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Filing date: **04/22/2014**

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

Proceeding	94002596
Party	Registrant D'Amico Holding Company
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Submission	Motion for Summary Judgment
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Signature	/Bradley J. Walz/
Date	04/22/2014
Attachments	9006273_1.pdf(337521 bytes) 9006280_1.pdf(2361504 bytes) 9006286_1.pdf(40064 bytes)

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

In the matter of Application Serial No.: 76/685,731
Filed: January 14, 2008
For the mark: MASA
Published in the Trademark Official Gazette on August 23, 2011

Masayoshi Takayama,

Plaintiff,

v.

Concurrent Use No. 94002596

D'Amico Holding Company,

Defendant.

**DEFENDANT'S CROSS-MOTION AND EMBODIED MEMORANDUM OF LAW IN
SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

INTRODUCTION

Pursuant to Fed. R. Civ. P. 56(a) and 37 C.F.R. § 2.127, D'Amico Holding Company ("D'Amico") brings this Cross-Motion for Summary Judgment and requests that the Trademark Trial and Appeal Board (the "Board") enter summary judgment in D'Amico's favor. Trial is unnecessary because the undisputed facts of record establish that D'Amico's MASA & Design mark is incontestable. Consequently, Masayoshi Takayama ("Plaintiff") is entitled to a concurrent use registration for the territory in which he actually used the MASA mark prior to D'Amico's constructive notice date of February 12, 2008, which is New York City, NY. However, because the parties agreed to a specific geographic territory for Plaintiff's use of the MASA mark, the Board may broaden Plaintiff's registrable rights to New York and 50 miles around New York City, NY. The undisputed facts set forth below are supported by the evidence of record and the Declaration of Bradley J. Walz.

STATEMENT OF UNDISPUTED FACTS

- On November 30, 2006, D'Amico filed U.S. Application Serial Number 77/054,435 for its MASA & Design mark in connection with "restaurant and bar services" in International Class 43 ("D'Amico's Application"). [Decl. Walz, at Ex. 1.]
- D'Amico's Application matured into U.S. Registration Number 3,380,250 ("D'Amico's Registration"), which issued on the Principal Register on February 12, 2008. [*Id.*]
- Since February 12, 2008, D'Amico has continuously used its MASA & Design mark in commerce. [*Id.*, at Ex. 2.]
- MASA is not generic for restaurant and bar services. [*See id.*, at Ex. 1.]
- There has been no final adverse decision to D'Amico's claim of ownership, right to register, or right to keep its MASA & Design mark. [*Id.*, at Ex. 2.]
- No proceeding has been filed in any District Court challenging D'Amico's ownership of D'Amico's Registration or the validity thereof. [*Id.*]
- No Petition to Cancel D'Amico's Registration has been filed with the Board. [*Id.*]
- D'Amico filed the Declaration of Incontestability with the USPTO on December 13, 2013 at 12:13 PM CST. [*Id.*]
- The USPTO issued the Notice of Acceptance and Acknowledgement of the Declaration of Incontestability for D'Amico's MASA & Design mark on December 28, 2013. [*Id.*, at Ex. 3.]
- Plaintiff filed its amendment to convert its geographically unrestricted application on December 13, 2013, which was served on D'Amico by e-mail at 4:06 PM. [*Id.*, at Ex. 4.]
- As of the registration date of D'Amico's MASA & Design mark on February 12, 2008, Plaintiff had only used his MASA mark in connection with one restaurant in New York City, NY. [*Id.*, at Exs. 5, 6.]
- Since 2004, Plaintiff's MASA has been a single location at 10 Columbus Circle, Time Warner Center, 4/F, New York, NY 10019. [*Id.*, at Exs. 5 - 8.]

ARGUMENT

I. THERE IS NO GENUINE DISPUTE OF MATERIAL FACT THAT D'AMICO IS ENTITLED TO THE ENTIRE UNITED STATES EXCEPT FOR NEW YORK AND 50 MILES AROUND NEW YORK CITY, NY

A. *Standard of Review*

Summary judgment is appropriate when there is an absence of genuinely disputed material facts. FED R. CIV. PROC. 56(c). “When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine dispute of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial.” *Sinclair Oil Corp. v. Sumatra Kendrick*, 85 U.S.P.Q.2d 1032, 1034 (T.T.A.B. 2007). “The nonmoving party may not rest on the mere allegations of its pleadings and arguments in response to the motion, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.” *Id.*

As the concurrent use applicant, Plaintiff has the burden to show that: (1) he made lawful concurrent use of the MASA mark in commerce prior to the filing dates of D'Amico's MASA and MASA & Design applications; and (2) that confusion, mistake, or deception is not likely to result from his continued use of the MASA mark in the areas in which he is currently using his mark. *Turdin, Jr. v. Trilobite, Ltd.*, 109 U.S.P.Q.2d 1473 (T.T.A.B. 2014) There is no dispute that the first condition to the issuance of a concurrent use registration has been satisfied. *See id.* The parties acknowledged in the Confidential Settlement Agreement that Plaintiff used the MASA mark in connection with Japanese sushi restaurant and bar services in New York City, NY since at least 2004. [Dkt. No. 6, Decl. Plumley, Ex. A.] It is also undisputed that D'Amico filed its application to register its MASA & Design mark for “restaurant and bar services” on November 30, 2006. [Decl. Walz, Ex. 1.]

