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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on June 3, 2005.

Signed Jill O'Hara
Jill O'Hara

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

In the matter of

El Viajero Cheese Company, Inc.)

Concurrent Use
Proceeding No. 94002083

v.)

Marquez Brothers International, Inc.)



06-08-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64

**STATEMENT IN RESPONSE TO NOTICE OF CONCURRENT
USE PROCEEDING**

Pursuant to 37 C.F.R. §2.99(d)(2), Marquez Brothers International, Inc., owner of trademark Registration No. 1,404,276 hereby submits the following statement in response to the Notice of Concurrent Use proceeding.

1. Marquez Brothers International, Inc. hereby advises the Board that there are no relevant applications or registrations, other than that referenced in the Notice of Concurrent Use Proceeding which should be included in this concurrent use proceeding.

2. The current, correct address of Marquez Brothers International, Inc. is 5801 Rue Ferrari, San Jose, California 95138.

3. Marquez Brothers International has been using the subject trademark VAQUERO & Design since at least as early as September 1985.

4. Registration No. 1,779,064 for EL VAQUERO in Class 29 was owned by Leon Sanna, doing business as Sanna Foods Co. This registration, which was subject to concurrent use with Marquez Brothers International, was cancelled for failure to file a declaration of use pursuant to Lanham Act Section 8, 15 U.S.C. §1058. The Section 8 declaration was due on or

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1 before June 29, 1999.

2 5. On information and belief, Leon Sanna discontinued use of the EL VAQUERO
3 mark in connection with processed dairy products excluding ice cream, ice milk and frozen
4 yogurt with the intent not to resume such use.

5 6. Pursuant to the terms of the Amended Concurrent Use Agreement between Leon
6 Sanna and Marquez Brothers International, upon abandonment of its mark, Leon Sanna's rights
7 were lost and Marquez Brothers International thereafter was entitled to use its mark in all proper
8 ways, unrestrained by the terms of the Amended Concurrent Use Agreement.

9 7. On information and belief, El Viajero Cheese Company, Inc. is not a successor in
10 interest to Leon Sanna.

11 8. On information and belief, the first use of the mark EL VAQUERO by El Viajero
12 Cheese Company was May 30, 2000. Application Serial No. 76-130,223 filed by El Viajero
13 Cheese Company September 18, 2000 originally alleged May 30, 2000 as the date of first use of
14 the mark. El Viajero Cheese Company's alleged date of first use of May 30, 2000 is well after
15 the first use and registration of Marquez Brothers International's VAQUERO and Design mark.

16 Wherefore, it is urged that El Viajero Cheese Company, Inc. is not entitled to the
17 concurrent use registration which it seeks.

19 Dated: June 3, 2005

Respectfully submitted,

20 OWEN, WICKERSHAM & ERICKSON, P.C.

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CERTIFICATE OF SERVICE

I, Jill O'Hara, declare as follows:

I am a citizen of the United States of America and am employed in the City and County of San Francisco, State of California. I am over the age of eighteen and not a party to this action. My business address is that of OWEN, WICKERSHAM & ERICKSON, P.C., 455 Market Street, 19th Floor, San Francisco, California 94105.

On June 3, 2005 I served the following document(s):

STATEMENT IN RESPONSE TO NOTICE OF CONCURRENT USE PROCEEDING
by mail by placing a true and correct copy thereof in a sealed envelope with postage fully prepaid in a United States Post Office mail box at San Francisco, California, addressed as follows:

Catherine S. Bridge, Esq.
1358 Clove Road
Staten Island, CA 10301

I declare under penalty of perjury that the foregoing is true and correct. Executed on June 3, 2005 at San Francisco, California.



Jill O'Hara

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