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

Proceeding	92063674
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**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 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

*[Separate Statement of Undisputed Facts; Request
for Judicial Notice; Declaration of Melvin N.A.
Avanzado; Exhibits to Avanzado Declaration filed
concurrently herewith]*

PETITIONER'S MOTION FOR SUMMARY JUDGMENT

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION AND SUMMARY	1
II. FACTUAL BACKGROUND	2
A. Procedural Facts	2
B. The Background Behind And Creation of “Barrio Fiesta”	2
C. BFMC’s Distribution of “Barrio Fiesta” Products in the United States	3
D. Facts Underlying The Registration of the ‘365 Mark	4
E. Registrants’ Intentional Association With The Existing and More Famous “Barrio Fiesta” Marks	5
F. Related “Barrio Fiesta” Trademark Applications & Registrations	6
III. SUMMARY JUDGMENT SHOULD BE GRANTED	8
A. Legal Standards Governing Summary Judgment	8
B. BFMC and The Ongpauco Family’s Use Of The “Barrio Fiesta” Mark Establish Priority of Use	9
1. Priority of Use In The United States	9
2. Priority of Use In The Philippines	11
IV. CONCLUSION	14

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page(s)</u>
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986)	8
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986)	8
<i>Chance v. Pac-Tel Teletrac Inc.</i> , 242 F.3d 1151 (9th Cir. 2001)	10
<i>Groupion, L.L.C. v. Groupon, Inc.</i> , 859 F. Supp. 2d 1067 (N.D. Cal. 2012)	8
<i>Olde Tyme Foods, Inc. v. Roundy's Inc.</i> , 22 U.S.P.Q.2d (BNA) 1542, 1544 (Fed. Cir. ?MONTH? ?DAY?, 1992)	8
<i>Opryland USA, Inc. v. Great Am. Music Show, Inc.</i> , 23 U.S.P.Q.2d (BNA) 1471, 1472 (Fed. Cir. ?MONTH? ?DAY?, 1992)	8
<i>Sengoku Works Ltd. v. RMC Int'l, Ltd.</i> , 96 F.3d 1217 (9th Cir. 1996)	9-10
 <u>Statutes & Rules</u>	
15 U.S.C. § 1052(d)	13
15 U.S.C. § 1127	10
Fed. R. Civ. P. 56	8
37 C.F.R. § 2.116(a)	8
Trademark Manual of Examining Procedure § 1207.1	8
 <u>Other</u>	
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (4th ed. 2002)	11

Petitioner Consuelo Ongpauco-Cauton (“Ongpauco-Cauton”) hereby moves for summary judgment on her petition for cancellation (the “Petition”) of the mark, “Barrio Fiesta Express” registered on or about October 4, 2011 by Registrants June Francis Rono, Ashley Kirsten C. Rono and Justin Christian C. Rono (collectively, the “Registrants”).^{1/}

I.

INTRODUCTION AND SUMMARY

The evidence establishes the following undisputed facts warranting summary judgment on this Petition and cancellation of Registrants’ mark. “Barrio Fiesta” is a long established brand and mark in the Philippines created by the matriarch of the Ongpauco family in 1958. The Ongpauco family has been operating “Barrio Fiesta” restaurants in the Philippines continuously since that time. Since 1987, the Ongpauco family also has used the “Barrio Fiesta” mark in restaurants and food products in the United States.

Registrants did not file for its registration of the “Barrio Fiesta Express” mark until 2011 – after purchasing an existing “Barrio Fiesta” restaurant in Milpitas, California started by a member of the Ongpauco family. From Registrants’ initial application and continuing today in the operation of that “Barrio Fiesta” restaurant, Registrants have sought to associate themselves with the original “Barrio Fiesta” brand and marks, created and developed by the Ongpauco family.