There is also no dispute that the second condition to the issuance of a concurrent use registration has been satisfied. *See Trilobite, Ltd.*, 109 U.S.P.Q.2d at 1473. Pursuant to Paragraph 1 of the Confidential Settlement Agreement, D'Amico will not provide restaurant or bar services under the MASA mark in New York or within 50 miles of New York City, NY. [Dkt. No. 6, Decl. Plumley, Ex. A.] Likewise, pursuant to Paragraph 2 of the Confidential Settlement Agreement, Plaintiff will not provide restaurant or bar services under the MASA mark in Minnesota, 50 miles of Minneapolis, MN, or Florida. [*Id.*] What remains in dispute are the registrable rights to the remainder of the United States possessed by each party.

B. *Because D'Amico's MASA & Design mark is incontestable, D'Amico's registrable rights extend to the entire United States except for New York and 50 miles around New York City, NY*

An incontestable registration is conclusive evidence of the owner's exclusive right to use the registered mark nationwide. Lanham Act §§ 7(c), 33(b), 15 U.S.C. §§ 1057(c), 1115(b). A mark becomes incontestable when the registered mark has been continuously used in commerce for five consecutive years after the date of registration, unless one of four exceptions exists. Lanham Act § 15, 15 U.S.C. § 1065.

The MASA & Design mark has been continuously used in commerce since February 12, 2008, and none of the four exceptions apply. [Decl. Walz, at Ex. 2.] There is no final decision or pending proceeding involving D'Amico's ownership of or the right to register the MASA & Design mark. [*See id.*] D'Amico submitted the declaration of Paul Smith within one year following the fifth and sixth years after registration of the MASA & Design mark. [*Id.*] And MASA is not generic for restaurant and bar services. [*See id.*, at Ex. 1.] Finally, the USPTO acknowledged the incontestability of D'Amico's MASA & Design mark. [*Id.*, at Ex. 3.]

Therefore, there is no genuine dispute of material fact that D'Amico's MASA & Design mark is incontestable.

“An ‘incontestable registration’ cannot be challenged on the basis of prior rights in a mark substantially similar to the registered mark.” *Boi Na Braza, LLC v. Terra Sul Corp. a/k/a Churrascaria Boi Na Brasa*, Concurrent Use No. 94002525, at 17 (T.T.A.B. March 26, 2014) (citing Lanham Act §§ 15, 33(b)(5), 15 U.S.C. §§ 1065, 1115(b)(5)). “Under such circumstances, a prior user normally may carve out of an incontestable registration only ‘the specific area in which it has established its prior rights prior to actual or constructive notice of said registration.’” *Id.* at 17-18 (citing *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 U.S.P.Q. 330, 334 (T.T.A.B. 1980)).

Since 2004, Plaintiff's MASA restaurant has been a single location at 10 Columbus Circle, Time Warner Center, 4/F, New York, NY 10019. [See Decl. Walz, at Exs. 5 - 8.] Indeed, Plaintiff's website on January 24, 2008 and February 14, 2008 identified only the location at the Time Warner Center. [*Id.*, at Exs. 5, 6.] The constructive notice date for D'Amico's MASA & Design registration is February 12, 2008. [*Id.*, at Ex. 1.] Because D'Amico's Registration is incontestable and Plaintiff's MASA restaurant was a single location at 10 Columbus Circle, Time Warner Center, 4/F, New York, NY 10019 on February 12, 2008, there is no genuine dispute of material fact that D'Amico's registrable rights in its MASA & Design mark encompass the entire United States except for New York and 50 miles around New York City, NY.

The facts of this case are very similar to the facts in the *Boi Na Braza* case. *Boi Na Braza, LLC* obtained two, geographically unrestricted registrations for the BOI NA BRAZA and BOI NA BRAZA & Design marks in connection with restaurant services. *Boi Na Braza, LLC*,

Concurrent Use No. 94002525, at 1-2. Terra Sul Corporation (“Terra Sul”) successfully petitioned to cancel the registration for the BOI NA BRAZA mark in standard characters, but did not petition to cancel the registration for the BOI NA BRAZA & Design mark. *Id.*, at 2. The BOI NA BRAZA & Design mark eventually became incontestable. *Id.*, at 17.

Following the cancellation of the registration for the BOI NA BRAZA mark in standard characters, Boi Na Braza filed a concurrent use application for the BOI NA BRAZA mark in standard characters claiming the entire United States except for New Jersey and naming Terra Sul as the exception to Boi Na Braza’s exclusive rights. *Id.*, at 2-3. A concurrent use proceeding was instituted, and Terra Sul asked that Boi Na Braza’s registrable rights be limited to Dallas, TX; Atlanta, GA; and Cincinnati, OH. *Id.*, at 3.

