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

Proceeding	91121980
Party	Defendant ROBERT NOBLE & BONGO, S.A., DE C.V. ROBERT NOBLE & BONGO, S.A., DE C.V. ,
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Date	01/31/2007
Attachments	Ans to First Amended Pet to Cancel.pdf ( 7 pages )(89502 bytes )

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

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ESTEFAN ENTERPRISES, INC.

Petitioner/Petitioner,  
91121980

Petition to Cancel No.:

vs.

Cancellation No.: 92042251  
Registration No.: 2,347,247

BONGO, S.A. de C.V. and ROBERTO NOBLE,

Registrants/Registrants.

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**ANSWER TO ESTEFAN ENTERPRISES, INC.'S FIRST AMENDED PETITION  
TO CANCEL REGISTRATION NO. 2,347,247**

Registrant ROBERTO NOBLE and BONGO, S.A. de C.V. (hereinafter “Registrant”), hereby file their Answer to ESTEFAN ENTERPRISES, INC.’s First Amended Petition To Cancel Registration No. 2,347,247, and further allege:

1. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.
2. Registrant denies the allegations contained in this paragraph.
3. Registrant admits that Bongo, S.A. de C.V. assigned its entire interest in the COCO BONGO mark to Grupo Industrial Hotelero, C.V. Registrant denies that said assignment took place on April 1, 2005. Registrant admits that Grupo Industrial Hotelero, C.V. assigned its entire interest in the COCO BONGO mark to ROBERTO NOBLE. Registrant denies that said assignment took place on May 10, 2005. Registrant admits that Roberto Noble is the current owner of the COCO BONGO mark and U.S. Registration Number 2,347,247.

4. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

5. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

6. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

7. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

8. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

9. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

10. Registrant denies the allegations contained in this paragraph.

11. Registrant admits the allegations contained in this paragraph.

12. Registrant admits the allegations contained in this paragraph.

13. Registrant admits the allegations contained in this paragraph.

14. Registrant admits only that the application which matured into the subject Registration was filed after Petitioner's filing of its application one of its applications for one of its BONGOS CUBAN CAFÉ marks. Registrant denies the remaining allegations contained in this paragraph.

15. Registrant denies the allegations contained in this paragraph.

16(1).<sup>1</sup> Registrant denies the allegations contained in this paragraph.

16(2). This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

17. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

18. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

19. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires no response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

20. Registrant denies the allegations contained in this paragraph.

All allegations not specifically admitted above are denied.

### **AFFIRMATIVE DEFENSES**

21. As his First Affirmative Defense, Registrant alleges that all or part of

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<sup>1</sup> ESTEFAN ENTERPRISES, INC.'S First Amended Petition to Cancel contains two allegations numbered "16." For purposes of the Answer, Registrant shall refer to these allegations sequentially as paragraphs "16(1)" and "16(2)."

Petitioner's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Petition to Cancel, is generic, and thus incapable of functioning as a mark. Petitioner therefore has no standing to maintain an action to oppose the subject application.

22. As his Second Affirmative Defense, Registrant alleges that all or part of Petitioner's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Petition to Cancel, is merely descriptive of the goods and services provided in connection therewith, and thus incapable of functioning as a mark. Petitioner therefore has no standing to maintain an action to oppose the subject application.

23. As his Third Affirmative Defense, Registrant alleges that the term "BONGOS," which is the only term not expressly disclaimed by Petitioner, has become diluted as a result of its widespread use in the restaurant, nightclub and entertainment industries, a fact admitted by Petitioner in prior federal litigation.

24. As his Fourth Affirmative Defense, Registrant alleges that Petitioner has abandoned its rights, if any, in its alleged marks, by failing to continuously use and police same.

25. As his Fifth Affirmative Defense, Registrant alleges that Petitioner is collateral estopped from maintaining the herein Petition to Cancel proceeding in that issues central to Petitioner's Petition to Cancel have already been decided by the U.S. District Court in and for the Southern District of Florida and the 11th Circuit Court of Appeals in the case of Michael Caruso & Co., Inc. v. Estefan Enterprises, Inc., 994 F. Supp. 1454 (S.D. Fla. 1998), *aff'd without opinion*, 166 F.3d 353 (11th Cir. 1998).

26. As Sixth Affirmative Defense, Registrant alleges that Petitioner's acquiescence in enforcing its alleged rights in the mark BONGOS CUBAN CAFÉ bars it

from maintaining the herein Petition to Cancel proceeding.

27. As his Seventh Affirmative Defense, Registrant alleges that neither registration, nor use, of the Registrant's mark as alleged in the subject application, will create a likelihood of confusion with any of Petitioner's alleged marks.

28. As his Eighth Affirmative Defense, Registrant alleges that Petitioner has not used some or all of its alleged marks on the goods or services asserted in bona fide commerce. Petitioner therefore has no standing to maintain an action to oppose the subject application.

29. As his Ninth Affirmative Defense, Registrant alleges that Petitioner has not used its alleged marks in interstate commerce and therefore has no federal rights to assert. As a result, Petitioner has no standing to maintain an action to oppose the subject application.

30. As his Tenth Affirmative Defense, Registrant alleges that some or all of the federal registrations alleged to be owned by Petitioner were obtained by fraud in that the corresponding marks were not used in interstate commerce.

31. As his Eleventh Affirmative Defense, Registrant alleges that Petitioner is not likely to be, damaged by Registrant's continued maintenance of the subject Registration, and any confusion or damage which might be possible would be *de minimus*.

32. As his Twelfth Affirmative Defense, Registrant alleges that Petitioner is estopped by its own actions which are inconsistent with its claims of likelihood of confusion herein. Namely, Petitioner either owned or licensed the operation of a restaurant, bar and retail souvenir business under its alleged mark in the Mexico City

airport, a jurisdiction in which Petitioner undeniably has priority of right over Petitioner to use his COCO BONGO marks.

33. As his Thirteenth Affirmative Defense, Registrant alleges that he has priority of right over Petitioner to use his COCO BONGO marks for the goods and services at issue.

34. As his Fourteenth Affirmative Defense, Registrant alleges that some or all of Petitioner's alleged marks upon which its claim of priority depends are either no longer in use, or have been abandoned.

35. As his Fifteenth Affirmative Defense, Registrant alleges that he has used the mark which is the subject of the Registration Number 2,347,247 in qualifying commerce on his own, and through his licensees and predecessor-in-interest BONGO S.A. de C.V., Grupo Industrial Hotelero, S.A. and Marrero Enterprises, Inc.

WHEREFORE, Registrant respectfully requests that the Board grant no relief to Petitioner by reason of its First Amended Petition to Cancel Registration No. 2,347,247, and grant such further relief as the Board deems just and proper.

Respectfully submitted,

Law Offices of  
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By: s/Michael I. Santucci  
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Florida Bar Number: 0105260

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing has been served on this 31<sup>st</sup> day of January, 2007, by first class and by TTAB electronic mail to Karen Stetson, Esq., PO Box 403023, Miami, Florida 33140.

By: s/Michael I. Santucci  
Michael I. Santucci, Esquire