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

Proceeding	91125436
Party	Defendant TEQUILA CENTINELA, S.A. DE C.V.
Correspondence Address	JEFFREY H. KAUFMAN OBLON, SPIVAK, MCCLELLAND, MAIER & NEUST 1940 DUKE STREET ALEXANDRIA, VA 22314
Submission	Applicant's Reply to Opposer's Response to TTAB Decision
Filer's Name	JEFFREY H. KAUFMAN
Filer's e-mail	tmdocket@oblon.com
Signature	/Jeffrey H. Kaufman/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TEQUILA CAZADORES, S.A. de C.V.)
 and BACARDI & COMPANY LIMITED)
 JOINED AS PARTY PLAINTIFF,)
)
 Opposers,)
)
 v.)
)
 TEQUILA CENTINELA, S.A. de C.V.,)
)
 Applicant.)

Opposition No. 91/125,436
Appln. Serial No. 76/112,825

APPLICANT’S REPLY TO OPPOSER’S RESPONSE TO TTAB DECISION

Applicant, TEQUILA CENTINELA, S.A. de C.V. (“Tequila Centinela”), submits this Reply to Opposer’s Response to the Board’s summary judgment decision of February 24, 2004. Opposer Bacardi & Company Limited (“Opposer Bacardi”) has not clarified, as a matter of law based upon clear, undisputed facts, that it has properly succeeded to the rights of Opposer Tequila Cazadores, S.A. de C.V. (“Opposer Cazadores”). In fact, Opposer Bacardi’s recent submission has only created more questions. Therefore, summary judgment on the issue of standing is inappropriate at this time.

Procedural History

Twice during these proceedings, on September 4, 2002 and April 15, 2003, Opposer Bacardi sought to become a party to this Opposition, claiming rights by assignment in the marks CAZADORES and CAZADORES & Design (the “CAZADORES marks”) by assignment from Opposer Cazadores. The first time, on March 5, 2003, the Board rebuffed Opposer Bacardi’s attempt to join in this Opposition, based upon a lack of adequate proof of its ownership rights.

The second time, On October 20, 2003, the Board denied Opposer Bacardi's renewed motion to substitute itself as the Opposer, unless Bacardi submitted papers clarifying its chain of title to the involved registration and marks.

In its Order of February 24, 2004, however, the Board permitted Opposer Bacardi to become a party to the Opposition. In that same Order, the Board determined that Tequila Centinela's Application Serial No. 76/112,825 to register the mark CABRITO & Design was improperly filed. The Board, however, left open the issue of standing,¹ stating:

[W]ith regard to Opposer's standing we find that Opposer has not demonstrated the absence of a genuine issue of material fact. At a minimum, there is a genuine issue as to the veracity of the documents submitted to allege the transfer of interest in this proceeding from Tequila Cazadores, S.A. de C.V. to Bacardi, and the pleaded registration is not of record.

Opposer is therefore allowed until THIRTY DAYS from the mailing date of this Order in which to submit a showing that there is no genuine issue of fact as to standing, and that it is entitled to judgment on the issue of standing as a matter of law. *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1775-76 (TTAB 1994).

Opposer Bacardi's New Submission on the Question of Standing

Opposer Bacardi has now filed for a third time with the Board its supposed proof of ownership of the CAZADORES & Design mark and the CAZADORES registration (Registration No. 1,863,882). There are several discrepancies in Opposer Bacardi's proofs.

Opposer Bacardi allegedly obtained rights to the CAZADORES marks in a multi-step process. At the time the captioned Opposition was filed, Opposer Tequila Cazadores allegedly owned the rights to the CAZADORES marks. According to Opposer Bacardi's recent submissions, Opposer Tequila Cazadores, on September 3, 2002, changed its name to Grupo Industrial Tlajomulco, S.A. de C.V. ("Grupo Industrial"), but this was after Grupo Industrial

¹ The substantive Opposition grounds of dilution and likelihood of confusion were not decided on summary judgment, and remain to be decided.

assigned the CAZADORES marks, on May 31, 2002, to the entity Domino Recreativo S.A. (“Domino Recreativo”). Therefore, Grupo Industrial purported to assign to Domino Recreativo the rights to marks that it did not own. Strangely, the recordation of the name change of Opposer Tequila Cazadores to Grupo Industrial still remains pending with the Assignment Branch of the PTO. More puzzling, the assignment document showing the transfer from Grupo Industrial to Domino Recreativo was not signed until a year after the alleged assignment took place.