Because Boi Na Braza owned an incontestable registration for a mark that incorporated the entire literal element of the mark that was subject to the concurrent use application, Boi Na Braza was entitled to the entire United States except for those areas where Terra Sul could establish it had used its mark prior to the constructive notice date of the incontestable BOI NA BRAZA & Design mark. *Id.*, at 17-18. Terra Sul was able to establish use of its mark in New York and New Jersey before December 24, 2002, the registration date of the BOI NA BRAZA & Design mark. *Id.*, at 19. Therefore, the Board awarded Boi No Braza the entire United States except for New York and New Jersey. *Id.*, at 20.

In this case, D’Amico owns two geographically unrestricted registrations for its MASA and MASA & Design marks in connection with restaurant services. D’Amico’s MASA & Design mark is incontestable. Therefore, like the *Boi Na Braza* case, D’Amico is entitled to the entire United States except for New York and 50 miles around New York City, NY.

CONCLUSION

There is no genuine dispute of material fact that D'Amico is entitled to the entire United States except for New York and 50 miles around New York City, NY. Therefore, D'Amico respectfully requests that the Board grant its Cross-Motion for Summary Judgment.

Respectfully Submitted,

WINTHROP & WEINSTINE, P.A.



Bradley J. Walz
Timothy D. Sitzmann
3500 Capella Tower
225 South Sixth Street
Minneapolis, MN 55402-4629
Telephone: (612) 604-6400
Facsimile: (612) 604-6800

ATTORNEYS FOR DEFENDANT
D'AMICO HOLDING COMPANY

Date: April 22, 2014

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

In the matter of Application Serial No.: 76/685,731
Filed: January 14, 2008
For the mark: MASA
Published in the Trademark Official Gazette on August 23, 2011

Masayoshi Takayama,

Plaintiff,

v.

Concurrent Use No. 94002596

D'Amico Holding Company,

Defendant.

DECLARATION OF BRADLEY J. WALZ

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. § 1001, and that such willful false statements and the like may jeopardize the validity of this document declares that:

1. I am a shareholder with the law firm of Winthrop & Weinstine, P.A. and I am one of the attorneys representing D'Amico Holding Company ("D'Amico") in the above-captioned matter.
2. This Declaration is submitted in support of Defendant's Motion for Summary Judgment and is based upon my personal knowledge.
3. Attached as Exhibit 1 is a true and correct copy of the TESS ("Trademark Electronic Search System") and Assignment database printouts showing current status and title for the MASA & Design mark, Reg. No. 3,380,250.
4. Attached as Exhibit 2 is a true and correct copy of the Combined Declaration of use and Incontestability under Sections 8 & 15 for Registration No. 3,380,250 for the MASA &

Design mark, which was obtained from the Trademark Status & Document Retrieval (“TSDR”) database on April 21, 2014.

5. Attached as Exhibit 3 is a true and correct copy of the Notice of Acceptance Under Section 8 and Notice of Acknowledgment Under Section 15 for Registration No. 3,380,250 for the MASA & Design mark, which was obtained from the TSDR database on April 21, 2014.

6. Attached as Exhibit 4 is a true correct copy of the e-mail correspondence sent to me by Jennifer H. Guerra dated December 13, 2013.

7. Attached as Exhibit 5 is a true and correct copy of an archived Web page from Plaintiff’s website located at the <masanyc.com> domain name on January 24, 2008, which was obtained from the website located at the <archive.org> domain name on April 18, 2014.

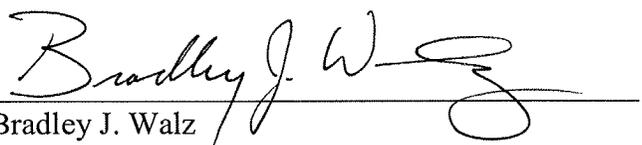
8. Attached as Exhibit 6 is a true and correct copy of an archived Web page from Plaintiff’s website located at the <masanyc.com> domain name on February 14, 2008, which was obtained from the website located at the <archive.org> domain name on April 21, 2014

9. Attached as Exhibit 7 is a true and correct copy of an archived Web page from Plaintiff’s website located at the <masanyc.com> domain name on September 1, 2004, which was obtained from the website located at the <archive.org> domain name on April 21, 2014.

10. Attached as Exhibit 8 is a true and correct copy of Plaintiff’s website located at the <masanyc.com> domain name that was obtained on April 21, 2014.

FURTHER YOUR DECLARANT SAYETH NOT

Date: April 22, 2014


Bradley J. Walz

9003538v1

Exhibit 1



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Word Mark MASA

Translations The foreign wording in the mark translates into English as flour or dough.

