

Yes

**Registration Number**

4699469

**Date Registered**

2015/03/10

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Doctor's Associates Inc. CORPORATION FLORIDA 325 Bic Drive Milford  
CONNECTICUT 06461

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant  
services. First Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sandwiches. First  
Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Processed apples.  
First Use: 2006/11/28. First Use In Commerce: 2006/11/28.

**Prior Registration(s)**

1174608;4205708;4217167;AND OTHERS

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FRESH" AND "FOR KIDS".  
APART FROM THE MARK AS SHOWN.

Print: May 14, 2015

86351130

**Filing Date**

2014/07/29

**Examining Attorney**

HOFFMAN, DAVID

**Attorney of Record**

Jessica Johnson- Connecticut Bar Member

SUBWAY FRESH FIT FOR KIDS

Print: May 14, 2015

86375918

**DESIGN MARK**

**Serial Number**

86375918

**Status**

REGISTERED

**Word Mark**

RICK'S BARBECUE

**Standard Character Mark**

Yes

**Registration Number**

4723150

**Date Registered**

2015/04/21

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Rick's Barbecue, Inc. CORPORATION TENNESSEE P.O. Box 725 Lawrenceburg  
TENNESSEE 38464

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Precooked meats  
sold in vacuum-sealed packages. First Use: 1990/10/25. First Use In  
Commerce: 1990/10/26.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Sauces. First Use:  
2009/03/23. First Use In Commerce: 2009/03/23.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Restaurant and  
catering services. First Use: 1984/01/01. First Use In Commerce:  
1984/01/01.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BARBECUE" APART FROM  
THE MARK AS SHOWN.

**Print: May 14, 2015**

**86375918**

**Filing Date**  
2014/08/25

**Examining Attorney**  
BOULTON, KELLY

**Attorney of Record**  
John C. Blattner

# Rick's Barbecue

Print: May 14, 2015

86387148

**DESIGN MARK**

**Serial Number**

86387148

**Status**

REGISTERED

**Word Mark**

SWEET BUTTER KITCHEN - CAFÉ MARKET

**Standard Character Mark**

No

**Registration Number**

4731147

**Date Registered**

2015/05/05

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Rberge Holdings LLC LIMITED LIABILITY COMPANY CALIFORNIA 13824 Ventura Blvd. Sherman Oaks CALIFORNIA 91423

**Goods/Services**

Class Status -- ACTIVE. IC 029. US 046. G & S: Jellies and jams; Potato chips; Salads, namely, fruit salads; Soups; Vegetable salads. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

**Goods/Services**

Class Status -- ACTIVE. IC 030. US 046. G & S: Candy; Chocolate covered pretzels; Cookie dough; Cookies; Crackers; Croissants; Fudge; Hot sauce; Macaroons; Peanut brittle; Popcorn; Sandwiches; Toast; Tortilla chips. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

**Goods/Services**

Class Status -- ACTIVE. IC 043. US 100 101. G & S: Café and restaurant services; Catering; Catering services; Restaurant; Restaurant and Café services; Restaurant and catering services; Take-out restaurant services. First Use: 2010/02/25. First Use In Commerce: 2010/11/22.

Print: May 14, 2015

86387148

**Prior Registration(s)**

3932528

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KITCHEN" AND "CAFE" AND "MARKET" APART FROM THE MARK AS SHOWN.

**Description of Mark**

The mark consists of the words "SWEET BUTTER KITCHEN . CAFE . MARKET" surrounded by a fanciful oval border with a series of wide stripes in the background. The gray is intended to show shading only and color is not claimed as a feature of the mark.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Filing Date**

2014/09/05

**Examining Attorney**

BUCHANAN WILL, NORA

**Attorney of Record**

J. Harrison Colter



**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REGISTRANTS' REQUEST FOR JUDICIAL NOTICE IN SUPPORT OF ITS OPPOSITION TO PETITIONER'S MOTION For SUMMARY JUDGMENT was served on counsel for Petitioner on April 7, 2017, by sending the same via FEDEX overnight delivery, to:

Melvin N.A. Avanzado  
THE AVANZADO LAW FIRM  
1880 Century Park East, Suite 1100  
Los Angeles, CA 90067

/S/ JAMES CAI

James Cai, Esq.  
Attorney for Registrants