The assignment of the CAZADORES marks from Domino Recreativo to Opposer Bacardi also is quite unusual. The assignment document from Domino Recreativo to Opposer Bacardi again was not signed until a year after the alleged assignment took place. To prove the assignment, Opposer Bacardi submitted two documents: the first document was signed only by the President of Domino Recreativo; the second document (dated a month later) was signed by the President of Domino Recreativo and outside counsel for Opposer Bacardi (with no proof that outside counsel is or was a Bacardi officer).

Standards for Summary Judgment

Summary Judgment is appropriate when the evidentiary record before the Board shows that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. *See*, Rule 56(c), Fed.R.Civ.P. Moreover, it is the burden of the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See*, *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Callaway Vineyard & Winery v. Endsley Capital Group Inc.*, 63 USPQ2d 1919, 1921 (TTAB 2002).

“[O]n a motion for summary judgment, the function of the Board is not to try issues of fact but to determine, instead, if there are any genuine issues of material fact to be tried.”

University Book Store v. University of Wisconsin Board of Regence, 33 USPQ2d 1385, 1389 (TTAB 1994). “A material fact is one that may effect a decision in the case. A genuine dispute with respect thereto exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party.” *Id.* (citations omitted). “[A]ll doubts ... whether ... particular factual issues are genuinely in dispute must be resolved against the moving party and, similarly, all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non/moving party.” *Id.* (citations omitted).

Where factual inferences are erroneously drawn in favor of the moving party, summary judgment is inappropriate and is grounds for reversal. *Old Tyme Foods Inc. v. Roundy's Inc.*, 22 USPQ2d 1542, 1544 (Fed.Cir. 1992).

Opposer Bacardi's Standing Remains in Dispute

Before it may maintain this Opposition, Opposer Bacardi is required to provide properly documented proof that it acquired by assignment the trademark rights of the original Opposer, Tequila Cazadores, upon which this Opposition is based.² 37 C.F.R. §§ 3.71(d) and 3.73(a) and (b); TBMP § 512.01. For a third time, the purported assignment documents Bacardi has submitted fall far short of the required standard. Because Opposer Bacardi has not submitted proper assignment documents, summary judgment on the issue of standing at this time is inappropriate.

Absent the filing of sufficient, uncontroverted, and clear proof that it is indeed the successor to the alleged trademark rights of Opposer Tequila Cazadores, Opposer Bacardi should not be granted the right, as a matter of law, to maintain this Opposition. As the Board stated in *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981),

² The rights Opposer Bacardi alleges it acquired by and through Opposer Tequila Cazadores consist of the alleged “right title and interest and ... goodwill in the marks claimed as the basis for this subject Opposition” as well as the rights to Registration No. 1,863,882 for the mark CAZADORES.

"[O]pposer, having shown no proprietary right, as a matter of law, in ... [the relied upon] trademark ..., is apparently relying on whatever rights in that mark might be possessed by a third party, which cannot be done." From the face of Opposer Bacardi's papers submitted on March 25, 2004, there remain genuine issues of material fact with respect to the propriety of the *mesne* assignments resulting in Opposer Bacardi's alleged acquisition of the trademark rights upon which this Opposition is based. Summary judgment on the issue of standing at this time, therefore, is inappropriate.

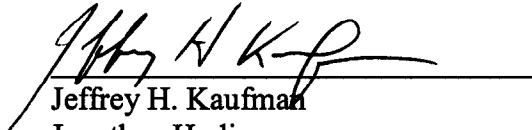
Conclusion

Wherefore, Applicant, Tequila Centinela S.A. de C.V., respectfully requests that summary judgment on the issue of standing be denied.

Respectfully submitted,

TEQUILA CENTINELA, S.A. de C.V.

By:



Jeffrey H. Kaufman
Jonathan Hudis
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220

Attorneys for Applicant

Date: April 26, 2004

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO TTAB DECISION** was served on counsel for Opposer, this 26th day of April, 2004, by sending same via First Class Mail, postage prepaid, to:

Janice W. Housey, Esquire
ROBERTS, MLOTKOWSKI & ROBBES, P.C.
8270 Greensboro Drive, Suite 850
McLean, Virginia 22102