Goods and Services IC 043. US 100 101. G & S: Restaurant and bar services. FIRST USE: 20051122. FIRST USE IN COMMERCE: 20051122

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

Design Search Code 26.07.14 - Diamonds, exactly three diamonds; Three diamonds
26.07.21 - Diamonds that are completely or partially shaded
26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved
26.17.25 - Other lines, bands or bars

Trademark Search Facility Classification Code SHAPES-BAR-BANDS Designs with bar, bands or lines
SHAPES-COLORS-3-OR-MORE Design listing or lined for three or more colors
SHAPES-DIAMONDS Diamond shaped designs including shaded or more than one diamond

Serial Number 77054435

Filing Date November 30, 2006

Current Basis 1A

Original Filing Basis 1A

Published for Opposition November 27, 2007

Registration Number 3380250

Registration Date February 12, 2008

Owner (REGISTRANT) D'Amico Holding Company CORPORATION MINNESOTA 211 North First Street

Minneapolis MINNESOTA 55401

**Attorney of
Record**

Stephen R. Baird

**Description of
Mark**

The color(s) orange, light orange, yellowy-orange, and yellow is/are claimed as a feature of the mark. The mark consists of the color orange appears in the letter "M," lighter orange appears in the first letter "A," yellowy-orange in the letter "S," and yellow in the second letter "A." The stylized design appears in a yellowy-orange color.

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR).

**Live/Dead
Indicator**

LIVE

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No assignment has been recorded at the USPTO

For Serial Number: 77054435

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.4
Web interface last modified: Jul 8, 2013 v.2.3.4

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Exhibit 2

Combined Declaration of Use and Incontestability under Sections 8 & 15

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	3380250
REGISTRATION DATE	02/12/2008
SERIAL NUMBER	77054435
MARK SECTION	
MARK	MASA (stylized and/or with design)
ATTORNEY SECTION (current)	
NAME	Stephen R. Baird
FIRM NAME	WINTHROP & WEINSTINE PA
STREET	225 S 6TH ST STE 3500
CITY	MINNEAPOLIS
STATE	Minnesota
POSTAL CODE	55402-4629
COUNTRY	United States
PHONE	(612) 604-6585
FAX	(612) 604-6985
EMAIL	sbaird@winthrop.com
ATTORNEY SECTION (proposed)	
NAME	Stephen R. Baird
FIRM NAME	WINTHROP & WEINSTINE PA
STREET	225 S 6TH ST STE 3500
CITY	MINNEAPOLIS

STATE	Minnesota
POSTAL CODE	55402-4629
COUNTRY	United States
PHONE	(612) 604-6585
FAX	(612) 604-6985
EMAIL	trademark@winthrop.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
CORRESPONDENCE SECTION (current)	
NAME	STEPHEN R BAIRD
FIRM NAME	WINTHROP & WEINSTINE PA
STREET	225 S 6TH ST STE 3500
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COUNTRY	United States
PHONE	(612) 604-6585
FAX	(612) 604-6985
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CORRESPONDENCE SECTION (proposed)	
NAME	Stephen R. Baird
FIRM NAME	WINTHROP & WEINSTINE PA
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STATE	Minnesota
POSTAL CODE	55402-4629
COUNTRY	United States
PHONE	(612) 604-6585
FAX	(612) 604-6985
EMAIL	trademark@winthrop.com;sbaird@winthrop.com; bwalz@winthrop.com; tsitzmann@winthrop.com; jbriley@winthrop.com

AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	043
GOODS OR SERVICES	Restaurant and bar services
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	<u>SPN0-207250219132-155030795 . Specimen for MASA and Design mark in Class 43.pdf</u>
CONVERTED PDF FILE(S) (2 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\770\544\77054435\xml1\8150002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\770\544\77054435\xml1\8150003.JPG</u>
SPECIMEN DESCRIPTION	Photocopy of Registrant's menu
OWNER SECTION (current)	
NAME	D'Amico Holding Company
STREET	211 North First Street
CITY	Minneapolis
STATE	Minnesota
ZIP/POSTAL CODE	55401
COUNTRY	United States
LEGAL ENTITY SECTION (current)	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Minnesota
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	300
TOTAL FEE PAID	300
SIGNATURE SECTION	

SIGNATURE	/Paul Smith/
SIGNATORY'S NAME	Paul Smith
SIGNATORY'S POSITION	CFO
DATE SIGNED	12/12/2013
PAYMENT METHOD	CC
FILING INFORMATION	
SUBMIT DATE	Fri Dec 13 13:13:36 EST 2013
TEAS STAMP	USPTO/S08N15-207.250.219. 132-20131213131336414137- 3380250-5007180c37a1f35d1 6f3f8c8e6c684aec4664d84b0 aa37ac12cdfa2973044581c-C C-12830-20131212155030795 359

**Combined Declaration of Use and Incontestability under Sections 8 & 15
To the Commissioner for Trademarks:**

REGISTRATION NUMBER: 3380250

REGISTRATION DATE: 02/12/2008

MARK: (Stylized and/or with Design, MASA)

The owner, D'Amico Holding Company, a corporation of Minnesota, having an address of
211 North First Street
Minneapolis, Minnesota 55401
United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 043, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class: Restaurant and bar services; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one specimen for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Photocopy of Registrant's menu.