Thus, the undisputed evidence establishes that BFMC and the Ongpauco family have priority of use of “Barrio Fiesta” – and therefore are the rightful owners of all marks which can possibly be confused with their brand. Summary judgment should be granted in favor of BFMC on this Petition.

1. Petitioner Barrio Fiesta Manufacturing Corporation (“BFMC”) raises similar issues pertaining to priority in its petition, Cancellation No. 92063668. Both this motion and the BFMC motion are based upon the same evidence obtained by BFMC’s United States distributor in the lawsuit entitled *Barrio Fiesta, LLC v. Northridge Foods International, Inc.*, pending in the United States District Court for the Northern District of California, Case Number 4:15-cv-02669 (the “Federal Lawsuit”) and the summary judgment motion pending in that Federal Lawsuit.

II.

FACTUAL BACKGROUND^{2/}

A. Procedural Facts

Registrants are the registered owners of the mark BARRIO FIESTA EXPRESS, Registration No. 4,034,365 (the “‘365 Mark”) issued on October 4, 2011. [Facts ¶ 21] BFMC and Ongpauco-Cauton filed their Petitions for Cancellation of the ‘365 Mark on May 4, 2016.

B. The Background Behind And Creation of “Barrio Fiesta”

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. [Facts ¶ 1] Mrs. Ongpauco had eight children, each of whom opened one or more “Barrio Fiesta” restaurants in the Philippines. [Facts ¶ 2]

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”). [Facts ¶ 3] In or about 1994, Ongpauco-Tamayo transferred the Los Angeles BF Restaurant to another Ongpauco sibling, Ongpauco-Cauton and her husband, Cesar Cauton (collectively, the “Cautons”). [Facts ¶ 4]

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. [Facts ¶ 5] 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. [Facts ¶ 6] 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

2. The evidence supporting the uncontroverted facts summarized in this Factual Background are set forth in detail in the Separate Statement of Undisputed Facts of Law filed concurrently with this motion. Citations to this evidence in this motion are denominated “Facts ¶ ____.”

“Milpitas BF Restaurant”). [Facts ¶ 7] The Milpitas BF Restaurant opened after the Los Angeles BF Restaurant. [Facts ¶ 8]

C. BFMC’s Distribution of “Barrio Fiesta” Products in the United States

Bonifacio started BFMC in 1987 in the Philippines. [Facts ¶ 9] By November 1987, BFMC started manufacturing packaged food products under the “Barrio Fiesta” label. [Facts ¶ 10] 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. [Facts ¶ 11] 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. [Facts ¶ 12] Later, BFMC used other companies to distribute its products in the United States. [Facts ¶ 13]

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. [Facts ¶ 14] 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. [Facts ¶ 15]

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. [Facts ¶ 16] Global Foods has distributed Barrio Fiesta products since at least 1989. [Facts ¶ 17] The Barrio Fiesta products distributed by Global Foods ultimately are sold to consumers. [Facts ¶ 18]

Since 2006, Northridge Foods International, Inc. (“Northridge”) and its affiliate in the Philippines, Northridge Foods Import & Export, Inc. (“Northridge Philippines”), have been BFMC’s exclusive United States distributor of “Barrio Fiesta” products. [Facts ¶ 19] 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. [Facts ¶ 20]

D. Facts Underlying The Registration of the '365 Mark

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. [Facts ¶ 21]

In 2010, Registrant June executed an agreement to purchase an existing "Barrio Fiesta" restaurant in Milpitas, California – *i.e.* the Milpitas BF Restaurant – effective January 2011. [Facts ¶ 22] Until his purchase of this existing restaurant, June's only connection with "Barrio Fiesta" was as a consumer. [Facts ¶ 23]

June acknowledges that he was aware of BFMC's distribution of "Barrio Fiesta" products in the United States *before* he purchased the Milpitas BF Restaurant. [Facts ¶ 24] June's specific testimony on this point was as follows:

Q: Are you able to estimate a date that you purchased Barrio Fiesta food products of Barrio Fiesta Manufacturing Corporation in the United States?