Original PDF file:

SPN0-207250219132-155030795 . Specimen for MASA and Design mark in Class 43.pdf

Converted PDF file(s) (2 pages)

Specimen File1

Specimen File2

The registrant's current Attorney Information: Stephen R. Baird of WINTHROP & WEINSTINE PA
225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota (MN) 55402-4629
United States

The registrant's proposed Attorney Information: Stephen R. Baird of WINTHROP & WEINSTINE PA
225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota (MN) 55402-4629
United States

The phone number is (612) 604-6585.

The fax number is (612) 604-6985.

The email address is trademark@winthrop.com.

The registrant's current Correspondence Information: STEPHEN R BAIRD of WINTHROP & WEINSTINE PA

225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota (MN) 55402-4629
United States

The registrant's proposed Correspondence Information: Stephen R. Baird of WINTHROP & WEINSTINE PA

225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota (MN) 55402-4629
United States

The phone number is (612) 604-6585.

The fax number is (612) 604-6985.

The email address is trademark@winthrop.com;sbaird@winthrop.com; bwalz@winthrop.com; tsitzmann@winthrop.com; jbriley@winthrop.com.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

The mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce. There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.

The undersigned being hereby 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 this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and 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: /Paul Smith/ Date: 12/12/2013

Signatory's Name: Paul Smith

Signatory's Position: CFO

Mailing Address (current):

WINTHROP & WEINSTINE PA
225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota 55402-4629

Mailing Address (proposed):

WINTHROP & WEINSTINE PA
225 S 6TH ST STE 3500
MINNEAPOLIS, Minnesota 55402-4629

Serial Number: 77054435

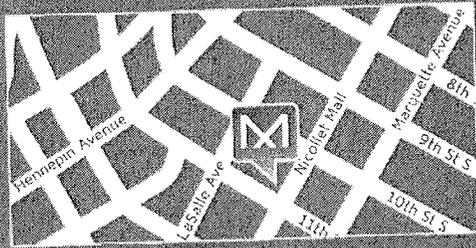
Internet Transmission Date: Fri Dec 13 13:13:36 EST 2013

TEAS Stamp: USPTO/S08N15-207.250.219.132-20131213131

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c8e6c684aec4664d84b0aa37ac12cdfa29730445

81c-CC-12830-20131212155030795359



Located on Nicollet Mall, Downtown Minneapolis
 1070 Nicollet Mall 612.338.6272
www.masa-restaurant.com

Masa offers a contemporary homage to the tradition of Mexican cuisine. Replete with floor to ceiling windows, colorful murals and a juicy orange backlit bar, Masa serves lunch Monday – Friday, and dinner is served every night of the week. Patio seating available in season.



Best New Restaurant

Mpls St Paul Magazine's Best of the Twin Cities

Best New Restaurant

Twin Cities Business Magazine

Best Mexican

Mpls St Paul Magazine's Readers Poll

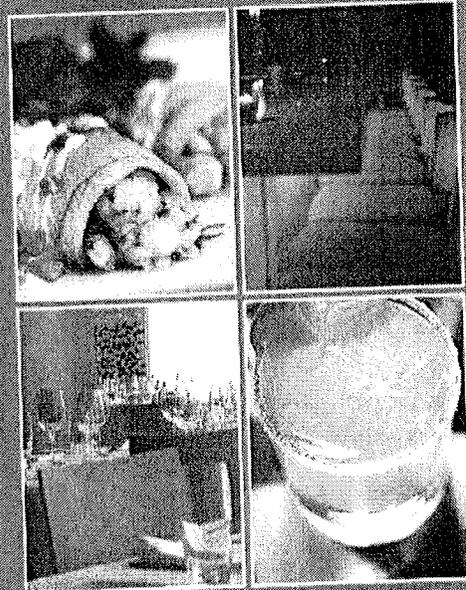
50 Great Plates

Mpls St Paul Magazine's Best Restaurants

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Masa Minneapolis



Contemporary Mexican Cuisine

Outdoor Patio

Full Bar

Private Dining Available



A "Buzz-worthy Restaurant"

New York Times

Best Mexican

Mpls St Paul Magazine

"Notable Places to Eat"