A: Again, I don't recall specifically. I do remember, perhaps, buying it mid- -- mid-2000s, perhaps.

Q: Okay. But certainly before you purchased the Barrio Fiesta Restaurant located in Milpitas?

A: Yes.

[Facts ¶ 25] Registrants were also aware that Barrio Fiesta restaurants in the Philippines had been in existence for decades. [Facts ¶ 26] June visited and ate at one of the Barrio Fiesta restaurants in the Philippines prior to his purchase of the Milpitas BF Restaurant. [Facts ¶ 27]

On or about September 14, 2010, June incorporated a California corporation, Barrio Fiesta LLC ("BFLLC"). June is the sole officer and shareholder of BFLLC. [Facts ¶ 28]

BFLLC owns and operates the Milpitas BF Restaurant, which is still called “The Original Barrio Fiesta of Manila” and uses its original signage. [Facts ¶ 29]

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. [Facts ¶ 30] June completed the application himself and caused his children, Justin and Ashley, to file the application. [Facts ¶ 31]

On October 4, 2011, Justin and Ashley obtained the registration of the BARRIO FIESTA EXPRESS service mark for fast food restaurants. [Facts ¶ 33] On November 24, 2014, Justin and Ashley filed an assignment of ownership of the BARRIO FIESTA EXPRESS mark to include June. [Facts ¶ 32]

E. Registrants’ Intentional Association With The Existing and More Famous “Barrio Fiesta” Marks

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. [Facts ¶ 34] 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. [Facts ¶ 35]

Registrants admit that Barrio Fiesta is a famous restaurant created in the Philippines. [Facts ¶ 36] 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.” [Facts ¶ 37] 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.” [Facts ¶ 38]

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. [Facts ¶ 39] "Barrio Fiesta" is recognized as one of the iconic brands of the Philippines. [Facts ¶ 40]

F. Related "Barrio Fiesta" Trademark Applications & Registrations

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. [Facts ¶ 41] 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. [Facts ¶ 42]

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. [Facts ¶ 43]

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. [Facts ¶ 44]

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. [Facts ¶ 45] That application was granted on October 29, 1986, registration number 28689. [Facts ¶ 46] 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. [Facts ¶ 47]

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. [Facts ¶ 48] 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. [Facts ¶ 49]

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. [Facts ¶ 50] 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. [Facts ¶ 51]

BFMC's pending application to re-register a "Barrio Fiesta" mark has been suspended by the USPTO because of potential confusion with Registrants' '365 Mark.

[Facts ¶ 52]

III.

SUMMARY JUDGMENT SHOULD BE GRANTED

A. Legal Standards Governing Summary Judgment

The Federal Rules of Civil Procedure generally apply to proceedings before the Trademark Trial and Appeal Board. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 23 U.S.P.Q. 2D (BNA) 1471, 1472 (Fed. Cir. 1992) (citing 37 C.F.R. § 2.116(a)). Summary judgment is appropriate after adequate discovery when the evidence demonstrates that there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56; *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); *Groupon, LLC v. Groupon, Inc.*, 859 F. Supp. 2d 1067, 1071 (N.D. Cal. 2012).

An issue of fact is "genuine" only if there is sufficient evidence for a reasonable fact finder to find for the non-moving party." *Groupon, LLC*, 859 F. Supp. 2d at 1072 (citing *Anderson*, 477 U.S. at 248-49). The moving party bears the initial burden of establishing the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). The non-moving party's evidence in opposition to a motion for summary judgment "is to be believed, and all justifiable inferences are to be drawn in [its] favor." *Anderson*, 477 U.S. at 255; *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 22 U.S.P.Q. 2D (BNA) 1542, 1544 (Fed. Cir. 1992).

As detailed here, the undisputed evidence shows that Registrants' first use of the '365 Mark came many decades after continuous use by BFMC and others in the Ongpauco family – both here in the United States and in the Philippines. Because Registrants cannot establish priority of use (despite their successful registration of a mark), Ongpauco-Cauton is entitled to summary judgment on this petition to cancel the '365 Mark.

B. BPMC and The Ongpauco Family's Use Of The "Barrio Fiesta" Mark
Establish Priority of Use

The undisputed evidence establishes that: (1) the Ongpauco family has been using the "Barrio Fiesta" mark in restaurants in the Philippines since 1958 and in the United States since 1987 [Bonifacio Depo. at 8:5-9:20 (Avanzado Ex. 3-A); Cauton Depo. at 11:7-12:8 (Avanzado Ex. 3-B)], (2) BPMC has been manufacturing "Barrio Fiesta" food products and importing them into the United States since 1987 [Bonifacio Depo. at 22:2-5, 24:14-20, 43:8-22, 51:16-20, 54:8-12; 69:12-17 (Avanzado Ex. 3-A)], and (3) BPMC and its distributors have sold "Barrio Fiesta" products in the United States continuously many years before Registrants obtained their registration for the '365 Mark [Alianan Decl. ¶¶3-6 (Avanzado Ex. 1)].^{3/} In contrast, Registrants had no involvement with any "Barrio Fiesta" mark until one of them purchased the Milpitas BF Restaurant [June Depo. at 143:24-144:9 (Avanzado Ex. 3-F) & Avanzado Ex. 3-N (Purchase Agreement)]. Registrants' own application admits their date of first use was January 3, 2011. [RJN ¶¶ C, D, E & F & RJN Ex. 3; Avanzado Exs. 3-O, 3-P & 3-JJ]

Because BPMC and the Ongpauco family establish priority of use of the "Barrio Fiesta" marks, Registrants do not have valid ownership of the '365 Mark or any "Barrio Fiesta" related mark.

1. Priority of Use In The United States

A cardinal principle of trademark law is "first in time equals first in right." *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088, 1093 (9th Cir. 2004) (citing *Sengoku Works*

3. The Avanzado Declaration submitted herewith attaches the Declarations of Erlinda Alianan (Exhibit 1), Ronald Yu (Exhibit 2) and Melvin N.A. Avanzado (Exhibit 3) which were filed in the Federal Lawsuit. References to the exhibits in these Federal Lawsuit declarations shall be referenced by the declaration's exhibit number to the Avanzado Declaration filed herewith followed by the exhibit number to the corresponding declaration filed in the Federal Lawsuit. For example, the Avanzado Declaration filed in the Federal Lawsuit is Exhibit 3 to the declaration submitted here; thus, Exhibit A of the Avanzado Declaration filed in the Federal Lawsuit is cited herein as "Avanzado Ex. 3-A."

Ltd. v. RMC Int'l, Ltd., 96 F.3d 1217, 1219 (9th Cir. 1996) (“It is axiomatic in trademark law that the standard test of ownership is priority of use.”)).

Under the principle of first in time equals first in right, priority ordinarily comes with earlier use of a mark in commerce. It is “*not enough to have invented the mark first or even to have registered it first.*”

Grupo Gigante, 391 F.3d at 1093 (emphasis added). For both goods and services, the “use in commerce” requirement includes “(1) an element of actual use, and (2) an element of display.” *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1159 (9th Cir. 2001) (citing 15 U.S.C. § 1127)).