Wall Street Journal

**"Masa Brings the Company's High Standards
 and Design Acumen to the Realm of Mexican Cuisine"**
 Mpls St Paul Magazine



MASA SAMPLE MENU

ENTREMESES

appetizers, salads and soups

- Ceviche del Día** Ceviche of the day 9.75
- Guacamole Picado** Mashed avocado with white onion, tomato, chile serrano, cilantro and lime: served with raw vegetables and tortilla chips 8.75
- Ensalada de Invierno con Calabasa Rotisada**
Warm roasted winter squash and spinach salad with goat cheese, toasted pepitos and chipotle vinaigrette 9.00
- Carne Cruda** Seared beef tenderloin marinated with pasilla and ancho chiles, served with pepito pesto, purple cress and radish salad 9.00
- Quesadilla con Carne** Fresh masa quesadilla with Chihuahua cheese, shredded beef, serrano and onion: served with poblano crema 8.00
- Salpicon con Carne de Puerco** Romaine lettuce salad with marinated pork, apples, avocado, cherry tomatoes and toasted-cumin vinaigrette 8.50
- Ensalada de Corazon de Palmitos** Fresh hearts of palm, local cherry tomatoes, red onion and avocado salad with mixed baby lettuces, dressed with cilantro-lime vinaigrette 7.75
- Queso Fundido con Hongos** Melted Chihuahua and havarti cheese with mixed mushrooms, onion, tomato, serrano and Dos Equis Amber: served with warm tortillas 9.75
- Jalapeño Relleno de Chorizo con queso Chihuahua**
Roasted jalapeño pepper stuffed with chorizo, apples and Chihuahua cheese: served with guajillo and black bean purée 8.00
- Arroz Negro con Calamares en Salsa Verde**
Black rice with calamari in salsa verde 9.75
- Sopa de Tortilla** Tortilla soup with avocado, chile pasilla and Chihuahua cheese: served with lime and fried tortilla strips 9.00

TORTAS

sandwiches (lunch menu)

- Torta Carnitas** Roast pork sandwich with cilantro, avocado, onion, lime and pickled peppers 9.75
- Torta al Carbon** Marinated skirt steak, roasted poblano peppers, onions and salsa rojo 10.50
- Torta con Pollo** Grilled chicken breast marinated in barbacoa salsa: served with cucumber, chile serrano, pickled red onion, cilantro and tomato 9.50
- Torta Verdura** Grilled marinated vegetables, pickled jalapeño vinaigrette and griddled panella cheese 9.50

PLATILLOS LIGEROS

lighter plates (lunch menu)

- Chilaquiles con Salsa Verde** Two fried eggs your way: served with tortilla chips simmered in salsa verde, onions and queso fresco 12.00
- Tamales con Puerco** Two tamales in steamed corn husks filled with pork, Chihuahua cheese and red molito sauce: served with cilantro rice and frijoles negros 14.50
- Camarones al Mojo de Ajo** Sautéed Florida gulf shrimp with toasted garlic and chipotle in adobo and lime: served with cilantro rice 16.00
- Enchiladas con Pollo Estilo Morelia** Two traditional light corn tortillas, dipped in guajillo salsa, sautéed and filled with chicken: served with potatoes, carrots and pickled jalapeños 13.75
- Enchiladas de Carne** Two traditional light corn tortillas with shredded braised beef, lettuce, tomato, onion and salsa verde: served with cotija and crema 13.75
- Enchilada Vegetariana** Vegetarian enchilada with mushrooms, roasted poblanos, chard and black beans 13.75
- Sopa de Tortilla con Pollo** Tortilla soup with chicken, avocado, chile pasilla and Chihuahua cheese: served with lime and fried tortilla strips 12.75

PARA ACOMPAÑAR

side dishes

- Frijoles Negros** Black beans with epazote and queso fresco 4.50
- Frijoles Charros** Pinto beans with chorizo 4.50
- Arroz Mexicano** Rice flavored with tomato, guajillo chiles, carrots and peas 4.50
- Arroz Blanco** White rice with cilantro and lime 4.50

DE MAIZ

corn-based dishes (dinner menu)

- Sope con Palo** Fresh masa sope with duck confit in mole Colorado, mashed ripe plantain, crema anejo and cotija cheese 8.50
- Enchiladas con Pollo Estilo Morelia** Two traditional light corn tortillas, dipped in guajillo salsa, sautéed and filled with chicken: served with potatoes, carrots and pickled jalapeños 16.50
- Enchiladas con Jaiba** Two traditional light corn tortillas filled with king crab and Chihuahua cheese: served with lettuce, pickled onions, salsa verde, cotija and crema 24.00
- Enchiladas de Carne** Two traditional light corn tortillas with shredded braised beef, lettuce, tomato, onion and salsa verde: served with cotija and crema 17.50
- Tamales con Puerco** Two tamales in steamed corn husks filled with pork, Chihuahua cheese and red molito sauce: served with cilantro rice and frijoles negros 14.75
- Tamal con Pollo** Grilled chicken tamale steamed in banana leaf with chard, Chihuahua cheese and red molito sauce: served with cilantro rice and frijoles negros 15.50
- Tacos con Arroz y Frijoles** 15.50
Choose any combination of three tacos: includes rice and frijole negros
- al carbon marinated skirt steak, lettuce and onions
 - pescado grilled mahi mahi, pico de gallo, lettuce and guacamole
 - al pastor pork marinated in adobo sauce, grilled pineapple and salsa verde
 - tinga de pollo shredded chicken with chipotle crema
 - carnitas roasted pork, cilantro, onion and lime

PLATILLOS FUERTES

entrées (dinner menu)

- Pollo al Campestre** Grilled all-natural chicken breast marinated in salsa verde with roasted poblanos, mushrooms and onion: served with poblano crema and cilantro rice 19.50
- Pollo con Mole Colorado estilo Oaxaca** All-natural half chicken cooked in authentic mole colorado: served with fried plantains, rice and warm tortillas 18.75
- Chuleta de Puerco en Chile Guajillo** Pan-roasted bone-in pork chop marinated in guajillo chiles, onions and roasted garlic: served with cilantro rice and citrus salad 19.00
- Chamorro de Puerco a la Pibil** Roasted pork shank, broiled pineapple in adobo and black bean purée 19.75
- Filete al Chipotle con Queso Chihuahua y Cebollitas Verdes**
Grilled beef tenderloin marinated with chipotle salsa and finished with melted Chihuahua cheese and grilled green onions 28.75
- Mole de Hoya con Carne de Res** Beef short ribs and vegetables braised in red guajillo chile broth: served with fresh masa dumplings and warm tortillas 23.00
- Sea Bass con Salsa Huichol y Ensalada de Arroz** Grilled sea bass with salsa Huichol butter: cilantro rice salad with pico de gallo, romaine and sliced avocado 26.75
- Camarones estilo Oaxaca** Sautéed Florida gulf shrimp with roasted tomato-morita salsa: served with cilantro rice and black beans 19.50

POSTRES

desserts

- Crepes de Cajeta** Buttered crepes with goat's milk caramel and candied pecans 6.50
- Flan de Coconut** Coconut flan with toasted coconut 6.50
- Pastel de Tres Leches** Three milk cake 6.50
- Churros** Warm fritters with Oaxacan chocolate sauce 6.50
- Pan de Chocolate con Elado de Platano**
Warm Mexican chocolate bread pudding with banana-rum ice cream 6.50
- Helados y Sorbete** Ice cream or sorbet: served with Mexican cookies 5.50



ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 3380250



Serial Number: 77054435



RAM Sale Number: 3380250

RAM Accounting Date: 20131213

Total Fees: \$300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20131213	\$100	1	1	\$100
§15 affidavit	7208	20131213	\$200	1	1	\$200

Physical Location: MADCD- ALEX. CENTRAL DOCKET

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20131213



Exhibit 3

From: TMOOfficialNotices@USPTO.GOV
Sent: Saturday, December 28, 2013 11:00 PM
To: trademark@winthrop.com
Subject: Trademark RN 3380250: Official Notice of Acceptance and Acknowledgement under Sections 8 and 15 of the Trademark Act

Serial Number: 77054435
Registration Number: 3380250
Registration Date: Feb 12, 2008
Mark: MASA(STYLIZED/DESIGN)
Owner: D'Amico Holding Company

Dec 28, 2013

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
043

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

Requirements in the First Ten Years

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

Requirements in Successive Ten-Year Periods

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=77054435>.

NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

Exhibit 4

Walz, Bradley

From: Jennifer H. Guerra <Jennifer.Guerra@cph.com>
Sent: Friday, December 13, 2013 4:06 PM
To: Trademark; Walz, Bradley; Gleekel Peter; Trademark
Cc: David Plumley; Jennifer H. Guerra
Subject: D'Amico Holding Company v. Masayoshi Takayama; Opposition No. 91201540 - Electronic Service
Attachments: MASA_suspend.PDF; MASA_amend.PDF; T605_Motionred.PDF

D'AMICO HOLDING COMPANY,

Opposer,

v.

MASAYOSHI TAKAYAMA,

Applicant.

Opposition No. 91201540

Mark: MASA
Serial No.: 76/685,731
Filed: January 14, 2008

Attached please find your service copies of the following documents:

1. Applicant Masayoshi Takayama's Motion to Amend the Underlying Application to An Application Claiming Concurrent Use (Redacted);
2. Applicant Masayoshi Takayama's Motion to Amend the Underlying Application to An Application Claiming Concurrent Use (Confidential); and
3. Applicant Masayoshi Takayama's Motion to Suspend Opposition Proceeding

Please advise if you require hard copies.

Sincerely,

Jennifer H Guerra

Assistant to David A. Plumley, Lauren E. Schneider
and Steven E. Lauridsen



CHRISTIE PARKER HALE LLP

655 North Central Avenue, Suite 2300, Glendale, CA 91203

✉ jennifer.guerra@cph.com ☎ 626-795-9900 📠 626-577-8800

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Please consider the environment before printing this e-mail

Exhibit 5

INTERNET ARCHIVE
Wayback Machine

<http://www.masanyc.com/> Go

228 captures
1 Sep 04 - 26 Mar 14

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2007 2008 2009 Help

雅
M A S A

Location

10 Columbus Circle,
Time Warner Center, 4/F
New York, NY 10019
(Cross Streets: Broadway and 59th Street)

[Chef Masa](#) [Drink Menu](#) [Style](#) [Gift Ideas](#) [General Information](#) [Home](#)



Exhibit 6

INTERNET ARCHIVE
waybackmachine

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2007 2008 2009 [Help](#)