The Barrio Fiesta mark and logo have been used in both the restaurant and packaged food product classifications decades before June purchased the Milpitas BF Restaurant. The Ongpauco siblings operated Los Angeles area restaurants and the Milpitas BF Restaurant before Plaintiff used the mark. [Cauton Depo. at 11:7-12:8, 14:7-11, 18:4-23 (Avanzado Ex. 3-B)] Barrio Fiesta products bearing the “Barrio Fiesta” mark have been sold and distributed throughout the United States since BFMC’s inception in 1987. [Bonifacio Depo. at 10:17-11:11, 22:2-5, 43:8-22, 51:16-20, 54:8-12, 69:12-17, 72:24-74:15 (Avanzado Ex. 3-A); Santos Depo. at 12:6-14:21, 29:8-33:9, 35:7-20 (Avanzado Ex. 3-C); Avanzado Ex. 3-R (Barrio Fiesta product); Yu Decl. ¶¶ 5-13 (Avanzado Ex. 2) & Avanzado Exs. 2-A through 2-D]

In contrast, June had no involvement with any “Barrio Fiesta” mark until he purchased the Milpitas BF Restaurant in 2010 (and took over operations in 2011). [June Depo. at 6:9-6:12, 10:15-10:21, 81:14-82:2 (Avanzado Ex. 3-E), June Depo. at 143:24-144:9, 271:9-21 (Avanzado Ex. 3-F) & Avanzado Ex. 3-N (Purchase Agreement)] The ‘361 Mark was not registered until 2011. [Avanzado Ex. 3-O (trademark registration); RJN Ex. 4 (trademark registration)] Registrants have no evidence to contradict the undisputed fact that the Ongpauco family and BFMC have used the “Barrio Fiesta” mark in the United States since 1987. [June Depo. at 297:14-299:20 (Avanzado Ex. 3-F)]

In sum, the undisputed evidence establishes that BFMC and the Ongpauco family used Barrio Fiesta marks in the United States long before Registrants used the ‘365 Mark. Summary judgment should be granted on this Petition.

2. Priority of Use In The Philippines

In addition, the undisputed evidence establishes that “Barrio Fiesta” has existed as a famous foreign mark for almost 60 years. Ordinarily, the “territoriality principle” in trademark law requires that “priority of trademark rights in the United States depends solely upon priority of use in the United States, not on priority of use anywhere in the world.” *Grupo Gigante*, 391 F.3d at 1093 n.9 (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 29:2, at 29-6 (4th ed. 2002) (internal footnote omitted)).

However, “when foreign use of a mark achieves a certain level of fame for that mark within the United States, the territoriality principle no longer serves to deny priority to the earlier foreign user.” *Grupo Gigante*, 391 F.3d at 1093. Thus, the Ninth Circuit held

that there is a famous mark exception to the territoriality principle.

While the territoriality principle is a long-standing and important doctrine within trademark law, it cannot be absolute. An absolute territoriality rule without a famous-mark exception would promote consumer confusion and fraud. Commerce crosses borders. In this nation of immigrants, so do people. Trademark is, at its core, about protecting against consumer confusion and “palming off.” *There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home.*

Grupo Gigante, 391 F.3d at 1094 (emphasis added; footnote omitted; citing *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002)).

In *Grupo Gigante*, the large Mexican grocery chain “Gigante” sued the United States grocery store owner of the “Gigante Market” in San Diego. The Mexican company

operated “Gigante” stores since 1962 and registered the “Gigante” mark in Mexico in 1963. By the time defendant opened its first “Gigante Market” in 1991, the Mexican grocery chain had almost 100 stores in Mexico, all using the mark “Gigante.” The Mexican company/plaintiff opened its first store in the United States (called “Gigante” like its Mexican stores) in 1999. The lawsuit followed. *Grupo Gigante*, 391 F.3d at 1091-92.

The district court held the “well-known mark” exception to the territoriality principle entitled the *Grupo Gigante* plaintiff’s earlier use in Mexico to declaratory judgment in its favor and gave it a valid and protectable interest in the “Gigante” mark. *Grupo Gigante*, 391 F.3d at 1092-93. The Ninth Circuit found it “agree[d] in large part with the district court’s excellent opinion” (*id.* at 1093) but vacated and remanded the case for the district court to apply a new test. *Grupo Gigante*, 391 F.3d at 1098.