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Exhibit 7

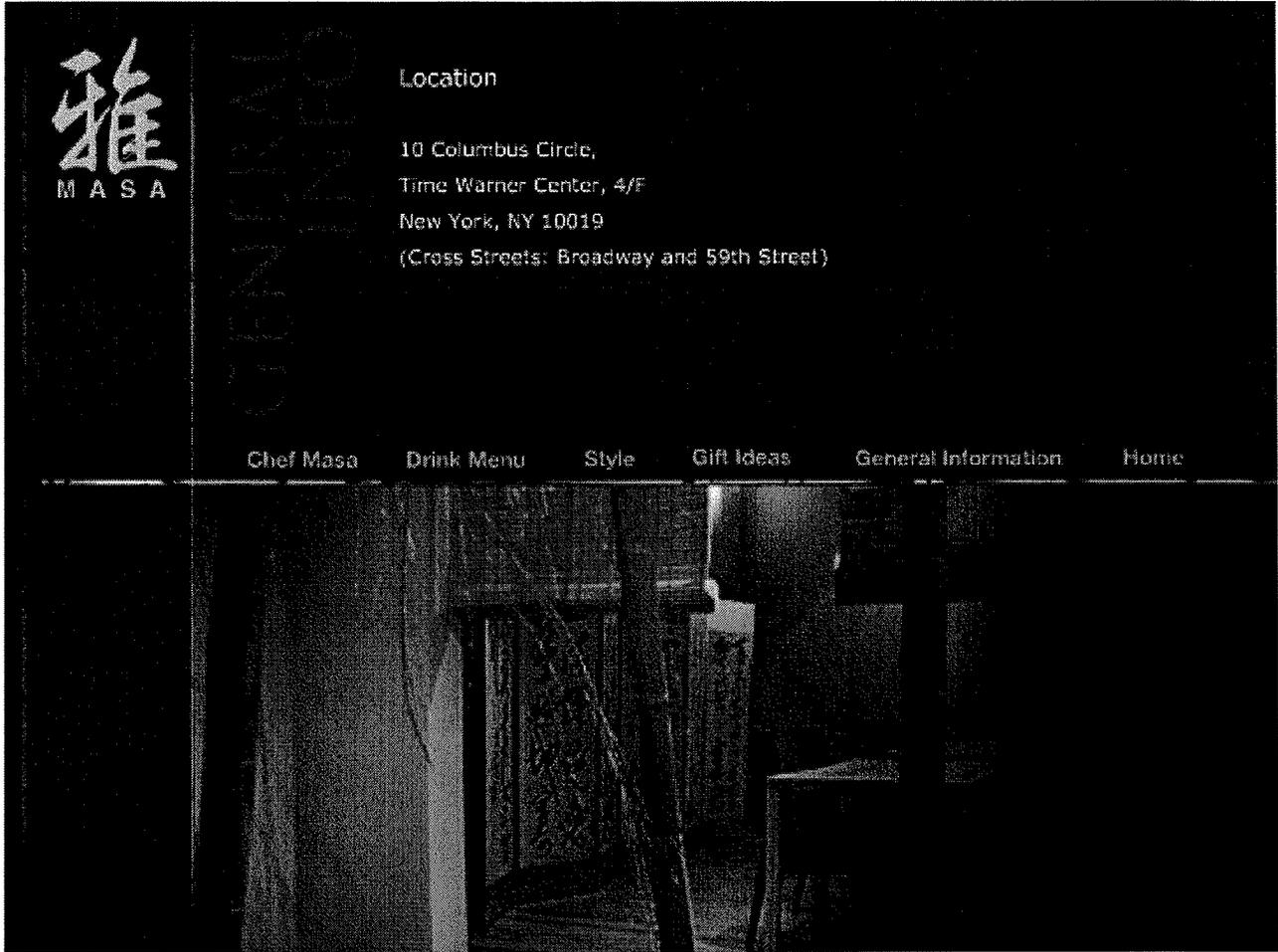
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Wayback Machine 228 captures  1 2003 2004 2005 [Help](#)
1 Sep 04 - 26 Mar 14

Under construction

Masa Restaurant
Time Warner Center
10 Columbus Circle, 4th Floor
New York, NY 10019

Reservation: 212.823.9800

Exhibit 8



The image shows the top section of a website for MASA restaurant. On the left, there is a logo with the Chinese character '雅' (Yǎ) above the letters 'M A S A'. To the right of the logo is a vertical navigation menu with the following items: Home, About Us, Menu, Location, Chef Masa, Drink Menu, Style, Gift Ideas, General Information, and Home. The 'Location' item is currently selected. Below the navigation menu is a horizontal navigation bar with the following items: Chef Masa, Drink Menu, Style, Gift Ideas, General Information, and Home. Below the navigation bar is a large, dark, grainy photograph of the restaurant's interior, showing a table and chairs.

Location

10 Columbus Circle,
Time Warner Center, 4/F
New York, NY 10019
(Cross Streets: Broadway and 59th Street)

[Home](#) [About Us](#) [Menu](#) **[Location](#)** [Chef Masa](#) [Drink Menu](#) [Style](#) [Gift Ideas](#) [General Information](#) [Home](#)

[Chef Masa](#) [Drink Menu](#) [Style](#) [Gift Ideas](#) [General Information](#) [Home](#)