To determine whether the famous-mark exception to the territoriality rule applies, the district court must determine whether the mark satisfies the secondary meaning test.... [¶] In addition, where the mark has not before been used in the American market, the court must be satisfied, by a preponderance of the evidence, that a *substantial* percentage of consumers in the relevant American market is familiar with the foreign mark.

Grupo Gigante, 391 F.3d at 1098 (emphasis in original).

Registrants and their Milpitas BF Restaurant expressly associate themselves with the Philippine restaurants’ famous Barrio Fiesta mark by claiming a “history dating back to 1952” on its website. [June Depo. at 33:20-34:11 (Avanzado Ex. 3-E); June Depo. at 159:24-161:12, 172:1-172:7 (Avanzado Ex. 3-F) & Avanzado Ex.3- L (BFLLC’s website)] Registrants admit that Barrio Fiesta is a famous mark in the Philippines. [June Depo. at 66:22-66:24 (Avanzado Ex. 3-E); June Depo. at 161:18-162:16, 163:4-15, 165:2-166:11 (Avanzado Ex. 3-F); Justin Depo. at 39:4-10, 41:12-20 (Avanzado Ex. 3-G); Alianan Dec. ¶ 6 (Avanzado Ex. 1) & Avanzado Ex.1-B (“Philippines’ Greatest Brands”)] Registrants admit that people are familiar

with Filipino restaurant brands created in the Philippines – such as the Barrio Fiesta brand – and make the connection with the Philippines-based restaurants when those restaurant brands are found in the United States. [June Depo. at 165:2-167:1 (Avanzado Ex. 3-F); Justin Depo. 38:21-40:15, 41:12-20 (Avanzado Ex. 3-G)]

Registrants’ admitted desire to associate themselves with the famous “Barrio Fiesta” restaurants in the Philippines is understandable. “Barrio Fiesta” is recognized as one of “Philippines’ Greatest Brands.” [Alianan Dec. ¶ 6 (Avanzado Ex. 1) & Avanzado Ex.1-B (“Philippines’ Greatest Brands”)] The Ninth Circuit in *Grupo Gigante* made clear that Registrants cannot use trademark laws “to fool immigrants into thinking they are buying from the store they liked back home.” *Grupo Gigante*, 391 F.3d at 1094. Under *Grupo Gigante*, the famous foreign mark exception to the territoriality rule applies.

In sum, the undisputed facts show that Registrants did not begin using the ‘365 Mark until almost 60 years after the Ongpauco family began the “Barrio Fiesta” restaurants which have become an iconic Filipino restaurant brand. Registrants also did not use the ‘365 Mark until almost 25 years after BFMC started selling its “Barrio Fiesta” products in the United States. Because the ‘365 Mark causes potential confusion with the “Barrio Fiesta” trademarks long used by BFMC and the Ongpauco family, summary judgment should be granted on Ongpauco-Cauton’s Petition to cancel the ‘365 Mark.^{4/}

4. The USPTO examining attorney has suspended BFMC’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. [Facts ¶ 52] Accordingly, the potential source confusion between the “Barrio Fiesta” marks used by BFMC and the Ongpauco family and Registrants’ ‘365 Mark is well established. *See* Trademark Manual of Examining Procedure §1207.1; 15 U.S.C. §1052(d) (Section 2(d) of the Trademark Act).

IV.

CONCLUSION

For all the foregoing reasons, therefore, Petitioner Consuelo Ongpauco-Cauton respectfully requests that the Court grant her motion for summary judgment on her petition for cancelation of the BARRIO FIESTA EXPRESS mark, Registration No. 4,034,365.

DATED: March 10, 2017

THE AVANZADO LAW FIRM

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PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing document:

PETITIONER'S MOTION FOR SUMMARY JUDGMENT

has been served on Registrants by mailing said copy on date set forth below via Priority United States Mail, postage prepaid, to:

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Executed on March 10, 2017 at Los Angeles, California.



Keiko Kawana